

20

Transcript of Record.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1921

No. 57

JOHN SIMMONS COMPANY, PETITIONER,

vs.

THE GRIER BROTHERS COMPANY.

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT
OF APPEALS FOR THE THIRD CIRCUIT.

PETITION FOR CERTIORARI FILED MAY 16, 1920.

CERTIORARI AND RETURN FILED JULY 20, 1920.

(27,687)



(27,687)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1920.

No. 342.

JOHN SIMMONS COMPANY, PETITIONER,

vs.

THE GRIER BROTHERS COMPANY.

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT
OF APPEALS FOR THE THIRD CIRCUIT.

INDEX.

	Original.	Print.
Transcript of record from the district court of the United States for the western district of Pennsylvania.....	1	1
Docket entries.....	1	1
Opinion of the circuit court of appeals, No. 1891.....	3	2
Mandate of the circuit court of appeals.....	11	10
Decree on mandate of circuit court of appeals.....	15	13
Order of the circuit court of appeals.....	15	13
Notice and petition to file bill of review.....	16	14
Bill of review.....	17	15
Exhibit A—Opinion of Supreme Court U. S. by Mr. Justice McKenna in No. 67, October term, 1917.....	20	19
B—Mandate of Supreme Court U. S. in No. 67, October term, 1917.....	28	25
C—Judgment of district court for southern district of New York on mandate of Supreme Court U. S.....	30	27
Answer to bill of review.....	31	28

	Original.	Print.
Petition and order to file supplemental bill.....	32	29
Exhibit A—Assignment.....	34	31
Exhibit B—Assignment.....	36	32
Supplemental bill.....	37	33
Answer to supplemental bill.....	38	34
Deposition of Frank N. Waterman.....	39	35
Opinion <i>sur</i> bill of review, ORT, J.....	41	38
Supplemental opinion re settlement of decree.....	48	41
Decree upon bill of review.....	49	43
Petition for appeal.....	50	44
Order permitting appeal.....	50	45
Assignment of errors.....	51	45
Bond on appeal.....	53	47
Præcipe for appeal record.....	54	48
Citation and service.....	55	50
Plaintiff's paper exhibits.....	57	51
Amended bill of complaint, New York suit.....	57	51
Amended answer, New York suit.....	60	54
Decree of district court, New York suit.....	67	61
Petition for appeal and order, New York suit.....	69	62
Mandate of court of appeals, New York suit.....	70	63
Order on the above mandate, New York suit.....	72	66
Petition for writ of certiorari.....	75	67
Assignment from F. E. Baldwin of reissue patent....	84	71
Assignment of right to recoveries, etc.....	86	72
Baldwin reissue No. 13,563, in suit.....	89	78
Baldwin original patent No. 821,510.....	95	82
Order of argument.....	98	85
Opinion, Bullington, J.....	98	85
Decree.....	105	92
Clerk's certificate.....	105	92
Writ of certiorari and return.....	106	93

1 In the District Court of the United States, the Western District of Pennsylvania. October Term, 1913.

No. 26. In Equity.

FREDERIC E. BALDWIN, a Citizen of the State of New York, and JOHN SIMMONS COMPANY, a Corporation and Citizen of the State of New York,

vs.

THE GRIER BROTHERS COMPANY, a Corporation and Citizen of the State of Pennsylvania.

Attorneys:

M. Arthur Keller, James Q. Rice, 220 Broadway, N. Y.

Joseph M. Nesbit, Brown & Stewart, C. P. Byrnes, Geo. H. Parmelee, and Geo. E. Stebbins.

Docket Entries since Feb. 23, 1915.

Feb. 24, 1915. Mandate from U. S. Circuit Court of Appeals affirming the decree of this Court as to so much thereof as refers to the subject of unfair competition, but the rest of the decree must be modified in accordance with the opinion of the U. S. Circuit Court of Appeals; the costs in both Courts to be equally divided, and the Plaintiffs to recover \$19.60 for its costs expended in the C. C. of Appeals, rec'd & filed.

Jan. 5, 1916. Decree on Mandate filed & entered.

Dec. 26, 1916. Stipulation & Order for substitution of M. Arthur Keller, Esq., as solicitor for plaintiffs in place of Wesley G. Carr, filed & entered.

Jan. 26, 1918. Bill of Review and Request therefor filed by leave of Court, and argument fixed for Feb. 13, 1918.

Feb. 13, 1918. Request for Bill of Review, argued, C. A. V.

Feb. 15, 1918. Opinion filed and entered refusing request for Bill of Review, without prejudice, etc.

2 March 6, 1918. Cert. copy decree on Mandate, for Plff's 9 fol.

March 13, 1918. Certified copy Order C. C. of Appeals granting leave to make an application to District Court to file a bill of review, filed.

April 11, 1918. Notice & Petition for leave to file a Bill of Review, filed & entered.

April 26, 1918. Petition for leave to file a Bill of Review argued, C. A. V.

April 26, 1918. Petition to file a Bill of Review granted. Order entered on Argument List: "Petition granted & leave granted to file Bill of Review as prayed for. Per Curiam. Counsel for De-

defendant excepts to this action of the Court and their exception is noted. Chas. P. Orr, U. S. Dist. Judge."

May 11, 1918. Answer of deft. to Bill of Review, filed.

Jan. 10, 1919. Petition of John Simmons Company & Order granting leave to file a supplemental Bill, filed and entered.

Jan. 10, 1919. Supplemental Bill filed.

Jan. 16, 1919. Defendant's Answer to Plaintiff's Supplemental Bill filed.

Mar. 22, 1919. Praecipe for Equity Calendar filed, & case entered.

Feb. 27, 1919. Testimony of Frank N. Waterman & Plaintiff's Exhibits "Assignment of all recoveries in this suit;" "Mandate C. C. of Appeals 2nd Circuit;" "Order on Mandate U. S. C. A. 2nd Circuit;" "Assignment of Reissue Patent 13542 in suit by Baldwin to John Simmons Co.;" "Petition for Writ of Certiorari, page 1 to 14;" "Transcript of Record Appeals from the Dist. Court for the Southern Dist. of New York, pages 1 to 5, 6 to 17, 192 to 194, 195 to 196."

Feb. 27, 1919. "Grier Lamp and Justrite Lamps received & filed.

April 24, 1919. Praecipe for appearance of C. P. Byrnes, Geo. H. Parmelee, and Geo. E. Stebbins for deft. filed.

April 24, 1919. Bill of Review argued, C. A. V.

Oct. 7, 1919. Opinion sur Bill of Review filed and entered.

Nov. 7, 1919. Supplemental Opinion upon Settlement of Decree upon Bill of Review, filed and entered.

Nov. 7, 1919. Decree upon Bill of Review filed and entered.

Nov. 12, 1919. Perpetual Injunction issued.

Nov. 17, 1919. Injunction returned served on The Grier Brothers Co. by handing to and leaving a true and correct copy thereof with J. Wilbur Grier, Pres. of said Company, at Pittsburgh, Pa., Nov. 17, 1919.

Nov. 24, 1919. Petition for Appeal & Order allowing same filed & entered.

Nov. 24, 1919. Assignments of Error filed.

Nov. 28, 1919. Bond on appeal approved and filed.

3 Nov. 31, 1919. Praecipe re contents of record on appeal filed.

Nov. 31, 1919. Narrative of Testimony & Order approving same filed and entered.

Nov. 31, 1919. Citation awarded and issued.

Jan. 7, 1920. Citation returned service accepted by James K. Bakewell.

Opinion of the United States Circuit Court of Appeals,

(Filed January 22, 1915.)

(Circuit Court of Appeals, Third Circuit. January 22, 1915.)

No. 1891.

GRIER BROS. Co.

vs.

BALDWIN et al.

Appeal from the District Court of the United States for the Western District of Pennsylvania; Charles P. Orr, Judge.

Suit in equity by Frederick E. Baldwin and the John Simmons Company against the Grier Bros. Company. Decree for complainants, and defendant appeals. Modified.

For opinion below, see 215 Fed., 735.

Joseph M. Nesbit and Thomas S. Brown, both of Pittsburgh, Pa., for appellant.

James Q. Rice, of New York City, for appellees.

Before Buffington, McPherson, and Woolley, Circuit Judges.

J. B. McPHERSON, *Circuit Judge*:

The Bill in this suit charges (1) infringement of reissued letters patent No. 13,542, and (2) unfair competition in the sale of the lamp covered thereby. It came first before the late Judge Young, who refused a preliminary injunction to restrain infringement, but granted it to restrain unfair competition. (D. C.) 210 Fed., 560. Upon final hearing before Judge Orr, a final injunction was granted upon both grounds. (D. C.) 215 Fed., 735.

1. In order to understand the first branch of the controversy, the scope of the original letters patent must be determined. They are numbered 821,580 and were issued May 22, 1906, to Frederick E. Baldwin for improvements in acetylene gas lamps, "intended for use and adapted to use as bicycle, automobile, yacht, or miner's lamp, or for any other analogous purpose. * * *". The body of the lamp is a metallic or other container, and this is divided (horizontally by preference) into two chambers or compartments, the upper intended for water, and the lower for calcium carbide. The gas is generated in the lower chamber. The specification deals with two problems, but we are concerned with only one of them, namely, "The means for effecting and controlling the generation of gas." That problem arises out of the following situation: Finely divided carbide is placed in the gas-generat-

ing chamber and retained in position by a suitably adjusted spring or other suitable device. A tube leads from the water-chamber into the chamber below, and by this duct the water and the carbid are brought together. The gas is generated by the chemical reaction of these two substances, and the gradual feed of the water must be carefully maintained. The inventor goes on:

"Various means have been employed to regulate or control the normal rate of flow of water through a water-supply tube. For example, the bore of the tube has been made of small diameter; but this plan has not been found practical for various reasons. In the first place, the discharge outlet thereof is under pressure of several inches of water, and it is practically impossible to make the bore so minute that the water will issue in sufficiently small quantity. If the attempt is made to secure this small flow by making the tube very minute, it then becomes so easily clogged that the operation of the lamp is rendered extremely uncertain. The smallest particle of foreign matter in the water, or a bit of slaked carbid carried into the bore by back pressure of the gas, will stop the flow completely, and the lamp will go out. Such a tube is also difficult, in fact almost impossible, to clean. Another method which has been employed is to use a duct of comparatively large bore, and fill the same with a wick of more or less loose texture for the purpose of checking the supply. This for a time operates with some degree of success, through from the very nature of the material used the precise amount of the feed can never be exactly determined. A valve is generally necessary to regulate the supply. Furthermore, when the lamp has been used for a time, the wick, which, of course, must act as a strainer, becomes filled with solid matter—such as sand, dirt, and organic particles contained in the water—so that the feed is reduced. This necessitates frequent adjustment of the valve to restore the proper supply. In time the wick becomes completely choked, and the user, often unskillful in such matters, must tamper with the lamp and insert a new wick, which is at best a troublesome procedure. Again, if the lamp has not been used for some time, the wick dries out, and a very appreciable time is required to soak it up so that the water will again flow through."

These being the difficulties, the patentee turned to his means for overcoming them. His plan was to make the bore of the duct comparatively large, and then to obstruct or restrict it by placing a wire or rod therein, preferably in the center, thus leaving a channel of the proper size and shape. The advantages are thus described:

"This arrangement is simple; but in a long experience it has been found to be entirely successful. It is possible to secure the correct drop-by-drop feed with a duct of considerable size, since the friction of the water on the large area of the tube-wall and wire reduces its flow. This retarding-friction may be regulated by varying the size of wire used. The duct does not become choked, since, if foreign particles are deposited therein, the water can take a zigzag course

around (them) without the supply being appreciably affected. If it is at any time necessary to clean the tube, the wire is simply reciprocated and rotated a few times from the outside of the lamp without disturbing the position of other parts. This nice regulation of the flow enables me to entirely dispense with the troublesome adjustment of the valve. If a valve is used at all, it is employed to shut off the flow entirely and not to regulate it. The construction just described is shown," etc., etc.

As will be observed, the device thus described is intended to perform a certain part in effecting and controlling the generation of the gas; this part being the regulation of the water-supply, or the control of the flow. But the generation of the gas might also be affected and controlled in another way, and to this subject the inventor immediately passed on:

"In some cases, however, there is employed in connection with the means for introducing the water into the mass of carbid (that is, in connection with the duct and rod) a device in the nature of a stirrer, which, on proper manipulation, may be used to break up the mass of carbid surrounding the outlet of the water duct, and which, by having become slaked and caked by the action of water, prevents the proper percolation of the latter to the un-slaked carbid in the receptacle *G*, Fig. 2. As such device I employ a stem or rod *N*, which extends down through the tube *L* and is bent at substantially a right angle to form an arm *N'*. This rod may form a prolongation of the valve-stem *M'*, of Fig. 2, or, in case no valve is used, may extend from the top of the lamp down through the water-reservoir, as shown in Fig. 3.

"As calcium carbid possesses strongly absorptive properties, the introduction of water through the tube *L*, will result in the gradual slaking of the material about its outlet; but the lime thus produced becomes gradually less permeable to the water, so that an insufficient quantity of gas is generated to maintain the proper flame. When this becomes noticeable, the rod *N* is turned, so as to cause the arm *N'* to break up to a greater or less extent the mass of lime, and in practice I have found that under ordinary conditions this is amply sufficient to insure a substantially uniform generation of gas until all the carbid in the receptacle *G* is exhausted.

"In the larger-sized lamps it is desirable to employ two or more water-tubes *L* and, if desired, stirring-rods *N*, extending down to different points in the carbid-receptacle. This is indicated in Fig. 4, which is an under plan view of the bottom *D* of the water-reservoir, showing three water-tubes *L* in section. It is, however, desirable, when a plurality of stirring rods are employed, that some means be provided for actuating all of them simultaneously. A device suitable for this purpose is shown in Fig. 6, in which *O* is a ring placed on top of the lamp, with which bent ends of all the rods *N* engage, so that partial rotation of the ring will impart a corresponding movement to each rod."

In the original patent, therefore, the inventor described two devices by which the generation of gas might be effected and controlled:

(1) A tube with a wire or rod therein; and (2) a bent arm on the end of the wire or rod, which could be used as a stirrer. And he claimed both these devices in each of the first 4 claims:

"(1) In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbid, of a tube extending from the former a considerable distance into the latter so as to be embedded in the mass of carbid contained in said receptacle, and a rod or stem extending through said tube into the carbid receptacle and having its end formed as a stirrer to break up the slaked carbid around the outlet of the water-tube, as set forth.

"(2) In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbid, of a tube extending from the former into the latter so as to be embedded in the mass of carbid contained in the receptacle, a rod extending from a point outside of the lamp through the tube and into the carbid-chamber and having its end bent to form a stirrer for breaking up the slaked carbid around the outlet of the water-tube, as set forth.

"(3) In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbid, of a plurality of tubes extending from the former into the latter so as to be embedded in the mass of carbid contained in the receptacle, a stirrer passing through each tube adapted to break up the slaked carbid around the end of the tube, and means for actuating all the stirrers simultaneously, as set forth.

"(4) In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbid, of a water-tube extending from the former a considerable distance into the latter and adapted to be embedded in the mass of carbid in the receptacle, and a rod extending through the water-tube, and constituting a stirrer to break up slaked carbid around the outlet of the water tube, the rod operating to restrict and thus control the flow of water to the carbid, as set forth."

This, then, was the patent when it was originally issued in 1903. Three years later the patentee sued Jacob Bleser for infringing claims 1 and 4, as well as several claims of an earlier patent granted in 1900. The Bleser lamp closely resembled the Grier lamp now in question, particularly in the fact that it had no bent arm to act as a stirrer; the end of the rod within the duct being merely pointed. The Court of Appeals of the Seventh Circuit in *Bleser vs. Baldwin*, 199 Fed., 133, 117 C. C. A., 615, decided that claims 1 and 4 of the patent now under consideration were not infringed by such a construction. The decision was rendered in April, 1912; and we can hardly doubt that the reissue was intended to meet the situation thus created, for it was applied for soon afterward—on February 5, 1913—although this was nearly seven years after the original grant. And the changes that mark the reissue are such as to indicate with much persuasiveness that this was in fact the intention. The patentee amended his specification in two respects: (1) He described the tube

as always imbedded in the carbid—"extend the tube which forms the duct downward so that its end will be always embedded in the carbid"—a change of not much importance; and (2) he added this significant paragraph:

"It will be understood, from what has been said, that the function of the stirrer is to break up, pierce, or disturb the particles of the slaked carbid mass which, when the lamp is in use, forms at the delivery end of the tube. This slaked carbid mass tends to solidify and either shuts the water off altogether, or restricts it so that less water is delivered from the water-tube than the lamp demands for efficient operation. As it is sufficient, under certain circumstances, to insure the requisite water flow by so manipulating the stirrer, as to pierce, break up, or loosen the slaked carbid mass immediately around or at the mouth of the tube, it is obvious that the stirrer need not always be formed with a bent end, or so as to extend radially from the mouth of the tube."

Having thus described in his specification a kind of stirrer that would have covered Bleser's construction, he then amended claim 4 so as to read:

"In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbid, of a water-tube extending from the former a considerable distance into the latter and adapted to be embedded in the mass of carbid in the receptacle, and a rod extending through the water-tube, and constituting a stirrer to break up slaked carbid around the outlet of the water-tube; *the rod operating to restrict and thus control the flow of water to the carbid, as set forth.*"

The italicized words being the clause inserted.

[1] Now, if we construe the reissue so as to eliminate the need for a bent arm—and this was its principal purpose—it operates to broaden the original patent, and (thus construed) claim 4 cannot be sustained. We have stated the facts fully in order to present the situation clearly, but we do not think it necessary to discuss the controlling legal principles. We think the authorities settle the proposition that a reissue cannot be allowed to broaden the original patent (as Baldwin attempted to do), especially after such a lapse of time as seven years, and after the claim had been limited by a final adjudication. And this would be true, even if no stress were to be laid upon the rights that had intervened by reason of the Blesser device, although Bleser himself had been manufacturing that device for several years, and the present appellant had been manufacturing it for several months, before the reissue was applied for. Powder Co. vs. Powder Works, 98 U. S., 126, 25 L. Ed. 77; Miller vs. Brass Co., 104 U. S., 350, 26 L. Ed. 783; James vs. Campbell, 104 U. S., 357, 26 L. Ed. 786; Coon vs. Wilson, 113 U. S., 268, 5 Sup. Ct. 537, 28 L. Ed. 963; General Electric Co. vs. Richmond Co., 178 Fed., 84, 102 C. C. A., 138; Railway Co. vs. Sayles, 97 U. S., 554, 24 L. Ed. 1053;

Flower vs. Detroit, 127 U. S., 563, 8 Sup. Ct. 1291, 32 L. Ed. 175;
Topliff vs. Topliff, 145 U. S., 156, 12 Sup. Ct. 825, 36 L. Ed. 658.

[2] on the patent question, therefore, we think the decree should have been in favor of the defendant.

[3] 2. Turning now to the subject of unfair competition, we may note, in passing, that the requisite diversity of citizenship exists in this case, so that the question of jurisdiction that might otherwise arise at this point need not be discussed. *Schiebel Toy Co. vs. Clark*, 217 Fed., 761, 774, — C. C. A., —. We agree with the District Court that deliberate unfair competition has been proved, and the only question that calls for consideration is the extent of the relief that

9 has been awarded. The decree complained of enjoins the appellant from—

** * * directly or indirectly placing upon the market, or causing to be placed on the market, the acetylene gas-generating lamp identified in this suit as 'Plaintiffs' Exhibit No. 6,' and which is complained of in this case as an imitation of Plaintiffs' Exhibit No. 1, or any other acetylene gas-generating lamp, which shall not be so differentiated or distinguished in outward form and appearance from plaintiffs' said lamp, identified as Plaintiffs' Exhibit No. 1, that purchasers thereof will not likely be deceived by similarity of form and appearance or by accessories sold therewith into purchasing such lamps, made or marketed by defendant, thinking the same to be plaintiffs' lamps, and also from doing any act or thing calculated to induce the belief that acetylene gas-generating lamps, not manufactured or offered for sale by plaintiffs, are, in fact, of plaintiffs' manufacture."

It is no doubt true that this decree is giving the appellant trouble, but this was its object; and we are only concerned with the inquiry whether it goes too far. In our opinion it does not, but is carefully guarded so as to protect the right of the Grier lamp to make a fair (but not an unfair) attack upon the market. We agree that actual imitations are not always unfair, but at present this lamp is undoubtedly a slavish imitation of the Baldwin device; and we are by no means satisfied that the numerous identities are essentially due to structural and economical necessities. It is of course true that the Baldwin lamp has no right to monopolize the trade, but the plaintiffs do have the right to insist that the Grier lamp shall cease from being merely a designed and colorable imitation, and shall stand on its own merits. We have no doubt the appellant's ingenuity is capable of solving that problem to the satisfaction of the court below, and we do not feel obliged to point out in what particulars the offending lamp should be modified. As at present constructed, it passes the limit of healthy rivalry in trade, and was properly enjoined. But the following observations may perhaps be usefully made:

The Baldwin lamp is undoubtedly a useful improvement, as its extensive use may indicate, but it has no right to dominate the situation. Its shape and design are protected, not by patent, but merely

by the rules that govern unfair competition; and it seems clear enough that the necessities of the art require that in size and arrangement all such lamps must bear a general resemblance among themselves. The container must be small, and must be divided internally into a water-chamber and a chamber for the carbid, and this necessity must influence the shape and arrangement to a considerable degree. Moreover, the lamp must be light in weight, especially when it is to be used in a mine, where it is ordinarily attached to a miner's cap. The patented features are concealed, and cannot be seen by ordinary inspection, so that unlawful interference therewith may be difficult to prevent; but it is not these features with which we are now concerned. The superficial details of construction certainly need not be identical in nearly every particular, as they are in Exhibit No. 6; and of course it is also unfair to represent the Grier lamp as a Baldwin, or as an improved Baldwin, lamp, or to accompany it with nearly identical instructions printed in the same foreign languages, and with the peculiarly-shaped cleaner referred to by the court below. All these matters were plainly intended to aid in confusing purchasers, and are abuses of the right to compete. It was also objectionable to stamp the appellant's name on a similar part of the lamp in raised characters that bear the same general form and appearance. There was no compelling reason for this, and we can hardly doubt its purpose, namely, to aid in misleading miners unacquainted with English. On the other hand, the cartons inclosing the lamps differ in appearance, and the Grier lamp has a self-sparker attached to the rim of the reflector; this too being a valuable aid in distinguishing the lamps. We have not exhaustively described the details of likeness and difference; our main purpose has been to avoid giving the impression that we regard the Baldwin lamp as having the right to exclude all competitors, while protecting that lamp in the trade that has been acquired by legitimate means. We therefore repeat that the precise matter before us is the correctness of the decree, and for the reasons thus outlined, we think it was right. If the appellant desires a ruling from the court below upon a proposed change in the details and appearance of Exhibit No. 6, we have no doubt that a proper application for such a purpose will be entertained and passed upon in a fair and reasonable spirit.

So much of the decree below as refers to the subject of unfair competition is affirmed, but the rest of the decree must be modified in accordance with this opinion; the costs in the District Court and in this court to be equally divided.

11 *Mandate from the Circuit Court of Appeals for the Third Circuit.*

(Filed February 24, 1915.)

UNITED STATES OF AMERICA, ss:

[SEAL.]

The President of the United States of America to the Honorable the Judges of the District Court of the United States for the Western District of Pennsylvania. Greeting:

Whereas, Lately in the District Court of the United States for the Western District of Pennsylvania, before you, or some of you, in a cause between the Grier Brothers Co., Appellant (Defendant below), and F. E. Baldwin and John Simmons Co., Appellees (Plaintiffs below), a decree was duly entered in the said District Court on the 24th day of July, 1914, which decree is of record in the office of the Clerk of said District Court, to which reference is hereby made, and the same is hereby expressly made a part hereof; as by the inspection of the transcript of the record of the said District Court, which was brought into the United States Circuit Court of Appeals for the Third Circuit by virtue of an appeal agreeably to the act of Congress, in such case made and provided, more fully and at large appears.

And whereas, in the present term of October, in the year of our Lord one thousand nine hundred and fourteen, the said cause came on to be heard before the said United States Circuit Court of Appeals on the said transcript of record and was argued by counsel:

On consideration whereof, "It is now here ordered, adjudged and decreed by this Court, that the decree of the said District Court in this cause be, and the same is hereby affirmed as to so much thereof as refers to the subject of unfair competition, but the rest of the decree must be modified in accordance with the opinion of this Court, the costs in the District Court and in this Court to be equally divided;" and that the said Appellant, the Grier Brothers Company, recover against the said Appellees, Frederic E. Baldwin and John Simmons Co., in the sum of nineteen and 60/100 dollars (\$19.60), for its costs herein expended, and have execution therefor;

Philadelphia.

January 22, 1915.

You, therefore, are hereby commanded that such execution and further proceedings be had in said cause, as according to
12 right and justice, and the laws of the United States, ought to be had, the said appeal notwithstanding.

Witness, the Honorable Edward D. White, Chief Justice of the Supreme Court of the United States, at Philadelphia, the twenty-

third day of February, in the year of our Lord one thousand nine hundred and fifteen.

Costs of The Grier Brothers Co.:

Clerk, \$19.60.

Attorney, \$19.60.

SAUNDERS LEWIS, JR.,
*Clerk of the U. S. Circuit Court of
Appeals, Third Circuit.*

United States Circuit Court of Appeals, Third Circuit, October Term, 1914.

Costs of The Grier Brothers Company.

No. 1891.

1914, October Term—

Docketing cause and filing record.....	\$5.00
Appearance, 25c; filing papers, \$5.00.....	5.25
Filing briefs, \$5.00; submission, 20c.....	5.20

1914, October Term—

Transfer	1.00
Filing briefs	5.00

1914, October Term—

Filing papers	50
Filing briefs	5.00

1914, October Term—

Filing briefs, \$5.00; argument, 20c.....	5.20
Judgment, \$1.00; filing same, 25c; recording, 40c; man- date, \$5.00	6.65
Costs and copy	40

39.20

One-half as proportion of Appellee.....\$19.60

Test:

SAUNDERS LEWIS, JR.,
Clerk Circuit Court of Appeals, 3d Circuit.

13 Decree on Mandate from the Circuit Court of Appeals.

(Filed January 5, 1916.)

This cause having been brought on upon the mandate herein sent down from the United States Circuit Court of Appeals for the Third Circuit, and now on file in this Court, by which mandate it appears that an appeal was taken by the above named defend-

ant, Grier Brothers Company, to the United States Circuit Court of Appeals for the Third Circuit, from the decree of this Court entered herein on the 24th day of July, 1914, in favor of the above named plaintiffs, Frederick E. Baldwin and John Simmons Company, against said defendant, Grier Brothers Company, that said appeal was argued by counsel, and that a decree has been entered therein, whereby it is ordered, adjudged and decreed that the said decree of this Court be affirmed as to so much thereof as refers to the subject of unfair competition, but that the rest of the decree must be modified in accordance with the opinion of said United States Court of Appeals for the Third Circuit, and that the costs in this Court, and also the costs of said appeal be equally divided between the plaintiffs and the defendant; the said mandate also directing that such execution and further proceeding be had in said cause as according to right and justice and the laws of the United States ought to be had, the said appeal notwithstanding:

Now, therefore, in compliance with said mandate it is, on motion of Wesley G. Carr, Esq., Solicitor, and of Counsel for plaintiffs herein, ordered, adjudged and decreed:

1st. That the judgment and decree of the United States Circuit Court of Appeals for the Third Circuit be, and the same hereby is, made the judgment and decree of this Court; and that the said decree entered herein on the 24th day of July, 1914, be, and the same is, affirmed and modified, and it is further ordered, adjudged and decreed as follows:

2nd. That the plaintiffs, Frederick E. Baldwin and John Simmons Company, are the sole and exclusive owners of, and alone entitled to manufacture and sell, acetylene gas generating lamps like the lamp manufactured and sold by plaintiffs, identified herein as Plaintiffs' Exhibit No. 1.

3rd. That the defendant, Grier Brothers Company, has invaded and violated the rights of said plaintiffs, Frederick E. Baldwin and John Simmons Company, in the manufacture and sale of acetylene gas generating lamps, in that lamps manufactured and sold by the said defendant and identified as Plaintiffs' Exhibit No.

6, have been so manufactured and sold in unfair imitation of the lamps manufactured and sold by the plaintiffs and identified as Plaintiffs' Exhibit No. 1.

That said plaintiffs do recover from the said defendant such damages for unfair trade, in vending acetylene gas generating lamps like Plaintiffs' Exhibit No. 6, as plaintiffs, or each of them, may be lawfully entitled to recover, and may prove that they have sustained.

4th. And this cause is hereby referred to William F. Knox, Esq., one of the Masters of this Court, to ascertain and report to this Court the damages suffered by the plaintiffs, or either of them, as a result of defendant's sale of said acetylene gas generating

lamps, Exhibit No. 6, or any other lamp, or lamps, sold by defendant in unfair competition with plaintiffs' said Exhibit No. 1.

And the said Grier Brothers Company is hereby directed and required to attend before said Master, from time to time, as required by him, and to render such other detailed accounts, and to produce before him such books, papers and documents as relate to the matters at issue, and to submit to such examination as the Master may require.

5th. It is hereby further ordered, adjudged and decreed that a perpetual injunction be issued forthwith, strictly commanding and enjoining the defendant, Grier Brothers Company, its officers, directors, clerks, servants, agents and workmen, and each and every of them, under the pains and penalties that may fall upon them, and each of them, in case of disobedience, that they forthwith desist and refrain from directly, or indirectly, placing upon the market, or causing to be placed upon the market the acetylene gas generating lamp, identified in this suit as Plaintiffs' Exhibit No. 6, and which is complained of in this case as an imitation of Plaintiffs' Exhibit No. 1, or any other acetylene gas generating lamp, which shall not be so differentiated or distinguished in outward form and appearance from plaintiffs' said lamp, identified as Plaintiffs' Exhibit No. 1, that purchasers thereof will not likely be deceived, by similarity of form and appearance or by accessories sold therewith, into purchasing such lamp made or marketed by defendant, thinking the same to be plaintiffs' lamps; and also from doing any act or thing calculated to induce the belief that acetylene gas generating lamps, not manufactured or offered for sale by plaintiffs, are, in fact, of plaintiffs' manufacture.

6th. That the bill of complaint herein as to infringement of reissue letters patent No. 13,512 in suit be, and the same hereby is, dismissed.

7th. That the costs in this Court be equally divided.

January 5th, 1916.

Per CURIAM.

15 *Certified Copy of Order of the Circuit Court of Appeals for the Third Circuit.*

(Filed March 13, 1918.)

Per Curiam:

Upon consideration of the petition of Plaintiffs-Appellors for leave to file a bill of review against the decree heretofore entered in the United States District Court for the Western District of Pennsylvania in this cause.

It is hereby ordered that the said Plaintiffs-Appellees have leave to make an application to the said District Court to file a bill of review, and that the said District Court be, and the same is, hereby

authorized and empowered to take such action upon said petition as to it seems proper.

Philadelphia, March 12, 1918.

UNITED STATES OF AMERICA,

Eastern District of Pennsylvania,

Third Judicial Circuit, ss:

I, Saunders Lewis, Jr., clerk of the United States Circuit Court of Appeals, for the Third Circuit, do hereby certify the foregoing to be a true and faithful copy of the original order of this Court authorizing District Court to entertain petition for bill of review, in the case of Grier Brothers Company, Defendant-Appellant, vs. Frederick E. Baldwin and John Simmons Company, Plaintiffs-Appellees, on file, and now remaining among the records of the said Court, in my office.

In Testimony Whereof, I have hereunto subscribed my name and affixed the seal of the said Court, at Philadelphia, this twelfth day of March, in the year of our Lord one thousand nine hundred and eighteen, and of the Independence of the United States the one hundred and forty-second.

[SEAL.]

SAUNDERS LEWIS, JR.,

*Clerk of the U. S. Circuit Court of
Appeals, Third Circuit.*

16 *Notice and Petition for Leave to File Bill of Review.*

Together With the Bill of Review Attached to Such Petition and Exhibits "A," "B," and "C," Referred to in Paragraph 5 of said Bill of Review.

(Filed April 11, 1918.)

Notice.

SIRS:

Please take notice that we shall petition this Court, in the Court Room of said Court, in the City of Pittsburgh, Pa., on the — day of April, 1918, at 10:30 A. M., on that day, or as soon thereafter as counsel can be heard, for leave to file the annexed bill of review, and for such other and further relief as may be just and proper in the premises.

Dated April 11th, 1918.

Respectfully,

KELLER & BAKEWELL,

Attys for Petitioners.

To Messrs. Bakewell & Byrnes,

Attys for The Grier Brothers Co.,
Pittsburgh, Pa.

Due service of the within notice, petition and bill of review is hereby admitted this 11th day of April, 1918.

BAKEWELL & BYRNES,

Attys for The Grier Brothers Co.

Petition for Leave to File Bill of Review.

To the Honorable the Judges of the District Court of the United States, Western District of Pennsylvania:

And now, come your petitioners, Frederic E. Baldwin and John Simmons Company, plaintiffs in the above entitled cause, and respectfully represent:

1. That prior to the 12th day of March, 1918, they petitioned the United States Circuit Court of Appeals for the Third Circuit, for leave to file a bill of review against the decree entered by this Court in this cause on or about January 5, 1916, a copy of the notice, motion, petition and the papers therein referred to being annexed hereto.

17 2. That on or about the 12th day of March, 1918, the said Circuit Court of Appeals for the Third Circuit, after consideration of said petition and the documents thereto annexed, entered an order granting leave to said plaintiffs to make an application to this Court to file said bill of review and authorizing and empowering this Court to take such action upon the petition as seem to it proper, a copy of said order being hereto annexed, the original being on file in this Court.

Wherefore, Your petitioners respectfully petition this Court for leave to file the annexed verified bill of review, and, to permit the taking of all pertinent and necessary proceedings thereunder.

KELLER & BAKEWELL,

Attys for Petitioners, Oliver Building, Pittsburgh, Pa.

JAMES Q. RICE,

Of Counsel.

Bill of Review.

And now come Frederic E. Baldwin and John Simmons Company, the above named plaintiffs, and show:

1. That on or about the 4th day of October, 1913, the plaintiffs herein filed their bill of complaint in this Honorable Court, against the Grier Brothers Company, alleging, by reason of the sale of certain miner's carbide cap lamps, identified in said cause as Exhibit 6, infringement of reissue letters patent to Frederic E. Baldwin, No. 13,542, dated March 11, 1913, of which said Frederic E. Baldwin is the owner and under which John Simmons Company is the sole licensee, and also alleging that the defendant, The Grier Brothers Company, to be guilty of unfair competition in trade by reason of the sale of said lamp.

2. That after due proceedings had, a hearing was had therein on full proofs and briefs submitted, and that on the 7th day of July, 1914, his Honor, Judge Orr, handed down an opinion (215 Fed.,

735) finding said reissue patent valid and infringed by said defendant and said defendant guilty of unfair competition in trade; that on the 24th day of July, 1914, an interlocutory decree was duly entered, in accordance with said opinion.

3. That defendant thereupon took an appeal to the Circuit Court of Appeals for the Third Circuit; that after due proceedings the cause came on for hearing before said Court of Appeals, both parties being represented by counsel and full briefs submitted; that on the 22nd day of January, 1915, said Court of Appeals handed down an opinion (219 Fed., 735) reversing the decree of this Court so far as it related to the validity of said reissue patent No. 13,542, on the ground that said reissue patent was invalid, stating that "the authorities settle the proposition that a reissue cannot be allowed to

18 broaden the original patent (as Baldwin attempted to do), especially after such a lapse of time as seven years, and after the claim had been limited by a final adjudication;" that said Court of Appeals affirmed the decree of this Court as to the question of unfair competition in trade; that thereafter the mandate of said Court of Appeals was duly sent down to this Court, and, in accordance therewith, this Court, on the 5th day of January, 1915, entered an interlocutory decree referring this cause to a master; and that proceedings are still pending before the master.

4. That on the 29th day of May, 1913, a bill was filed in the District Court of the United States for the Southern District of New York, by Frederic E. Baldwin, one of the plaintiffs herein, against Abercrombie & Fitch Company, alleging infringement of said reissue patent 13,542, because of the sale by said Abercrombie & Fitch Company, of a certain miner's carbide cap lamp, said lamp corresponding in all essential features of construction with the lamp Exhibit 6 complained of in this cause; that thereafter, John Simmons Company, of New York, sole licensee, intervened as party plaintiff and Justrite Manufacturing Company, of Chicago, Ill., makers of the lamp sold by Abercrombie & Fitch Company, intervened as party defendant; that after due proceedings had, the said cause was tried before his Honor, Judge Mayer, full proofs having been adduced, and full briefs submitted by both parties; that thereafter, on the 8th day of February, 1915, Judge Mayer handed down an opinion (227 Fed., 455) holding said reissue patent No. 13,542 valid and infringed; that on the 10th day of February, 1915, an interlocutory decree was duly entered in accordance with said opinion; that thereafter said defendants, Abercrombie & Fitch Co., and Justrite Manufacturing Company, took an appeal to the Circuit Court of Appeals for the Second Circuit, and on the 9th day of November, 1915, after full hearing, both parties being represented by counsel and full briefs submitted, said Circuit Court of Appeals handed down an opinion (228 Fed., 895) affirming the decree of the Court below; and that the mandate of said Circuit Court of Appeals of the Second Circuit was duly sent down, and on the 23rd day of November, 1915, an order in accordance therewith was duly entered; and

5. That, thereafter, on the 20th day of December, 1915, said defendants, Abercrombie & Fitch Company and Justrite Manufacturing Company, petitioned the Supreme Court of the United States for a writ of certiorari, the ground of said petition being the differing decisions between the Court of Appeals of the Second Circuit and the Court of Appeals of the Third Circuit on the same state of facts; that the Supreme Court of the United States, on the 10th day of January, 1916, granted said writ of certiorari, and after due proceedings the case was fully argued in said Supreme Court by counsel for both sides, full briefs being submitted, that thereafter, on the 19 10th day of December, 1917, said Supreme Court handed down its decision affirming the decision of the Court of Appeals of the Second Circuit, and holding said Baldwin reissue patent valid and infringed, a certified copy of said opinion being now on file in this Court, marked "Exhibit A"; that on the 15th day of January, 1918, the Supreme Court sent down its mandate to the District Court of the United States for the Southern District of New York, a certified copy of said mandate being now on file in this Court and marked "Exhibit B"; and that an order was duly entered thereon in said District Court of the Southern District of New York, on the 18th day of January, 1918, a certified copy of said order being now on file and marked "Exhibit C."

6. Plaintiffs therefore respectfully represent that new facts have arisen since said decree was entered in this Court on the 5th day of January, 1916, which the record in this case should contain and that said decree is erroneous and contrary to law, insofar as, pursuant to the opinion of said United States Circuit Court of Appeals for the Third Circuit, it dismisses the bill as to infringement of reissue letters patent No. 13,542; insofar as it decrees that the costs in this Court be equally divided; insofar as it fails to decree that said letters patent is valid and infringed by said Grier Brothers Company; insofar as it fails to decree that a perpetual injunction be issued enjoining said The Grier Brothers Company from further infringement of said reissue letters patent 13,542; and insofar as it decrees that the cause be referred to a master only to ascertain and report to this court the damages suffered by the plaintiffs, or either of them, as a result of defendant's sale of said acetylene gas generating lamps Exhibit No. 6, or any other lamp or lamps sold by said defendant and in unfair competition with Exhibit No. 1; and that said decree works and will work great injustice and impose great hardship upon your petitioners.

7. Plaintiffs, therefore, respectfully pray that this cause may be reopened; that they be permitted to take evidence to establish the new condition of facts recited herein and which have arisen since the decree in this Court was entered; that a new final hearing be had; that said decree be rescinded and set aside insofar as it dismisses the bill of complaint as to infringement of said reissue letters patent No. 13,542, and insofar as it refers the cause to the master to ascertain and report to this court only the damages suffered by the plaintiffs, or either of them, as a result of defendant's sale of said acetylene

gas generating lamp Exhibit No. 6 or any other lamp or lamps sold by defendant in unfair competition with Plaintiffs' said Exhibit No. 1; and that a new decree be entered in this cause, granting the relief prayed for in the original bill of complaint in this cause now on file in this court; that plaintiffs have such other and further relief as the circumstances of the case may require; and that a writ of subpoena ad respondendum issue to the said The Grier Brothers Company to show cause, if any there be, why the relief herein prayed for should not be granted.

[Corporate Seal.]

JOHN SIMMONS CO.
CHAS. H. SIMMONS,
Pres't.

KELLER & BAKEWELL,
Att'ys. for Plaintiff,
Oliver Building,
Pittsburgh, Pa.

JAMES Q. RICE,
Of Counsel,
220 Broadway, N. Y. City.

STATE OF NEW YORK,
County of New York, ss:

Charles H. Simmons, being first duly sworn, deposes and says, that he is the President of John Simmons Company, one of the complainants above named; that he has read the foregoing bill of review subscribed by him on behalf of said company, and knows the contents thereof, and that the same is true of his own knowledge.

CHAS. H. SIMMONS.

Subscribed and sworn to before me this 9th day of April, 1918.

[SEAL.]

PHILLIP WIEGAND,
Notary Public.

Bronx County No. 30,
New York County No. 34,
New York Register's No. 10,045.

EXHIBIT A.

Supreme Court of the United States, October Term, 1917.

No. 67.

ABERCROMBIE & FITCH COMPANY and JUSTRITE MANUFACTURING
COMPANY, Petitioners,

VS.

FREDERICK E. BALDWIN and JOHN SIMMONS COMPANY.

On Writ of Certiorari to the United States Circuit Court of Appeals
for the Second Circuit.

[December 10, 1917.]

Mr. Justice McKENNA delivered the opinion of the Court.

Suit for infringement of a patent embraced in letters patent No. 821,580 and a re-issue thereof, No. 13,542.

The suit was originally brought by Frederick E. Baldwin, patentee, John Simmons Company, licensee, having the exclusive right to manufacture and sell the patented device, subsequently intervened and became complainant.

The patents are for a lamp designed to generate and burn acetylene or similar gas "intended for use," to quote the description of the patents, "and adapted to use as a bicycle, automobile, yacht, or miner's lamp, or for any other analogous purpose, it being necessary only to change its form or dimensions to adapt it to any one of the purposes mentioned." Stress in this case, however, is put upon the use of the asserted invention as a miner's lamp, such use conspicuously displaying its commercial utility.

Answer was filed by the Justrite Manufacturing Company, who was made a party defendant to the suit as manufacturer of the asserted infringing lamp, and by stipulation its answer was considered the answer of the Abercrombie & Fitch Company. It denied invention with great detail, set up anticipating patents, denied its utility, attacked the validity of the re-issue on the ground that the 1st and 4th claims of the original patent were held invalid by the United States Circuit Court of Appeals for the Seventh Circuit, 199 Fed., 133, and for the further reason that the application for the re-issue was not made until seven years after the original letters patent were issued and rights had accrued in the meantime to defendants (petitioners here) and to others. Infringement was denied.

A decree was passed sustaining the validity of the original patent and of the re-issue, the originality of the invention and its utility and adjudging defendants (petitioners) had infringed claim 4 of the re-issue, that plaintiffs recover the damages they had incurred by reason of the infringement and the profits defendants had received, an accounting being ordered for this purpose. A perpetual injunction was also adjudged against further infringements. — Fed. —. The decree was affirmed in all respects by the Circuit Court of Appeals and subsequently this certiorari was granted.

The plaintiffs (we shall so designate respondents) struggled through some years and some litigation to the success of the decrees in the pending case. In a suit brought in the District Court for the Southern District of Illinois a device like that of the defendant herein was held to be an infringement of certain claims of the original patent. The holding was reversed by the Circuit Court of Appeals for the Seventh Circuit. *Bleser vs. Baldwin*, 199 Fed. 133.

Subsequently, the re-issue having been granted, suit was brought in the Western District of Pennsylvania against an asserted infringer. Unfair competition was also alleged, and, holding the latter to exist, the court granted a preliminary injunction (210 Fed., 560). Upon

final hearing that holding was repeated, and infringement of a claim of the re-issue patent decreed. 215 Fed., 735. The decree was reversed by the Circuit Court of Appeals (Third Circuit) on the ground that the claim of the re-issue patent found to have been infringed was broader than a corresponding claim of the original letters patent and therefore void. The holding of the District Court as to unfair competition was sustained. 219 Fed., 735. Aided by the reasoning in the opinions of those cases and the discussion of counsel, we pass to the consideration of the proposition in controversy.

First, as to the original patent. Its contribution to the world instrumentalities was, as we have said, an acetylene lamp and was represented by the following figure, designated as Figure 1.

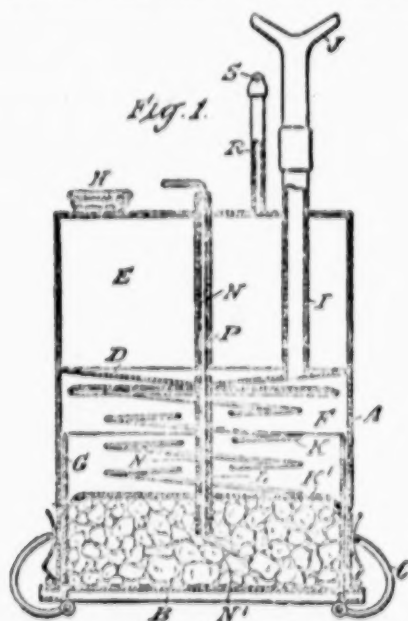


Fig. 1.

It will be observed that the device consists of a receptacle divided into two compartments, an upper one for water and a lower one designed to serve as a gas-generating chamber, adapted to contain a receptacle for calcium carbide, which is attached to and forms the detachable bottom. There are means of introducing water into the reservoir and thence to the carbide and means of conducting the gas to the burner.

The device is a means of using the gas (acetylene) formed by the decomposition of water with calcium carbide and necessarily must bring them into contact in an effectual way and use the gas generated in a controlled flow. A tube (L) hence leads from the water reservoir into the carbide receptacle and forms a duct which introduces the water into the body of the carbide. Various means, the specifications recite, have been employed to regulate or control the flow of water to the carbide, which were found objectionable or not adequate.

The patentee then says that the method which he has invented "for securing the proper feed under all circumstances" without "objectionable features is to make the bore of the duct of comparatively large size and then restrict the duct by means of a wire or rod preferably centrally located therein to leave a channel of the proper size."

It is then said: "This arrangement is simple; but in a long experience it has been found to be entirely successful. It is possible to secure the correct drop-by-drop feed with a duct of considerable size, since the friction of the water on the large area of the tube wall and wire reduces its flow. This retarding friction may be regulated by varying the size of wire used. The duct does not become choked, since if foreign particles are deposited therein the water can take a zigzag course around it without the supply being appreciably affected. If it is at any time necessary to clean the tube, the wire is simply reciprocated and rotated a few times from the outside of the lamp without disturbing the position of other parts. This nice regulation of the flow enables me to entirely dispense with the troublesome adjustment of the valve. * * * In some cases, however, there is employed in connection with the means for introducing water into the mass of carbide a device in the nature of a stirrer, which on proper manipulation may be used to break up the mass of carbide surrounding the outlet of the water duct and which by having become slaked and caked by the action of the water prevents the proper percolation of the latter to the unslaked carbide in the receptacle G, Fig. 1. As such device I employ a stem or rod N, which extends down through the tube L, and is bent at substantial right angles to form an arm N'."

There is also a figure attached to the patent which shows a valve upon the constricting rod and it is said "this rod may form a prolongation of the valve stem * * * or in case no valve is used may extend from the top of the lamp down through the water-reservoir," and this is illustrated by figures.

"As calcium carbide possesses strongly absorptive properties, the introduction of water through the tube L will result in the gradual

slaking of the material about its outlet; but the lime thus produced becomes gradually less permeable to the water, so that an
 24 insufficient quantity of gas is generated to maintain the proper flame. When this becomes noticeable, the rod N is turned, so as to cause the arm N' to break up to a greater or less extent the mass of lime, and in practice I have found that under ordinary conditions this is amply sufficient to insure a substantially uniform generation of gas until all of the carbid in the receptacle G is exhausted.

There are some further descriptive details not necessary to be repeated, and this was said: "The specific construction of the various parts of my lamp may be, as will be seen from a consideration of the nature of the improvements, very greatly varied without departing from the invention."

The claims of the patent which are pertinent to our inquiry are as follows:

"1. In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbid, of a tube extending from the former a considerable distance into the latter so as to be embedded in the mass of carbid contained in said receptacle, and a rod or stem extending through said tube into the carbid-receptacle and having its end formed as a stirrer to break up the slaked carbid around the outlet of the water-tube, as set forth.

"2. In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbid, of a tube extending from the former into the latter so as to be embedded in the mass of carbid contained in the receptacle, a rod extending from a point outside of the lamp through the tube and into the carbid-chamber and having its end bent to form a stirrer for breaking up the slaked carbid around the outlet of the water-tube, as set forth.

* * * * *

"4. In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbid, of a water-tube extending from the former a considerable distance into the latter and adapted to be embedded in the mass of carbid in the receptacle, and a rod extending through the water-tube, and constituting a stirrer to break up slaked carbid around the outlet of the water-tube, *the rod operating to restrict and thus control the flow of water to the carbid, as set forth.*"

The words in italics are the addition of the re-issue.

Whether the lamp exhibits invention, when both patents are considered, we shall discuss later. Our attention is more immediately challenged by the stress put upon other defenses, especially upon
 25 the contention that the patent is confined to a special form and, so confined, is not infringed; and that the extension of the patent by the re-issue is void. The controversy is, therefore, brought to a consideration of the original patent as added to or developed by the re-issue. And their comparison centers in the

water-feeding duct or tube and its restriction by means of a wire or rod and the shape and use of the rod to pierce or stir the carbide. In the original patent, as we have seen, it was said that the invented method for securing a proper feed (flow of the water to the carbide) without certain specific objectionable features was "to make the bore of the duct of comparatively large size and then restrict the duct by means of a wire or rod preferably centrally located therein to leave a channel of the proper size." In the re-issue, after the words "comparatively large size," it was added—"extend the tube which forms the duct downward so that its end will be always embedded in the carbid." In other words, the tube is explicitly described as extending to and its end embedded in the carbide, and this, it is contended, was an enlargement of the original patent.

The contention is untenable if there was in the original patent an implication of such length and termination of the tube, and we think there was. To conduct water to the carbide it necessarily had to extend to the carbide receptacle and as necessarily had to penetrate the carbide if the rod located in it, whether straight or bent, was to act "in the nature of a stirrer, which on proper manipulation" might "be used to break up the mass of carbid surrounding the outlet of the water duct," which is the purpose that the patent ascribes to it. And Fig. 1 shows such ending and embedding. It would be impossible otherwise to perform its function or secure the "proper percolation" of the water "to the unslaked carbid in the receptacle G, Fig. 1."

But there was another addition in the re-issue which, it is contended, enlarges the invention and assigns a new shape and function to the stirrer of the original. In the latter the rod is described as extending "from the top of the lamp down through the water-reservoir, as shown in Fig. 3." To this the re-issue adds:

"It will be understood from what has been said that the function of the stirrer is to break up, pierce or disturb the particles of the slaked carbid mass which, when the lamp is in use, forms at the delivery end of the tube. This slaked carbid mass tends to solidify and either shuts the water off altogether or restricts it so that less water is delivered from the water-tube than the lamp demands for efficient operation. As it is sufficient, under the certain circumstances, to insure the requisite water flow by so manipulating the stirrer, as to pierce, break up, or loosen the slaked carbid mass immediately around or at the mouth of the tube, it is obvious that the stirrer need not always be formed with a bent end or so as to extend radially from the mouth of the tube."

There is nothing in this but what was clearly implied in the original, except the shape of the stirrer. In the original it is described and represented as bent. In the re-issue it is stated to be obvious that the stirrer need not always be bent "or extend radially from the mouth of the tube."

We are unable to assign to this the extent of alteration that counsel do, nor do we think it necessary to rehearse the details of their argument. We have given it attention and the cases it cites, espe-

cially the decision and reasoning of the Circuit Court of Appeals of the Third Circuit in *Baldwin et al vs. Grier Bros. Co.*, 219 Fed., 735, but we are constrained to a different conclusion. Indeed, we are of opinion that the original patent did not need the exposition of the re-issue. It exhibited an invention of merit, certainly one entitled to invoke the doctrine of equivalents. *Paper Bag Patent Case*, 210 U. S., 405. Baldwin, the patentee, complied with the statute (§4888 R. S.) by explaining the principle of his invention and the mode of putting it to practical use; there was a clear exposition of the principle and the instruments of its use were defined and their purpose and manner of operation. It left nothing in either for further experiment or contrivance. As we have said, the invention was a means of using the gas formed by the decomposition of water with calcium carbide, and necessarily the water and carbide must be brought into contact and under a controlled flow; hence the tube and its centrally located rod extending downward to the carbide. It was foreseen and stated that the carbide might become torpid or slaked by the action of the water and might have to be disturbed or dispursed in order that there might be percolation of water to unslaked carbide, and this was provided to be performed by a simple manipulation of the rod. Whether the rod was bent or made straight was unimportant. In either form it removed the slake and secured the continuous operation of the water and carbide and through them the formation of the gas and its illuminating purpose. One or the other might be better, according to the extent of the dispersion required, and one naturally suggested the other.

It is, however, contended that plaintiffs were required to give up and did give up in the Patent Office a claim which had the extent which we have indicated. A claim, numbered in the application as 6, described the rod as: "A rod extending from a point outside the lamp through the tube into the carbide receptacle."

Counsel say, "It is to be particularly noted" that while other claims "mentioned the stirring function of the rod, claim 6 omitted this feature," but that the solicitor who drew the claim "unquestionably had in mind the straight form of rod construction without any stirrer at the end, for the claim specifies 'through the tube into the carbide receptacle.'" It is hence argued that when the claim was given up the straight form of construction was given up, and, having been given up to secure the patent, it cannot be insisted upon to prevent its use by others. But counsel is in error as to the extent of the surrender. The straight construction was not given up, but such construction through the tube into the carbide receptacle, and this was in deference, and only in deference, to other patents that showed such use, that is, showed a penetration into the receptacle but not its duct ending and embedded in the carbide.

We do not think the case calls for extended discussion. It is best considered in broad outline. The scope and merit of the patents are of instant and assured impression, and to the attempt to defeat or limit their invention by the state of the prior art we adduce the discussion and reasoning of the opinions of the lower courts, which we approve.

The denial of infringement is also easily disposed of. Indeed, it has been in effect disposed of. It is based on the contention that the stirrer is an essential of plaintiff's lamp and that a stirrer is absent from defendant's lamp, which is in all other particulars, as far as this case is concerned, similar to the plaintiff's lamp. To the contention of defendants, therefore, we cannot assent. There is a stirrer in both, and its form, as we have seen, is not of the essence of the invention. There is nothing occult in the act of stirring; it is causing movement or disturbance, and this may be performed by a straight rod as by a bent one. There may be difference in their dispersing power, but no difference in function, and one or the other would be instantly selected according to the need, under the clear description of the patent. This ready adaptation of the form of stirrer to the work to be performed Baldwin demonstrated even before the grant of the patent. Early in 1906 he put upon the market a lamp with a straight rod, "which, among other things," as the District Court has said, "has characterized the commercial lamp ever since."

To the contention that the Justrite Company, the manufacturing defendant, acquired rights before the re-issue we again may oppose the reasoning and conclusion of District Judge Mayer and their affirmation by the Circuit Court of Appeals. The learned Judge said:

"It will be remembered that this company entered the field with its lamp at a time when the validity and scope of the Baldwin patent were still unquestioned and when after some five years of capable effort, the Baldwin lamp had created an extensive market. The

Justrite Company took its chances and, in view of the necessities of the situation, it is relieved of all accountability for the period prior to the granting of the re-issue patent; but when the re-issue statute was granted the Justrite Company again took its chances.

"By the reissuance of the patent, the patentee loses all in the way of an accounting under the original patent, but the dominant purpose of the re-issue statute was to serve to the inventor the future remaining after the re-issue.

"I see nothing in the course of plaintiffs or defendants which would allow a court of equity to conclude that defendants are to be relieved because of intervening rights."

Decree affirmed.

EXHIBIT B.

Mandate of Supreme Court.

UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the Honorable the Judges of the District Court of the United States for the Southern District of New York, Greeting:

Whereas, Lately in the United States Circuit Court of Appeals for the Second Circuit, in a cause between Abercrombie & Fitch Com-

pany and Justrite Manufacturing Company, appellants, and Frederic E. Baldwin and John Simmons Company, appellees, wherein the decree of the said Circuit Court of Appeals, entered in said cause on the 19th day of November, A. D. 1915, is in the following words, viz:

"This cause came on to be heard on the transcript of record from the District Court of the United States for the Southern District of New York, and was argued by counsel.

On Consideration Whereof, It is now hereby ordered, adjudged and decreed that the decree of said District Court be and it hereby is affirmed with costs.

It Is Further Ordered That a Mandate issue to the said District Court in accordance with this decree.

E. H. L."

as by the inspection of the transcript of the record of the said United States Circuit Court of Appeals which was brought into the
29 Supreme Court of the United States by virtue of a writ of certiorari, agreeably to the act of Congress, in such case made and provided, fully and at large appears.

And Whereas, In the present term of October, in the year of our Lord one thousand nine hundred and seventeen, the said cause came on to be heard before the said Supreme Court, on the said transcript of record, and was argued by counsel:

On Consideration Whereof, It is now here ordered, adjudged and decreed by this Court that the decree of the said United States Circuit Court of Appeals in this cause be, and the same is hereby affirmed with costs, and that the said appellees, Frederic E. Baldwin et al. recover against the said appellants for their costs herein expended and have execution therefor.

And It Is Further Ordered, That this cause be, and the same is hereby, remanded to the District Court of the United States for the Southern District of New York.

December 10, 1917.

You, Therefore, Are hereby commanded that such execution and proceedings be had in said cause, as according to right and justice, and the laws of the United States, ought to be had, the said writ of certiorari notwithstanding.

Witness, The Honorable Edward D. White, Chief Justice of the United States, the fifteenth day of January, in the year of our Lord one thousand nine hundred and eighteen.

JAMES D. MAHER,

[SEAL.] *Clerk of the Supreme Court of the United States.*

Costs of Appellee:

Clerk.
Printing Record.
Attorney.
Paid by Appellants.

(Endorsed:) File No. 25,050. Supreme Court of the United States, No. 67, October Term, 1917. Abercrombie & Fitch Company et al. vs. Frederic E. Baldwin et al. Mandate. U. S. District Court, S. D. of N. Y. Filed Jan. 18, 1918.

A true copy.

[SEAL.]

ALEX. GILCHRIST, JR.

30

EXHIBIT C.

At a Stated Term of the District Court of the United States for the Southern District of New York, Held in the United States Court House and Post Office Building, Borough of Manhattan, City of New York, on the 18th Day of January, 1918.

Present: Martin T. Manton,

In Equity. 10-219.

FREDERIC E. BALDWIN and JOHN SIMMONS COMPANY, Intervenor,
Plaintiffs,

vs.

ABERCROMBIE & FITCH COMPANY and JUSTRITE MFG. COMPANY,
Intervenor, Defendants.

This cause having been brought on upon the Mandate sent down from the Supreme Court of the United States and now on file in this Court, by which Mandate it appears that a petition for a writ of certiorari was filed by the above-named defendants, Abercrombie & Fitch Company and Justrite Mfg. Company, in the Supreme Court of the United States, which writ was granted January 10, 1918, and that such writ was argued by counsel, and that a decree has been entered herein, whereby it is ordered, adjudged and decreed that the decree of the United States Circuit Court of Appeals in this case be affirmed with costs; the said mandate further ordered that this cause be remanded to the District Court of the United States for the Southern District of New York; the said Mandate also directing that such execution and proceedings be had in said cause as according to right and justice, and the laws of the United States, ought to be had, the said writ of certiorari notwithstanding.

Now, Therefore, In compliance with said Mandate, it is on motion of Messrs. Phillip, Sawyer, Rice & Kennedy, solicitors and of counsel for plaintiffs herein.

Ordered, Adjudged and Decreed, That the judgment and decree of the Supreme Court of the United States be, and the same is hereby, made the judgment and decree of this Court; that the decree entered herein on or about the 10th day of February, 1915, be, and the same is hereby affirmed with costs to the plaintiffs to be taxed.

MANTON,
U. S. D. J.

31

Answer.

(Filed May 11, 1918.)

United States District Court, Western District of Pennsylvania,
October Term, 1913.

In Equity. No. 26.

FREDERIC E. BALDWIN and JOHN SIMMONS CO., Plaintiffs,

vs.

THE GRIER BROTHERS COMPANY, Defendant.

Answer of The Grier Brothers Company, Defendant, to the Bill of Review of Frederic E. Baldwin and John Simmons Company, Plaintiffs.

1. The defendant admits the allegations of paragraph 1 of the Bill of Review, except that the defendant is without knowledge as to whether or not Frederic E. Baldwin is the owner of re-issue letters patent No. 13,542 and John Simmons Company is the sole licensee thereunder.

2. Defendant admits the allegations of paragraph 2 of the Bill of Review.

3. Defendant admits the allegations of paragraph 3 of the Bill of Review.

4. Defendant denies that the miner's carbide lamp involved in the suit of Baldwin vs. Abercrombie & Fitch Company corresponded in all essential features of construction with the lamp Exhibit G complained of in this cause, as alleged in paragraph 4 of the Bill of Review. The defendant is without knowledge as to the remaining allegations of paragraph 4 of the Bill of Review.

5. The defendant is without knowledge of the allegations contained in paragraph 5 of the Bill of Review. The defendant avers that the decisions of the Court of Appeals of the Second Circuit and the Court of Appeals of the Third Circuit were not rendered "on the same state of facts."

6. The defendant denies that any new facts have arisen since the decree was entered in this Court on January 5, 1916, which the record in this case should contain, and the defendant further denies that said decree is erroneous or contrary to law as alleged in paragraph 6 of the Bill of Review. The defendant further denies that said decree works, or will work, any injustice or hardship upon the plaintiffs.

7. The defendant avers that the facts alleged in said Bill of Review form no basis for a Bill of Review in this cause; and fur-

32 ther avers that while the same is entitled a Bill of Review, it is in fact only a petition for rehearing because of the decision of the Supreme Court referred to therein. The defendant further alleges that the decision of the Court of Appeals for the Third Circuit denying the validity of said reissue patent No. 13,542 is final as between the plaintiffs and this defendant. The defendant further alleges that the decision of the Supreme Court of the United States in the suit against Abercrombie & Fitch Company forms no basis for a Bill of Review in the suit against this defendant.

Wherefore, The defendant denies that the plaintiffs are entitled to the relief prayed for or any part thereof and the defendant prays to be hence dismissed with reasonable costs and charges in this behalf most wrongfully sustained.

THE GRIER BROTHERS COMPANY,
By BAKEWELL & BYRNES,

Its Solicitors,

C. P. BYRNES,
THOMAS STEPHEN BROWN,
Of Counsel.

Petition and Order Granting Leave to File Supplemental Bill.

(Filed January 10, 1919.)

Pittsburgh, January 6th, 1919.

Messrs. Bakewell & Byrnes,
Farmers Bank Building, Pittsburgh, Pa.

SIRS:

Please take notice that I shall present the accompanying petition and supplemental bill to the Court on Friday, January 10th at 10 o'clock A. M.

Very respectfully,

JAMES K. BAKEWELL,

Service acknowledged this 6th day of Jan., 1919.

BAKEWELL & BYRNES,
Att'ys for Grier Bros. Co.

Petition.

To the Honorable the Judges of the District Court of the United States for the Western District of Pennsylvania:

33 The petition of John Simmons Company, one of the above named plaintiffs, respectfully shows that on or about the 4th day of October, 1913, it and Frederic E. Baldwin filed their bill of complaint in this court against the above named defendant, Grier Brothers Company, alleging among other things infringement by said Grier Brothers Company of reissue patent No. 13,542, granted March 11, 1913, to Frederic E. Baldwin; that after due proceedings

had this court found said patent valid and infringed, and a decree was accordingly entered in the suit; that thereafter the United States Circuit Court of Appeals for the Third Circuit reversed the decree of this court so far as it related to the validity of said patent 13,542; that thereafter the Supreme Court of the United States in a suit which originated in the United States District Court for the Southern District of New York, said suit being entitled *Frederic E. Baldwin and John Simmons Company vs. Abercrombie & Fitch Company and Justite Manufacturing Company*, on a writ of certiorari, held said reissue patent valid and infringed; that thereafter the plaintiffs in this cause presented a Bill of Review to this court with petition for leave to file the same on the 26th day of April, 1918, this court ordered said bill on file; that on or about the 10th day of May, 1918, the defendant herein, Grier Brothers Company, filed its answer to said Bill of Review; that thereafter, to wit, on the 9th day of July, 1918, said John Simmons Company acquired and has ever since owned the entire right, title and interest of said Baldwin in any recoveries for costs, damages and profits in this suit and in and to said letters patent 13,542, dated March 11, 1913, together with all claims and demands both at law and in equity, that the said Frederic E. Baldwin had or may have for damages and profits accrued or to accrue on account of the infringement of said letters patent, as appears by the annexed verified copies of assignments which are marked "Assignment Exhibit A," and "Assignment Exhibit B."

Your petitioner, therefore, prays that leave be granted it to file in this cause, its supplemental bill submitted herewith setting forth the change in title which has occurred as hereinbefore stated.

JOHN SIMMONS CO.,

[CORPORATE SEAL.]

CHAS. H. SIMMONS,

Pres't.

And now, to wit, January 10th, 1919, on motion of Keller & Bakewell, solicitors for complainants, the prayer of the foregoing petition is granted.

Per CURIAM

STATE OF NEW YORK,

County of New York, ss:

Thomas F. Kehoe, being first duly sworn, deposes and says:

I am of lawful age, and am managing clerk for Phillips, Sawyer, Rice & Kennedy, of counsel for plaintiffs in the above entitled cause.

I have compared the copies of assignments marked "Assignment Exhibit A" and "Assignment Exhibit B," annexed to the petition, with the original instruments, and they are true and correct copies thereof.

THOMAS F. KEHOE.

Subscribed and sworn to before me this 2nd day of January, 1919.

[SEAL.]

AUGUSTA WHITE,

Notary Public, N. Y. Co.

ASSIGNMENT, EXHIBIT A.

Whereas, Frederic E. Baldwin, of Philadelphia, Pennsylvania, is the owner of the entire right, title and interest in and to certain Letters Patent of the United States, as follows:

Reissue No. 13,542, March 11, 1913, for Acetylene Gas Generating Lamp;

No. 1,066,241, July 1, 1913, Reflector for Lamps;

No. 1,070,000, August 12, 1913, Acetylene Lamp and Generator;

No. 1,075,960, October 14, 1913, Non-Clogging Burner-tip;

No. 1,077,582, November 4, 1913, Acetylene Gas Lamp;

No. 1,083,427, January 6, 1914, Acetylene Lamp;

No. 1,094,358, April 21, 1914, Miner's Lamp;

No. 1,099,908, June 16, 1914, Lamp;

No. 1,101,982, June 30, 1914, Miner's Lamp;

No. 1,115,157, October 27, 1914, Acetylene Gas Lamp;

No. 1,174,035, March 7, 1916, Miner's Gas Burning Lamp;

No. 1,174,036, March 7, 1916, Acetylene Lamp;

No. 1,174,037, March 7, 1916, Acetylene Lamp;

No. 1,174,112, March 7, 1916, Acetylene Lamp;

No. 1,237,449, August 21, 1917, Miner's Lamp;

No. 1,237,450, August 21, 1917, Miner's Lamp;

No. 994,365, June 6, 1911, Acetylene Gas Burner;

and

Whereas, John Simmons Company, a corporation of the State of New York, is desirous of obtaining the entire right, title and interest in and to said Letters Patent, and the inventions and improvements therein contained, and all claims and demands, both at law and in equity that the said Frederic E. Baldwin has, or may have, for damages and profits accrued or to accrue on account of the infringement of said Letters Patent,

Now, to all whom it may concern: Be it known that for and in consideration of the sum of one dollar, lawful money of the United States, to him paid by the said John Simmons Company, and for other good and valuable considerations from it to him moving, the receipt of which is hereby acknowledged, the said Frederic E. Baldwin has sold, assigned, transferred and set over, and does hereby sell, assign, transfer and set over, unto the said John Simmons Company, its successors and assigns, the entire right, title and interest in and to the said improvements and the aforesaid Letters Patent, and any and all reissues and extensions of the same, throughout the United States and the Territories thereof; the same to be held and enjoyed by said John Simmons Company, its successors and assigns, as fully and entirely as the same would have been held and enjoyed by me if this assignment and sale had not been made.

And for the before-mentioned consideration, said Frederic E. Baldwin has assigned, sold and set over, and does by these presents

assign, sell and set over, unto the said John Simmons Company, its successors and assigns, all claims and demands, both at law and in equity that he has or may have, for damages and profits accrued or to accrue on account of the infringement of any of said Letter Patent, and he does hereby authorize and empower the said John Simmons Company, its successors or assigns, to sue for in its or their own names and collect for its or their own use all such claims and demands.

And for the before-mentioned consideration, said Frederic E. Baldwin does hereby covenant and agree that he will execute any papers and perform any acts that said John Simmons Company, its successors or assigns, may deem necessary or expedient to vest in the said John Simmons Company, its executors and assigns, the entire right, title and interest in and to said Letters Patent and any reissues and extensions thereof, and any and all claims and demands, both at law and in equity, that he has or may have, for damages and profits accrued or to accrue on account of the infringement of any of said Letters Patent.

And for the before-mentioned considerations, said Frederic E. Baldwin does hereby covenant and agree that he will, at the request and charges of said John Simmons Company, its successors or assigns, execute any and all applications and other papers and perform any acts to secure the reissue or extension of any of said Letters Patent that said John Simmons Company, its successors or assigns, may deem necessary or expedient.

In Witness Whereof, Said Frederic E. Baldwin has hereunto set his hand and seal this 9th day of July, 1918.

FREDERIC E. BALDWIN.

STATE OF NEW YORK,

County of New York, ss:

On this 9th day of July, 1918, before me personally came Frederic E. Baldwin, to me known and known to me to be the individual described in and who executed the foregoing instrument and acknowledged to me that he executed the same.

AUGUSTA WHITE,

[SEAL.]

Notary Public, N. Y. Co.

ASSIGNMENT, EXHIBIT B.

To All Whom It May Concern: Be it known that I, Frederic E. Baldwin, of Philadelphia, Pennsylvania, for and in consideration of the sum of one dollar to me paid by John Simmons Company, a corporation of the State of New York, having a place of business in the City, County and State of New York, and for other good and valuable considerations from it to me moving, the receipt of all of which is hereby acknowledged, have sold, assigned, transferred and set over, and do hereby sell, assign, transfer and set over, unto said John Simmons Company, its successors and assigns, my entire

right, title and interest in and to any recoveries, both at law and in equity, for costs, damages and profits to which I am or may be entitled in the suit brought by me jointly with said John Simmons Company against Grier Brothers Company in the United States District Court for the Western District of Pennsylvania, the bill of complaint in said suit having been filed on or about the 4th day of October, 1913; and hereby authorize said John Simmons Company, its successors or assigns, to sue for and collect to its or their own use any and all such costs, profits and damages.

(Signed)

FREDERIC E. BALDWIN.

July 9, 1918.

COUNTY OF PHILADELPHIA,

State of Pennsylvania, ss:

On this 2nd day of November, 1918, before me personally appeared Frederic E. Baldwin, to me known and known to me to be the individual described in and who executed the foregoing instrument and acknowledged to me that he executed the same.

J. MORRIS DALTON,

[SEAL.]

Notary Public.

My commission expires March 9, 1919.

37

Supplemental Bill.

(Filed January 10, 1919.)

And now comes John Simmons Company, one of the above named plaintiffs, and shows:

1. That on or about the 4th day of October, 1913, the above named plaintiffs, John Simmons Company and Frederic E. Baldwin, filed their bill of complaint in this court against Grier Brothers Company; that on or about the 26th day of April, 1918, said plaintiffs, by leave of this Court first obtained, filed a Bill of Review in this cause, and that on or about the 10th day of May, 1918, said defendant filed its answer to said Bill of Review.

2. That since the filing of said Bill of Review and the answer thereto, to wit, on or about July 9, 1918, the plaintiff, John Simmons Company acquired by assignments in writing duly executed and delivered by said Baldwin, and has ever since owned, the entire right, title and interest of said Frederic E. Baldwin in and to any recoveries for costs, damages and profits in this suit and in and to said Letters Patent No. 13,542, together with all claims and demands, both at law and in equity, that said Baldwin has or may have for damages and profits accrued or to accrue on account of the infringement of said letters patent; as by said assignments, or duly verified copies thereof, here in court to be produced will fully and at large appear.

The plaintiff, John Simmons Company, therefore prays that this suit and all proceedings therein may continue, and that John Simmons Company may have the benefit of all proceedings so far taken in this cause; that said John Simmons Company be adjudged to be the owner of the rights aforesaid of Frederic E. Baldwin; that the relief prayed for in the original bill and in the bill of review in this cause be granted to it; that it may have such other and further relief as to this Court may seem meet; and that a rule of this court be issued upon said defendant, Grier Brothers Company, directing it within a certain time to be fixed by this Court to make such answer to this supplemental bill as it may be advised, but not under oath, answer under oath being specifically waived.

JOHN SIMMONS CO.,

[CORPORATE SEAL.]

By CHAS. H. SIMMONS, *Pres't.*

KELLER & BAKWELL,

Solicitors for Plaintiffs,

Oliver Building, Pittsburgh, Pa.

JAMES Q. RICE,

Of Counsel,

220 Broadway, New York.

38 STATE OF NEW YORK,

County of New York, ss:

Charles H. Simmons, being first duly sworn, deposes and says that he is the President of John Simmons Company, one of the complainants above named; that he has read the foregoing supplemental bill subscribed by him on behalf of said company, and knows the contents thereof, and that the same is true and his own knowledge.

CHAS. H. SIMMONS.

Subscribed and sworn to before me this 2nd day of January, 1919

AUGUSTA WHITE,

[SEAL.]

Notary Public, N. Y. Co.

Defendant's Answer to Plaintiffs' Supplemental Bill.

(Filed January 16, 1919.)

Answer of Grier Brothers Company, Defendant, to the Supplemental Bill Filed by the Plaintiff, John Simmons Company, on or about January 10th, 1919.

1. Defendant admits the allegations of paragraph one of the Supplemental Bill.

2. Defendant is without knowledge of the allegations contained in paragraph two of the Supplemental Bill.

Wherefore, The defendant denies that the plaintiff, John Simmons Company, is entitled to the relief prayed for or any part thereof.

GRIER BROTHERS COMPANY,
By BAKEWELL & BYRNES,
Its Solicitors.

January 16th, 1919.

39

Plaintiff's Testimony.

Deposition of Frank N. Waterman, Taken in New York, February 13, 1919.

(Filed December 31, 1919.)

Direct examination.

By Mr. James Q. Rice:

I am fifty-two years old and reside at Summit, New Jersey, and am a consulting Engineer by occupation. I testified in an open court trial before Judge Hough in a proceeding under a supplemental bill as an expert for the plaintiffs in a suit in the Second Circuit entitled "Frederic E. Baldwin and John Simmons Company vs. Abercrombie & Fitch Co. and Justrite Mfg. Co." In my preparation for my testimony in this case I studied the record in the case including particularly the depositions of the experts Messrs. Proctor and Cox, and examined the exhibits which were referred to by them in the main case referred to above, which was tried before Judge Mayer in the first instance and finally went to the Supreme Court of the United States on writ of certiorari. Mr. Proctor died several years ago. I recognize the two lamps handed me by counsel. The lamp of those handed me which bears a tag entitled "Plaintiff's Exhibit 2" in the case of Baldwin vs. Abercrombie & Fitch, appears to be the lamp, or at any rate is just like the lamp which was in evidence as a sample of the defendant's lamp in the case before Judge Mayer. It appears to have lost the cover which was present as I remember when I saw it before. The second lamp handed me seems to be identical in every way with the other lamp, except that it is provided with a cover such as the exhibit illustrating defendant's lamp had at the time when I considered the testimony referred to.

The lamps handed the witness were then offered in evidence as "Plaintiff's Exhibit, Justrite Lamps, New York Suit."

Each of the lamps shown me by counsel comprises a water reservoir and a carbid receptacle, and there is a tube extending from the water receptacle a considerable distance into the carbid receptacle so that its lower end is embedded in the carbid. There is also a rod or wire extending through the tube and accessible from the outside as well as projecting beyond the lower end of the tube into the carbid to serve as a stirrer to loosen the carbid and also by extending through

the tube it restricts and thus controls the flow of water. The device also comprises a gas burner and a reflector.

The lamp now shown me by counsel which bears a tag "Plaintiffs' Exhibit No. 6, Grier Lamp," was not one of the exhibits in
40 the former case, but except for the name that is marked on it seems to be substantially like the lamp that was in that case and known as "Plaintiffs' Commercial Lamp."

The lamp shown the witness was then offered in evidence and marked "Plaintiffs' Exhibit, Grier Lamp."

Comparing this lamp "Plaintiffs' Exhibit, Grier Lamp" with the lamp "Plaintiffs' Exhibit, Justrite Lamps," New York Suit," they are essentially the same. The Grier lamp, like the Justrite lamp, comprises a water reservoir to which is attached a carbid reservoir, and there is a water feeding tube extending from the water reservoir into the carbid chamber a considerable distance so as to be embedded in the carbid. There is a rod extending through the water feeding tube which is accessible from the outside, and extends into the carbid so that it may serve as a stirrer to loosen the carbid and also acts to restrict and thus control the flow of water from the water reservoir into the carbid chamber. There is a trifling difference in shape, but this seems to have no bearing on the operation. The general dimensions are substantially the same; the water tubes and stirring rods appear to be of substantially the same bore and to extend approximately the same distance into the carbid, that on the Grier lamp being the longer, if there is any difference. I note that the Grier lamp, as shown me, lacks the burner and reflector, and also that there seems to be a slight contracting or tightening of the lower end of the water tube around the rod, so that the rod fits a trifle tighter at the bottom than in the case of the Justrite lamp, though the effect is so trifling that it may be purely unintentional.

Cross-examination.

By Mr. Geo. E. Stebbins:

I was called into the case of Baldwin vs. Abercrombie & Fitch above referred to as the New York case something over a year ago. I think this was after that case had been tried by the United States Supreme Court on the writ of certiorari. I had nothing to do with the "Plaintiffs' Exhibit, Justrite Lamps, New York Suit" during the proceedings in the Supreme Court, and the proceedings in the District Court and the Circuit Court of Appeals prior thereto. The knowledge which I have as to the identity of the lamps in such proceedings is what has been told me by those formerly connected with the case, except insofar as the exhibits were tagged. I read the record and identified the exhibits as I did so, from the descriptions and markings. Mr. Cox, whom I referred to in my direct testimony as one of Defendant's experts, lives in Chicago. In answer to the question as to whether the lamp spoken of as "Plaintiffs' Commercial Lamp" in the New York suit had any valve, I am not certain as to the precise designation. My recollection is that there was a Plain-

41 tiffs' lamp which had no valve and one which did have. The one I had in mind did not have. The one I had in mind did not have a rod bent below the end of the water tube. Referring to the lamp offered in evidence as "Plaintiffs' Exhibit, Grier Lamp" and which bears a tag bearing the marking "United States District Court, Southern District of New York, Baldwin and John Simmons Co. vs. Abercrombie & Fitch and Justrite Mfg. Co.," I do not remember this lamp as an exhibit in that suit. I am unable at this time to say that it was not an exhibit for some purpose or other. At any rate it was not one which I had particularly noted. I cannot say how the tag came to be attached to it.

My description of the operation of the Grier lamp given in my direct testimony, was not based on any actual experience with such lamp, if you are referring to that particular exhibit. But I have tested both the plaintiffs' commercial lamp and the Justrite lamp, and so far as operation goes, they must be substantially identical with the operation of the Grier lamp because the structures are identical, so far as features effecting operation are concerned; that is to say the tube must of course extend into the carbid, because it is of such a length that that result is inevitable; the rod must be capable as acting as a stirrer, because it extends into the carbid, and is capable of being revolved, and such a rod so revolved I find acts as a stirrer; also the rod must act to restrict and control the flow of the water because it is evident that the rod very nearly fills the tube just as in the case of the other two lamps. I have not referred to any other features of operation.

Redirect examination.

By Mr. Rice:

The testimony which I gave before Judge Hough I understood was in a proceeding under Supplemental Bill. In preparing for my testimony regarding the structures before the court under the Supplemental Bill, I had occasion to particularly inform myself as to the structure or lamp which the Court had found to be an infringement in the main case. I have no doubt, from my examination of the record and the exhibits, that the lamps "Plaintiffs' Exhibit, Justrite Lamps, New York Suit" are the lamps which were before Judge Mayer in the main suit and were found by him to be an infringement. I studied the record, examined the lamp, and furthermore, I tested the lamp identified from the testimony as Defendant's Justrite Lamp, or one just like it. Furthermore, at the time of the trial, I had occasion to see and handle the exhibit as shown to Judge Hough.

Recross-examination.

By Mr. Stebbins:

42 In answer to the question as to whether I know personally that this was the lamp involved in the main suit, except from the examination of the record, I will state that the examination of the record and the fact that it was accepted by Judge

Hough as being the lamp passed upon by Judge Mayer, are the only sources of my information.

Deposition closed.

By Mr. Rice: Plaintiffs offer in evidence a transcript of record on appeal from the District Court of the Southern District of New York to the U. S. Circuit Court of Appeals for the Second Circuit in the suit of Frederick E. Baldwin & John Simmons Co., Complainants-Appellees, against Abercrombie & Fitch Company, and Justite Mfg Company, Defendants-Appellants, and particularly, the certified copy of the bill as amended.

Pages 1 to 5, of said Transcript.

Certified copy of the answer as amended.

Pages 6 to 17 of said Transcript.

Certified copy of the decree of the District Court, pages 192-194 of said Transcript.

Certified copy of the petition for appeal.

Pages 195-196 of said Transcript.

Plaintiff also offers in evidence certified copy of the Mandate of the Court of Appeals of the Second Circuit in said suit, and a certified copy of the order on the mandate; a certified copy of the petition for Writ of Certiorari, contained in pages 1 to 14 of the printed edition for the Writ, as filed in the U. S. Supreme Court.

Plaintiff also offers in evidence certain assignments, to wit:

An assignment by Frederick E. Baldwin to John Simmons Company of certain patents, including Reissue 13,542, March 11, 1913, the same being the patent in suit; said assignment being dated July 9, 1918;

An assignment by Frederick E. Baldwin to John Simmons Co. on his entire right, title and interest in and to all recoveries to which he is entitled in this suit, dated July 9, 1918.

Plaintiffs also give notice that at the hearing they will refer to the certified copy of the opinion of the Supreme Court, the certified copy of the order on the mandate of the Supreme Court, and certified copy of the mandate now on file in this Court.

The foregoing statement of testimony is approved.

PHILLIP SAWYER, RICE & KENNEDY,

Attorneys for Plaintiffs.

December 31st, 1919.

Approved:

CHAS. P. ORR,

U. S. District Judge.

ORR, *District Judge:*

Plaintiffs have filed in this Court a bill of review. The matter is now before this Court upon bill, answer and proofs.

On or about October 4th, 1913, the plaintiffs filed their original bill of complaint against the defendant, charging that the defendant had infringed and was infringing a certain patent of the United States, issued to said Frederick E. Baldwin on March 11th, 1913, being a re-issue No. 13,542, covering a certain miners' carbide lamp intended to be worn on the miner's cap, and also charging the said defendant with unfair competition in trade, by reason of the sale of said lamp. On July 24th, 1914, after the trial of the issue raised by the bill last aforesaid and the answer of the said defendant to the same, this Court found both issues in favor of the plaintiffs and issued an injunction. From the decree so entered by this Court, the defendant appealed to the Circuit Court of Appeals for the Third Circuit, and such proceedings were had upon that appeal, that on the 22nd day of January, 1915, the said Court of Appeals, as appears by their opinion (219 Federal, 735) reversed the decree of this Court, so far as it related to the validity of said reissue patent, which was held to be invalid, but affirmed the decree of this Court, so far as the same related to unfair competition in trade. Thereafter, the mandate of said Court of Appeals was duly sent to this Court, and on January 5th, 1916, this Court entered a decree in conformity with said mandate, referring the cause to a Master, to ascertain the damages which the plaintiffs should recover from the defendant by reason of the unfair competition, and the proceedings last mentioned are still pending before the Master.

On May 20th, 1913, a certain bill was filed in the District Court of the United States for the Southern District of New York, by Frederick E. Baldwin, one of the plaintiffs in the case at bar, against Abercrombie & Fitch Company, charging the latter with infringement of said re-issue patent, because of the sale by it of a certain miner's carbide lamp, intended to be worn upon the miner's cap. In that proceeding, John Simmons Company, the other plaintiff in the case at bar, intervened as a party plaintiff, and Justrite Manufacturing Company, maker of the lamp sold by Abercrombie & Fitch Company, intervened as party defendant. The said cause in the Southern District of New York, was so proceeded with, that

44 Judge Mayer held (227 Federal, 455) said re-issue patent valid and infringed, and on the 10th day of February, 1915, entered an interlocutory decree in accordance with his opinion. From the decree of Judge Mayer, an appeal was taken by the defendants in the case before him, to the Circuit Court of Appeals for the Second Circuit, and therein, the cause was so proceeded with that the Court of Appeals of the Second Circuit handed down an opinion (228 Federal, 895) affirming the decree of the Court below, and on the 23rd of November, 1915, the proper order of affirmance was duly entered.

Afterwards, on December 20th, 1915, the defendants in said suit which had been pending in the Second Circuit, presented their petition to the Supreme Court of the United States for a writ of certiorari, and on the 10th day of January, 1916, said Supreme Court granted said writ and so proceeded with the case that on the 10th of December, 1917, said Supreme Court affirmed the decision

of the Court of Appeals for the Second Circuit (215 U. S., 198), holding said Baldwin re-issue patent to be valid and infringed, and on the 15th day of January, 1918, sent down the proper mandate to the District Court for the Southern District of New York, in pursuance of which, a judgment was properly entered in said District Court. In all the aforesaid litigation, claim 4 of said re-issue patent was specially considered.

Promptly after the decision of the Supreme Court had been rendered as aforesaid, plaintiffs in the case at bar petitioned this Court for leave to file a bill of review, which permission this Court refused, in the first instance, upon the ground that the proper course for the plaintiffs to take would be to make application to the Circuit Court of Appeals for the Third Circuit for leave to file the bill of review in this Court. Such application having been made to the Court of Appeals of the Second Circuit, the latter, on March 12th, 1918, entered its order, authorizing and empowering this Court to take such action upon the petition for leave to file such bill of review as seemed proper to this Court.

Afterwards, the plaintiffs filed their petition in this Court for leave to file a bill of review as aforesaid, and also filed their bill of review. The defendant has raised but one issue of fact in its answer to the bill of review. Such issue of fact is raised by the denial that the miners' carbide lamp involved in the suit brought in the Southern District of New York and considered by the Supreme Court in its opinion aforesaid, corresponded in all essential features of construction with the lamp complained of in the case at bar. This issue of fact must be determined in favor of the plaintiffs. The miner's carbide lamp sold by The Grier Brothers Company corresponds in all essential features of construction with the lamp involved in the litigation in the Southern District of New York made by the Justite Manufacturing Company and sold by Abercrombie & Fitch Company. The importance of this issue may be doubted because the lamp of the defendant in the case at bar was held to be similar to the lamp of the plaintiffs by the Court of Appeals of the Third Circuit.

While bills of review are not favored in equity, yet they have long been recognized as effective means of securing relief against decrees of the Court. Their uses and their limitations in the past are well considered in the opinion delivered by Mr. Justice Baldwin, while sitting in the Circuit Court of the United States for the Eastern District of Pennsylvania, in *Poole vs. Nixon*, 9th Peters, 765. The recognition by him of the embodiment of Lord Bacon's ordinance as part of the law of equity, which has been adopted by the constitution of the United States, has been many times approved. That ordinance provides that "no bill of review shall be admitted except it contain either error in law appearing in the body of the decree, without further examination of matters of fact, or some new matter which hath arisen in time after the decree," etc. In the case at bar, plaintiffs do not rely upon any new matter which has arisen after the decree, but rely upon an error of law. That error of law is charged to be the decision by the Court of Appeals of the

Third Circuit, that the re-issue patent aforesaid is invalid, in that the said re-issue had the effect of broadening the original patent. The plaintiffs, in support of their contention that the decree was based upon an error of law, offered the decree aforesaid of the Supreme Court of the United States sustaining the decision of the Court of the Second Circuit and thereby holding, as a matter of law, that said re-issue patent did not broaden the original patent.

It must be found that there was error of law as charged. In the first place, the law, as interpreted by the Supreme Court of the United States, is the law which should govern all subordinate Federal Courts. In the second place, if the later decision of the Supreme Court of the United States cannot be invoked for the relief of the plaintiffs, they are in a situation not contemplated by the States when they gave authority to Congress to secure to inventors the exclusive right to their discoveries and inventions for a limited period, or by the Congress of the United States when it legislated in pursuance of such authority. By the decision of the Supreme Court of the United States, the validity of the re-issue patent may secure to the plaintiffs rights thereunder in all parts of the United States, except within the limitations of the Third Judicial Circuit. Plaintiffs' rights to the invention would not be exclusive for any period within that Circuit in which is embraced the great anthracite and bituminous coal fields of the State of Pennsylvania.

The plaintiffs are not seeking to correct supposed erroneous deductions or conclusions from the evidence submitted in the original case. They set up an error of law apparent on the face of the record, without any further examination of matters of fact. The error of law was the alleged improper application of the provisions of the Revised Statutes Section 4916 relating to re-issue of defective patents, to the re-issued patent in suit. The effect of the decision of the Court of Appeals of the Third Circuit is that the Commissioner exceeded the authority vested in him by said section, whereas, the decision of the Supreme Court aforesaid was to the effect that the Commissioner did not exceed the authority granted to him by said section.

The defendant has cited *Scotton vs. Littlefield*, 235 U. S., 407, as a complete precedent which should govern the present case and require a dismissal of the bill of review. Had the Court in that case not dismissed the bill of review, there would have necessarily been a further examination of matters of fact and the consideration of a question which was held back in other proceedings and subsequently made the subject of a bill of review. It is insisted by Counsel for the defendant that in the case just cited, the Supreme Court squarely holds that a subsequent decision by it will not lay the ground for a bill of review. To this proposition the Court cannot agree.

It is objected on the part of the defendant, that the plaintiffs have lost their right to file a bill of review by their failure to petition to the Supreme Court for a writ of certiorari to review the judgment of the Circuit Court of Appeals for the Third Circuit. At that time, the petition for writ of certiorari would have shown to the Supreme Court that there was involved nothing but a matter of pri-

vate interest which the Supreme Court, in accordance with its practice, would probably have refused to consider. It was not until the decision of the Court of Appeals for the Second Circuit had been made that there appeared to be a conflict between two Courts of Appeal. The conflict between the two Courts of Appeal created a condition which, under the decisions of the Supreme Court, gave promise to the unsuccessful party in the later case, that the writ of certiorari would be granted.

In *Forsyth vs. Hammond*, 166 U. S., 506-514, we find expression by the Supreme Court of the extent of its power in certiorari and also of its practice and intent to exercise that power sparingly "and only when the circumstances of the case satisfy us that the importance of the question involved, the necessity of avoiding conflict between two or more Courts of Appeal, or between Courts of Appeal and the Courts of a State, or some matter affecting the interests of this Nation, in its internal or external relations, demands such exercise."

The plaintiffs in this case had no right of appeal from the decision in the Third Circuit and had no right to a writ of certiorari to review the decree of that Court. They should not be
47 deemed to have prejudiced their standing to maintain this bill of review, because they did not seek the remedy by certiorari which the decisions of the Supreme Court should lead them to believe would not be granted. There was no delay on the part of the plaintiffs in filing the bill after the decision of the Supreme Court which sustained the validity of the re-issued patent. There was good excuse for the prior delay in filing the bill, because of the pendency of the question before the Supreme Court of the United States.

Henry vs. A. B. Dick Company, 224 U. S., 1, involving certain phases of the law of patents, was decided March 11, 1912. In the case of *Motions Picture Patents Company vs. Universal Film Manufacturing Company*, 243 U. S., 502-518, the decision in *Henry vs. Dick Company* was squarely overruled by an opinion handed down on April 9, 1917. On May 21, 1917, a motion was made in the Supreme Court for leave to file a bill of review in the District Court of the United States for the Southern District of New York, in the said case of *Henry vs. A. B. Dick Company*, which motion was granted by the Supreme Court on June 11, 1917. In that case lapse of time was not permitted to prevent administration of justice. It follows necessarily that the plaintiffs are not only entitled to maintain their bill of review, but that the decree of this Court entered in pursuance of the mandate of the Court of Appeals for the Third Circuit, in so far as it held re-issued patent No. 13,544 invalid, must be vacated and set aside and that a decree should be entered sustaining the validity of claim 4 of said re-issue, and finding the defendant guilty of infringement thereof. Plaintiffs are entitled also to an accounting for such infringement, but such accounting should be limited so that it should not antedate the date of the filing of the bill of review, for the decision of the Court of Appeals for the Third Circuit was the law of the case between the parties, at least until proceedings

were instituted to have it set aside. Such limitation however, should not affect, in any way, the plaintiffs' rights to recover for unfair competition.

Let a decree be drawn and presented in accordance with this opinion.

48 *Supplemental Opinion Upon Settlement of Decree Upon Bill of Review.*

(Filed November 7, 1919.)

OBER, *District Judge:*

The Solicitors for the Plaintiffs and the Solicitors for the Defendant having appeared in Court and having been heard with respect to the form of a decree, it was brought to the attention of the Court that the conclusion expressed in the opinion, that there should be a limitation of the accounting to the Plaintiffs for the infringement by the Defendant, was an erroneous conclusion. It is necessary that the opinion heretofore filed should be hereby supplemented.

It seems to be the correct principle that as between the parties to the original litigation, the vacation of a decree by a bill of review leaves such original parties in the same position as if the original decree had not been entered. While proceedings upon a bill of review are not intended to perform the office of an appeal or a writ of certiorari, yet they may have the same result. Reliance upon a decree of a lower Court which is subsequently reversed by the Appellate Court has not been held to save the party so relying from the consequences of a reversal by the Appellate Court. And so with proceedings by bill of review. Reliance upon a decree which is erroneous should not protect a party when such decree is subsequently set aside for error.

By the entry of the decree in the present proceeding, which sets aside the decree of this Court originally entered, the parties must be held to be in the same position in which they would have been had the original decree not been founded upon error, but had been in its terms like the decree now to be entered.

49 *Decree Upon Bill of Review.*

(Filed November 7, 1919.)

And now, November 7th, 1919, this cause came on to be further heard on bill of review and was argued by counsel; and thereupon upon consideration thereof, it was ordered, adjudged and decreed as follows, viz:

1. That the decree of this Court entered herein on or about January 5th, 1916, as to paragraph "6th" thereof be, and the same hereby is, vacated and set aside.

2. That Frederick E. Baldwin was the first, original and sole inventor of the invention described in, and particularly recited in

claim 4 of the United States Re-issue Letters Patent No. 13,542, issued March 11th, 1913, for Acetylene Gas Generating Lamps.

3. That said Re-issue Letters Patent No. 13,542 are as to claim 4 thereof, good and valid in law, and that the title to said invention and Re-issue Letters Patent is duly vested in the plaintiff, John Simmons Company, as alleged in the bill of review.

4. That the defendant, The Grier Brothers Company, has infringed upon claim 4 of said Re-issue Letters Patent No. 13,542, by making, vending and using lamps containing or embodying the invention of said Re-issue Letters Patent No. 13,542.

5. That the plaintiffs do recover from said defendant the profits which it has derived, received or made by reason of the aforesaid infringement upon said claim 4 of said Re-issue Letters Patent No. 13,542; and that said plaintiffs also recover from said defendant and all damages they have sustained by reason of said infringement by said defendant; and it is hereby referred for the convenience of the parties, to William F. Knox, Esq., as a Master of this Court, to make, state and report to this Court an account of such profits and to ascertain and report thereto such damages, with all convenient speed; and that the said defendant, its and each of its confederates, associates, attorneys, solicitors, clerks, servants, agents and workmen, are hereby directed to attend before said Master, from time to time as required by him and to produce before him such books, papers, documents and other proofs, as relate to the matter at issue, in such manner as said Master shall direct and to submit to such oral examination as the Master may require.

6. That a perpetual injunction issue out of and under the seal of this Court directed to the said defendant, The Grier Brothers Company, its and each of its confederates, associates, attorneys, solicitors, clerks, servants, agents and workmen, perpetually enjoining
50 and restraining them, and each of them, from the manufacture, sale and use in any manner, of the lamps described in said Re-issue Letters Patent No. 13,542, and particularly referred to in claim 4 thereof.

7. That plaintiffs recover from said defendant their costs and disbursements in this proceeding to be taxed.

Per CURIAM.

Petition for Appeal.

(Filed November 24, 1919.)

To the Honorable the Judges of the United States District Court for the Western District of Pennsylvania:

The above named defendant, Grier Brothers Company, considering itself aggrieved by the decree entered herein on the 7th day of November, 1919, hereby appeals from such decree to the United States Court of Appeals for the Third Circuit for the reasons spe-

fied in the assignment of errors filed herein and herewith, and prays that its appeal may be allowed and a citation issue as approved by law, and that a transcript of the record, proceedings, papers and exhibits upon which said decree was made in the past, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Third Circuit, and your petitioner desiring to supersede the execution of the decree insofar as it ordered an accounting for profits and damages, here tenders bond in such amount as the Court may require for such purpose and prays that with the allowance of the appeal a supersedeas be issued staying, while this cause is pending on appeal, the accounting for profits and damages ordered in paragraph 5 of the decree filed herein on or about November 7, 1919, relating to the patent in suit.

GRIER BROTHERS COMPANY,

Defendant,

By BAKEWELL & BYRNES,

Its Solicitors,

Order.

The foregoing appeal is allowed and shall operate as a supersedeas to stay, while this cause is pending on appeal, the accounting for profits and damages ordered in paragraph 5 of the decree filed herein on or about November 7, 1919, relating to the patent in suit, upon the Petitioner filing a bond in the sum of Two Thousand Dollars, with sufficient securities to be conditioned as required by law.

Per CURIAM.

November 24, 1919.

51

Assignment of Errors.

(Filed November 24, 1919.)

Comes now the Grier Brothers Company, the defendant in the above entitled cause, by its solicitors; and hereby files the following assignment of errors, upon which it will rely, and says that the decree entered and filed herein on the 7th day of November, 1919, is erroneous and unjust and against the just rights of the plaintiffs for the following reasons, viz:

1. The Court erred in permitting the plaintiffs to file a bill-of-review against the decree entered on or about January 5, 1916.

2. The Court erred in not dismissing the bill-of-review filed by the plaintiffs.

3. The Court erred in vacating and setting aside the decree entered on or about January 5, 1916, as to paragraph 6th thereof.

4. The Court erred in holding that Frederick E. Baldwin was the first, original and sole inventor of the invention described in and particularly recited in claim 4 of United States Reissue Letters Patent No. 13,542.

5. The Court erred in holding that said Reissue letters patent No. 13,542 were, as to claim 4 thereof, good and valid in law.

6. The Court erred in holding that the defendant, the Grier Brothers Company, had infringed upon claim 4 of the said Reissue letters patent No. 13,542.

7. The Court erred in holding that the plaintiffs should recover from the defendant any profits derived by reason of the alleged infringement of claim 4 of said Reissue Letters Patent No. 13,542.

8. The Court erred in holding that the plaintiffs should recover from the defendant any damages sustained by reason of the alleged infringement of said Reissue letters patent.

9. The Court erred in appointing a Master to report an account of profits and damages and in directing that the defendant, its confederates, associates, etc., be directed to attend before said Master.

10. The Court erred in granting an injunction directed to the defendant, the Grier Brothers Company, and its confederates, associates, etc.

11. The Court erred in ordering that the plaintiffs recover from the defendant their costs and disbursements.

12. The Court erred in holding that the plaintiffs were entitled to recover profits and damages for the period prior to the filing of the bill of review herein.

13. The Court erred in holding that the plaintiffs are entitled to recover profits and damages for the period prior to the entry of the decree of November 7, 1919, herein.

14. The Court erred in holding that the plaintiffs were entitled to recover damages and profits for the period during which the decree of January 5, 1916, entered on the mandate of the Court of Appeals was in force.

15. The Court erred in holding that a bill of review would lie to vacate or revise the decree filed herein on or about January 5, 1916.

16. The Court erred in holding that the subsequent decision of the United States Supreme Court in the suit of Abernethie & Fitch Co. et al. vs. Baldwin et al. laid the ground for a bill of review in the present suit.

17. The Court erred in holding that there was error of law apparent on the face of the record which would support a bill of review.

18. The Court erred in holding that the plaintiffs did not rely upon new matter which had arisen after the decree filed herein on or about January 5, 1916, but relied upon an error of law.

19. The Court erred in not holding that the plaintiffs were barred by laches from bringing their bill of review.

20. The Court erred in not dismissing the bill of review because of the intervening rights of this defendant, the Grier Brothers Company.

21. The Court erred in not holding that the decree entered herein on or about January 5, 1916, had become final between the parties hereto.

THE GRIER BROTHERS COMPANY,

Defendant,

By BAKEWELL & BYRNES, *Its Solicitors.*

Bond on Appeal.

(Filed November 28, 1919.)

Know all men by these presents, That we, Grier Brothers Company, as principal, and the American Surety Company of New York, as surety, are held and firmly bound unto Frederick E. Baldwin and John Simmons Company in the sum of Two Thousand (\$2,000) Dollars to be paid to said Frederick E. Baldwin and John Simmons Company, their attorneys, successors or assigns, to which payment, well and truly to be made, we bind ourselves, our successors and assigns, generally and severally, by these presents.

Sealed with our seals and dated this 26th day of November, in the year of our Lord one thousand nine hundred and nineteen.

Whereas, Lately in a term in the United States District Court for the Western District of Pennsylvania, in a suit pending in said court between Frederick E. Baldwin and John Simmons Company, Plaintiffs, and Grier Brothers Company, defendant, a decretal order was entered, and the said Grier Brothers Company, having obtained an appeal to reverse the said decretal order in the aforesaid suit, and a citation directed to the said Frederick E. Baldwin and John Simmons Company is about to be issued citing and admonishing them to be and appear at the United States Circuit Court of Appeals for the Third Circuit to be holden at Philadelphia.

Now, therefore, The condition of this obligation is such that, if the above-named Grier Brothers Company shall prosecute its appeal to effect, and pay all damages and costs if it fails to make its plea good, then the above obligation shall be void. Otherwise, the same shall be and remain in full force and effect.

[INCORPORATE SEAL.]

GRIER BROTHERS COMPANY,

By J. WILBUR GRIER,

President.

Attest:

R. E. SHARPE,

Secretary.

AMERICAN SURETY COMPANY
OF NEW YORK,

By W. J. ZWINGGI,

Resident Vice President.

[SEAL.]

Attest:

A. C. McDONALD,

Resident Assistant Secretary.

STATE OF PENNSYLVANIA.

County of Allegheny, ss:

I, M. B. Burroughs, a Notary Public in and for said county, in the state aforesaid, do hereby certify that W. J. Zwitting, 54 Resident Vice President of the American Surety Company of New York, who is personally known to me, appeared before me this day and acknowledged that he signed, sealed and delivered the foregoing instrument as his free and voluntary act as Resident Vice President of the American Surety Company of New York and as the free and voluntary act of the American Surety Company, for the uses and purposes therein set forth.

Given under my hand and notarial seal this 26th day of November, 1919.

[SEAL.]

M. B. BURROUGHS,
Notary Public.

My commission expires April 21, 1923.

Approved:
CHAS. P. ORR,
Judge.

Precipe.

(Filed December 31, 1919.)

To the Clerk of the United States District Court for the Western District of Pennsylvania:

In accordance with equity rule No. 75, you are respectfully requested to prepare and forward to the Clerk of the United States Circuit Court of Appeals for the Third Circuit a transcript of the record in the above entitled cause for use in connection with the appeal from the decree of this Court filed herein on or about November 7, 1919, which said transcript is to be filed in the Office of the Clerk of the United States Circuit Court of Appeals for the Third Circuit, under the appeal heretofore perfected, and please include in said transcript the following pleadings, proceedings, papers on file and exhibits to wit:

Docket Entries.

Opinion of the United States Circuit Court of Appeals for the Third Circuit, dated on or about Jan. 22, 1915.

Mandate from the Circuit Court of Appeals for the Third Circuit on or about January 24, 1915.

Decree filed on or about January 5, 1916, on mandate from the Circuit Court of Appeals for the Third Circuit.

Certified copy of order of Circuit Court of Appeals for the Third Circuit filed on or about March 13, 1918.

Notice and petition for leave to file bill of review, filed on or about April 11, 1918, together with the bill of review attached to such

petition, and Exhibits "A," "B" and "C" referred to in paragraph 5 of said bill of review.

Answer filed on or about May 11, 1918.

55 Petition and order granting leave to file supplemental bill, filed on or about January 10, 1919.

Supplemental bill filed on or about January 10, 1919.

Defendant's answer to supplemental bill, filed on or about January 16, 1919.

Deposition of Frank N. Waterman.

Opinion sur bill of review, filed on or about October 7, 1919.

Supplemental opinion upon settlement of decree upon bill of review filed on or about November 7th, 1919.

Decree upon bill of review filed on or about November 7, 1919.

Petition for appeal.

Order allowing appeal.

Assignment of errors.

Bond on appeal.

Receipt for appeal record.

Citation.

Plaintiffs' Paper Exhibits.

Certified copy of pages 1 to 5 of the transcript of record on appeal from the District Court of the United States for the Southern District of New York to the United States Circuit Court of Appeal for the Second Circuit in the suit of Frederick E. Baldwin and John Simmons Company vs. Abercrombie & Fitch and Justrite Mfg. Co., being the bill-of-complaint as amended therein; certified copy of pages 6 to 17 of said transcript, being the answer as amended therein; certified copy of pages 192 to 194 of said transcript, being the decree of the District Court therein; and certified copy of pages 195 to 196 of said transcript, being the petition for appeal therein.

Certified copy of mandate of the Court of Appeals for the Second Circuit in the said suit of Baldwin et al. vs. Abercrombie & Fitch et al.

Certified copy of the order on the mandate in said suit of Baldwin et al. vs. Abercrombie & Fitch et al.

Certified copy of the petition for certiorari in said suit of Baldwin et al. vs. Abercrombie & Fitch et al., as contained in pages 1 to 14 of the printed petition for the right to file in the United States Supreme Court.

Assignment by Frederick E. Baldwin to John Simmons Company of certain patents including Reissue patent No. 13,544 of March 11, 1913, said assignment being dated July 9, 1918.

Assignment by Frederick E. Baldwin to John Simmons Company of his right, etc., to recoveries, said assignment being dated July 9, 1918.

Plaintiffs' Physical Exhibits.

Plaintiffs' Exhibit "Justrite Lamps" New York suit.

Plaintiffs' Exhibit "Grier Lamp."

Defendant's Physical Exhibits.

Defendant's Exhibit "H" Grier Lamp No. 79.

Defendant's Exhibit "The Grier Bros. Co. Lamp No. 23.

Patent Exhibits.

Baldwin Reissue 13,543 (Patent in Suit).

Baldwin Patent 821,580 (Original of Patent in Suit).

BAKEWELL & BYRNES,

Solicitors for Defendant.

Service of the foregoing praecipe is acknowledged this 9th day of December, 1919.

PHILIPP, SAWYER, RICE & KENNEDY,

Solicitors for Plaintiffs.

Citation.

WESTERN DISTRICT OF PENNSYLVANIA, ss:

To Frederick E. Baldwin and John Simmons Company, Greeting:

You are hereby cited and admonished to be and appear at a session of the United States Circuit Court of Appeals for the Third Circuit to be holden at Philadelphia in said Circuit, on the 30th day of January next, pursuant to an appeal filed in the office of the Clerk of the District Court of the United States for the Western District of Pennsylvania, wherein Grier Brothers Company, is Appellant, and you are Appellees, to show cause if any you know or have to say why the decree rendered against the said Appellant, as in the said appeal appears, should not be duly reversed, and full and speedy justice done to the parties aforesaid in this behalf.

Witness my hand this 31st day of December, 1919.

CHAS. P. ORR,

Judge.

Service of the above Citation accepted this 7th day of January, 1920.

JAMES K. BAKEWELL.

Certified from the record this 16th day of January, A. D., 1920.

J. WOOD CLARK,

Clerk.

[SEAL.]

Amended Bill of Complaint.

United States District Court, Southern District of New York.

In Equity.

FREDERIC E. BALDWIN and JOHN SIMMONS COMPANY, Intervenor,
Plaintiffs,

VS.

ABERCROMBIE & FITCH COMPANY and JUSTRITE MFG. COMPANY,
Intervenor, Defendants.

The plaintiff, Frederic E. Baldwin, for his amended bill of complaint alleges:

First. That the plaintiff Frederic E. Baldwin, is a citizen of the State of New York, and resident and inhabitant of the Borough of Manhattan, City, County and State of New York; that the plaintiff, John Simmons Company, is a corporation organized and existing under the laws of the State of New York, and a resident and inhabitant of said Borough of Manhattan; that the defendant, Abercrombie & Fitch Company, is a corporation duly organized and existing under and by virtue of the laws of New York and a citizen of said State, having its principal and a regular and established place of business in, and a resident and inhabitant of said Borough of Manhattan, City, County and State of New York; and that the Justrite Mfg. Company is a corporation duly organized and existing under and by virtue of the laws of the State of Illinois, a citizen of said State having a regular and established place of business in, and a resident and inhabitant of, Chicago, County of Cook, in said State of Illinois.

Second. That the jurisdiction of this court depends upon the patent laws of the United States.

Third. That plaintiff (Frederic E. Baldwin) being, prior to October 18, 1899, the first, original and sole inventor of certain improvements in Acetylene Gas Lamps not known or used by others in this country before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his said application, and which had not been for more than two years prior to said application in public use or on sale in this country, and which had not been first patented or caused to be patented by him or his legal representatives or assigns in a foreign country upon an application filed more than seven months prior to the filing of said application in this country for said Letters Patent, and which had not been abandoned, filed an application for Letters Patent for the said invention and having complied in all respects with the requirements

of the law, Letters Patent of the United States were on the 28th day of August, 1900, duly granted to him bearing No. 656,871.

Fourth. That said plaintiff being, prior to July 15, 1903, the first, original and sole inventor of certain improvements in Acetylene Gas Generating Lamps which had not been known or used by others in this country before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his said application, and which had not been for more than two years prior to said application in public use or on sale in this country, and which had not been first patented or caused to be patented by him or his legal representatives or assigns in a foreign country upon an application filed more than twelve months prior to the filing of said application in this country for said Letters Patent, and which had not been abandoned, filed an application for Letters Patent for the said invention and having complied in all respects with the requirements of the law, Letters Patent of the United States were, on the 22nd day of May, 1906 duly granted to him, bearing No. 821,580.

Fifth. That said patent being inoperative and invalid by reason of a defective and insufficient specification arising from inadvertence, accident and mistake, and without any fraudulent or deceptive intent, said plaintiff, on February 5, 1913, duly surrendered the said letters patent, and applied for a reissue thereof in due form of law, and that on the 11th day of March, 1913, all the requirements of the statutes then in force having been complied with, letters patent of the United States reissue No. 13,542, were duly granted to said plaintiff.

Sixth (A). That the plaintiff, John Simmons Company, is and has been, since about the year 1908, the only manufacturer of acetylene gas lamps for miners' use embodying the inventions of said original and reissued letters patent, is the only licensee thereunder, and is now and has been for the past two years the only authorized selling agents for said lamps.

Sixth. That a large number of Acetylene Gas Lamps embodying the inventions of each of said letters patent have been made and sold, all of which Lamps were duly marked "Patented," together with the dates of said Letters Patent of which the plaintiff Frederick L. Baldwin is now and has been since their respective grants the sole owner.

Seventh. The Abercrombie & Fitch Company (and Justite Mfg. Company, and each of them), has infringed upon each of said Letters Patent, since the dates of each of said letters patent and prior to, and within six years of the filing of the bill, and particularly claims 1 and 10 of the said Letters Patent No. 656,874, and claims 1 and 4 of said reissue letters patent No. 13,542, by making or causing to be made, using or causing to be used, and selling or causing to be sold, in the Borough of Man-

hattan, New York City, within the Southern District of New York, and elsewhere in the United States, Acetylene Gas Lamps, made in accordance with and embodying the inventions set forth in said claims of said Letters Patent, without the consent of the plaintiffs, and are continuing so to do, and have derived unlawful gains and profits from such infringement which plaintiffs would otherwise have received and have thereby been caused irreparable damage.

Wherefore, Plaintiffs pray for writs of injunction, as well provisional as permanent, issuing out of and under the seal of this court, enjoining and restraining the defendants, Abercrombie & Fitch Company and Justrite Mfg. Company, their and each of their officers, directors, clerks, servants, agents and workmen from infringing upon said letters patent and each of them; that each of said defendants account to each said plaintiff for the profits made by them and each of them, and the damages sustained by each plaintiff, and that upon rendering a decree herein, the actual damages so assessed be trebled, in view of the wilful and unjust infringement by the said defendants; that the plaintiffs recover the costs and disbursements of this suit; and plaintiffs pray for such other and further relief as may appear proper and be agreeable to equity.

FREDERIC E. BALDWIN,

By PHILIPP, SAWYER, RICE & KENNEDY,

Solicitors for Plaintiff,

Frederic E. Baldwin,

220 Broadway,

Manhattan, N. Y.

JAMES Q. RICE,

Of Counsel for Plaintiffs.

The foregoing amended bill of complaint is hereby adopted by the John Simmons Company, Intervenor, pursuant to the annexed order.

JOHN SIMMONS CO.,

By PHILIPP, SAWYER, RICE & KENNEDY,

Solicitors for Intervenor,

John Simmons Company,

220 Broadway,

Manhattan, N. Y.

A true copy,

[SEAL.]

ALEX. GILCHRIST, JR.,

Clerk.

60

Amended Answer.

United States District Court, Southern District of New York.

In Equity.

FREDERIC E. BALDWIN and JOHN SIMMONS COMPANY, Intervenor
Plaintiffs,

vs.

ABERCROMBIE & FITCH COMPANY and JUSTRITE MFG. COMPANY,
Intervenor.*Amended Answer to Amended Bill of Complaint.*To the Honorable, the Judges of the United States District Court for
the Southern District of New York:

The Justrite Mfg. Co. admitted as a party defendant in the above
entitled suit, states that it is a corporation organized and existing
under the laws of the State of Illinois and doing business in the City
of Chicago, and County of Cook in the said State, answering the Bill
of Complaint filed by the plaintiff, defendant answering says:

First. This Defendant on information and belief avers that the
Complainant, Frederic E. Baldwin, is not entitled to sue for injunc-
tion or damage herein, as said complainant is not engaged in the
manufacture or sale of any article containing his alleged patented
invention, and on like information and belief this defendant avers
that said complainant, for certain royalties to him reserved, has
licensed for the full term of his said alleged patent and for the United
States, the John Simmons Manufacturing Company to manufacture
and sell and to license others to manufacture and sell the said
patented inventions, and that on the 12th day of August, 1912, the
said John Simmons Manufacturing Company, in consideration of
a license from this defendant to use patent No. 688,926, issued to
Alvin L. Bullington (and by him assigned to the Justrite Mfg. Co.)
and the payment by said John Simmons Manufacturing Company
to this defendant of the sum of Five Thousand (\$5000.00) Dollars
released to this defendant and to all persons acting or claiming under
said alleged patents, and that during the said month of August the
president, Frederick J. Becker, and Harry Lea Dodson, attorney of
the Defendant, The Justrite Manufacturing Company, called upon
Mr. Charles Simmons, the president of the John Simmons Company
plaintiff, and that the said Dodson at that time and in the

61 presence of Mr. Charles Simmons and Mr. Becker made a
pencil memorandum setting out the details of the agreement
as above set forth, entered into between the parties, that a short time
thereafter Mr. J. Q. Rice, one of the attorneys for the plaintiffs came
into the matter for the purpose of preparing formal documents em-
bodying the terms of agreements entered into between Mr. Charles

Simmons for and in behalf of the John Simmons Company, and Mr. Frederick J. Becker, for and in behalf of the Justrite Manufacturing Company, that the said Rice attempted to embody in the agreement many things which the Defendant had never agreed to, and that a number of papers were prepared, and each and every one of which set forth the consideration as above stated but contained many covenants which this defendant had never made nor agreed to make, and that thereupon to wit, on or about the 1st day of May, 1913, the defendant, The Justrite Manufacturing Company, relying on Mr. Charles Simmons, acting for the John Simmons Manufacturing Company, sending the release as his part of the said agreement existing between the parties, and in order to fulfill its duties forwarded a formal license.

Second. Answering the 3rd Cause of plaintiff's Bill of Complaint, this defendant admits upon information and belief that Letters Patent of the United States No. 656,874, bearing date of the 28th day of August, 1900, for certain alleged improvements in acetylene lamps, were issued to plaintiff, but this defendant denies that the plaintiff was the original, sole and first inventor of the alleged improvement sought to be claimed in and by said Letters Patent; denies that said improvements had not been known or used by others before said Frederic E. Baldwin's pretended invention thereof, denies that the same had not, before such pretended invention, been patented or described in any printed publication, in this or any foreign country; denies that the same had not been in public use or on sale for more than two years prior to the application for said Letters Patent; and denies that said Letters Patent are valid or effectual to secure to the said Frederic E. Baldwin his heirs, administrators, executors or assigns, the exclusive right, or any right whatever, of making use, or selling to others to be used, the alleged improvements as set forth in the said Letters Patent, and particularly denies the validity of the invention as described in the 1st and 10th claims of the said Letters Patent.

Third. And this defendant further answering denies that the said alleged invention as described in the 1st claim is useful or that it is an improvement, and advance in this art, but on the contrary thereof, this defendant avers and charges the fact to be that said 1st claim of the said Letters Patent is null and void for want of utility, and also for the further and separate reason, for want of invention on the part of the said Frederic E. Baldwin.

62 Fourth. This defendant further answering the 4th Clause of plaintiff's Bill of Complaint admits upon information and belief that Letters Patent of the United States No. 821,580, bearing date of the 22nd of May, 1906, for certain alleged improvements in acetylene lamps were issued to plaintiff, but this defendant denies that the plaintiff was the original, sole and first inventor of the alleged improvement sought to be claimed in and by said Letters Patent; denies that said improvements had not been known or used by others before said Frederic E. Baldwin's pretended invention

thereof; denies that the same had not, before such pretended invention, been patented or described in any printed publication, in this or any foreign country; denies that the same had not been in public use or on sale for more than two years prior to the application for said Letters Patent; and denies that said Letters Patent are valid or effectual to secure to the said Frederic E. Baldwin, his heirs, administrators, executors or assigns, the exclusive right, or any right whatever, of making use, or selling to others to be used, the alleged improvements as set forth in the said Letters Patent, and particularly denies the validity of the invention as described in the 1st and 4th claims of the said Letters Patent.

Fifth. And this defendant further answering denies that the said alleged invention as described in the 2nd claim is useful or that it is an improvement and advance in this art, but on the contrary thereof, this defendant avers and charges the fact to be that the said 1st claim of the said Letters Patent No. 821,580 is null and void for want of utility, and also for the further and separate reason, for want of invention on the part of the said Frederic E. Baldwin.

Sixth. This defendant denies that it has ever made, used, or vended to others to be used, the said alleged invention, or any substantial part thereof, and denies that it has ever made, vended, or vended to others to be used, any device in acetylene lamps made according to, or employing said alleged invention, or any substantial part thereof, and denies that it has in any way infringed or violated the plaintiff's privileges in this behalf, or that it intends so to do, or that it has received or enjoyed any gains or profits therefrom, or has caused any injury or loss to the plaintiff.

Seventh. Defendant further answering says that it is now, and has been for several years past, engaged in the manufacturing, selling and introducing into use acetylene gas lamps, and that the lamps thus made were made in accordance with the description and drawings embodying the invention of Augie L. Hansen, described in Letters Patent No. 42,460, and dated May 7, 1912, as the assignee of the entire right, title and interest in the invention of the said Augie L. Hansen, above named.

63

Eighth. Defendant further answering states that the portion of the said lamp alleged to be covered by the 1st claim of the said Patent No. 656,874, does not embody the said construction, but is the invention of Ludwig Schmitt, of Mannheim, Germany, the description of which was published in his British Patent No. 15,688, of July 1898, which was duly published in the United States, and became public property long prior to the application for patent by the said Frederic E. Baldwin.

Ninth. And this defendant answering says that the said Frederic E. Baldwin was not the sole or original inventor of the alleged invention and improvement described by him as new in the 10th claim of Letters Patent No. 656,874, but affirms that the same, or all material parts thereof, were prior to the supposed invention

thereof by the said Baldwin, well known to one Leroy S. Buflington, of Minneapolis, Minn., and embodied in a lamp constructed and by him publicly used at that time, and which he still has properly attested and witnessed; and that the subject matter of the last claim as well as the 10th claim of said patent was well known to Thomas F. Williams, of Chicago, Ill., and practiced by him, and by various other persons whose names are unknown to this defendant, but which this defendant prays leave to insert herein and make a part hereof when they shall be discovered, and the defendant further denies the validity of the said Letters Patent for the Court of Appeals of the Sixth District in a decision reported in Vol. 199 Fed. Rep., P. 133; and this defendant further answering avers the fact to be that the said Frederic E. Baldwin was not the first and original inventor of the said alleged improvement in acetylene gas lamps described in the 1st and 10th claims of Letters Patent No. 656,874 and the 1st and 4th claims of Letters Patent No. 821,580, but on the contrary thereof that the same thing in all material and essential features, and the same principle and combination, was, previous to the said alleged invention of the said Frederic E. Baldwin, fully described and set forth in the Letters Patent, both of the United States and foreign countries, long prior to the alleged invention of discovery by the said Frederic E. Baldwin, the said Letters Patent being hereinafter enumerated as follows:

United States Patents.

- Bullington, 614,438, Nov. 22, 1898.
- Harvey, 614,652, Nov. 22, 1898.
- Laun, et al., 627,363, June 20, 1899.
- McMurray, 599,347, Feb. 22, 1898.
- Stein, 599,270, Feb. 15, 1898.
- Casgrain, 574,601, Jan. 5, 1897.
- Strakosch, 610,150, Aug. 30, 1898.
- Dolan, 621,331, Mar. 21, 1899.
- Hallows, et al., 644,910, Mar. 6, 1900.
- 61 Bundy, 608,571, Aug. 9, 1898.
- Moreau, 624,068, May 2, 1899.
- Williams, 618,594, Jan. 31, 1899.
- Watt, 662,842, Nov. 27, 1900.
- Gallagher, 597,900, Jan. 25, 1898.
- Whittemore, 595,230, Dec. 7, 1897.
- Villejean, et al., 600,563, Mar. 15, 1898.
- Rand, 582,548, May 11, 1897.
- Peck, 622,015, Mar. 28, 1899.
- Bundy, 616,889, Jan. 3, 1899.
- Kidd, 332,087, Dec. 8, 1895.
- Cary, 613,111, Feb. 13, 1900.
- Zimmermann, 634,319, Oct. 3, 1899.
- Waibel, et al., 625,943, May 30, 1899.
- Kerr, 596,937, Jan. 4, 1899.

Hull, 633,844, Sept. 26, 1899.
 Bellamy, 592,759, Nov. 2, 1897.
 Pourcelle, 627,139, June 20, 1899.
 Gallagher, 585,642, June 29, 1897.
 Hanotier, et al., 599,098, Feb. 15, 1898.
 Russell, 635,599, Oct. 24, 1899.
 Iden, 637,934, Nov. 28, 1899.
 Strakosch, 628,964, July 18, 1899.
 Parkhurst, 642,559, Jan. 30, 1900.
 Dupee, 592,083, Oct. 19, 1897.
 Watt, 638,898, Dec. 12, 1899.
 Williams, 619,814, Feb. 21, 1899.
 Baulieu, 611,885, Oct. 4, 1898.
 Handshy, 591,132, Oct. 5, 1897.
 Stearns, et al., 629,309, July 18, 1899.
 Dolan, 638,449, Dec. 5, 1899.

British Patents.

Holliday, 24,360, of Oct. 21, 1897.
 Schmitt, 15,688, of July 18, 1898.
 Schmid, 26,676, of Nov. 15, 1897.
 Van Praag, 2,227, of Jan. 31, 1899.
 Van Praag, 21,691, of Oct. 14, 1898.
 Windham, 20,537, of Sept. 7, 1897.
 No Name, 16,399, No Date.
 Marechal, et al., 29,405, of Dec. 11, 1897.
 Buffington, 23,802, of Oct. 15, 1897.
 Strakosch, et al., 9,718, of Apr. 27, 1898.
 Schumacher, 30,134, of Dec. 31, 1896.
 Barratt, 2,699, of Feb. 7, 1899.
 Davison, et al., 1,549, of Jan. 19, 1898.
 Miller, et al., 17,997, of Aug. 22, 1898.
 Bridges, 14,984, of July 20, 1899.

French Patents.

Ripicaud, 270,623, Jan. 10, 1898.

Swedish Patents.

Buffington, 10,259, Mar. 15, 1898.

Tenth. The defendant answering the 5th paragraph of the said Bill of Complaint denies that the said original Letters Patent No. 821,580 were or contained the proper grounds for a reissue, but affirms that the said reissue patent No. 13,542, is invalid by reason of the fact that the 1st and 4th claims of the said original patent No. 821,580 were held invalid by the United States Circuit Court of Appeals of the Sixth District in a decision reported in Vol. 199, Fed. Rep., P. 133; and for the further reason that the said application for

reissue was not made until seven years after the issuance of said original Letters Patent, and therefore, said reissue was invalid due to the intervening rights which had accrued to the defendant and others to wit:

Norgard Mfg. Co., Des Moines, Iowa.
Maple City Mfg. Co., Monmouth, Illinois.
Bleser Mfg. Co., Springfield, Illinois.
Scranton Lamp Co., Scranton, Pennsylvania.
Grier Bros. Mfg. Co., Pittsburgh, Pa.

Eleventh. And the Defendant further shows to the Court that it is claimed by the plaintiff herein that the Court of Appeals for the Sixth Circuit sustained Claim 1 of said Patent No. 656,874 in its judgment and decree, as reported in Vol. 199 Fed. Rep., P. 133. This defendant, however shows to the Court that the only patents cited in the trial and hearing of said Cause, or considered by the Court were as follows:

Handshy, 591,132, Oct. 5, 1897,
Dolan, 638,449, Dec. 5, 1899,
Hallows, et al., 644,910, Mar. 6, 1900,

and that the patents cited herein were not before the Court. A careful examination and analysis of the Court's decision in said cause will show that the minimum of patentable novelty referred to by the Court had reference to the projection of the wire passing through the water tube into the carbide below, thus regulating the flow of water, and constituted the meager invention which led the Court to say:

"This claim presents the minimum of patentable novelty" and the defendant avers that an inspection of the Letters Patents last referred to will show that this invention was not new, but had been anticipated by said patents and was well known in the art, and that said citations show that there was no element that could be
66 declared to be new in the said Baldwin invention.

Twelfth. And this defendant further answering plaintiff's Bill of Complaint shows to the Court that the said Letters Patent, and particularly as to claims 1 and 10 of Letters Patent No. 656,874, and the 1st and 4th claims of Letters Patent 13,542 are invalid upon their face by reason of the disclosure contained in the Letters Patent of the United States and Great Britain, Sweden and France heretofore enumerated.

Thirteenth. This defendant answering the 8th clause of Complainant's Bill of Complaint denies that it has in any manner infringed either of said Letters Patent mentioned in plaintiff's Bill of Complaint, and denies that this plaintiff has any right to any further answer to its Bill of Complaint and denies that the plaintiff is entitled to any injunction, damages, account or any other relief whatever against this defendant, injunctive or otherwise.

Wherefore, This defendant prays that said bill be dismissed, and for all proper relief.

JUSTRITE MANUFACTURING COMPANY,
By FREDERICK J. BECKER,
President,

WILLIAM M. CHADBOURNE,
Solicitor for Defendant,

CHARLES H. ALDRICH,
HARRY LEA DODSON,
Of Counsel,

STATE OF ILLINOIS,
County of Cook, ss:

Frederick J. Becker, being first duly sworn, deposes and says that he is the President of the Justrite Mfg. Co., that he has read the foregoing answer and knows the contents thereof and that the same is true except as to those matters stated to be on information and belief and as to such matters he believes them to be true.

FREDERICK J. BECKER,

Sworn to and subscribed before me this 10th day of December 1913,

C. M. BAUMEISTER,
Notary Public,

A true copy.

[SEAL.]

ALEX. GILCHRIST, JR.,
Clerk

67

Decree.

At a Stated Term of the United States District Court for the Southern District of New York Held at the United States Court House and Post Office Building, Borough of Manhattan, New York, on the 10th Day of February, 1915,

Present: Hon. Julius M. Mayer, District Judge,

In Equity,

FREDERIC E. BALDWIN and JOHN SIMMONS COMPANY, Plaintiffs,

vs.

ABERCROMBIE & FITCH COMPANY and JUSTRITE MANUFACTURING COMPANY, Defendants.

This cause came on to be heard at the January Term 1915, of this Court, and was argued by counsel; and, thereupon, upon consideration thereof, it was ordered, adjudged and decreed as follows, viz:

First, That Frederic E. Baldwin was the first, original and sole inventor of the invention described in, and particularly recited in

claim 4 of United States Reissue Letters Patent No. 13,542, issued March 11, 1913, for Acetylene Gas Generating Lamps.

Second. That said Reissue Letters Patent No. 13,542, are as to Claim 4 thereof good and valid in law, and that the title to said invention and Reissue Letters Patent is duly vested in the plaintiffs, Frederic E. Baldwin and John Simmons Company, as alleged in the bill of Complaint.

Third. That the defendants, Abercrombie & Fitch Company and Justite Manufacturing Company, have infringed upon claim 4 of said Reissue Letters Patent No. 13,542, by making, vending and using lamps containing or embodying the invention of said Reissue Letters Patent No. 13,542.

Fourth. That the plaintiffs do recover of said defendants the profits which they have derived, received or made by reason of the aforesaid infringement upon said claim 4 of said Reissue Letters Patent No. 13,542; and that said plaintiffs also recover of said defendants any and all damages they have sustained by reason of said infringement by said defendants; and it is hereby referred for the convenience of the parties, to Alfred W. Kiddle, Esq., as a Master

of this Court, to make, state and report to this Court an account of such profits, and to ascertain and report thereto such damages, with all convenient speed; and that the said defendants, their and each of their confederates, associates, attorneys, solicitors, clerks, servants, agents and workmen, are hereby directed to attend before said Master, from time to time, as required by him and to produce before him such books, papers, documents and other proofs as relate to the matter at issue, in such manner as said Master shall direct and to submit to such oral examination as the Master may require.

Fifth. That a perpetual injunction issue out of and under the seal of this Court directed to the said defendants, Abercrombie & Fitch Company, and Justite Manufacturing Company, their and each of their confederates, associates, attorneys, solicitors, clerks, servants, agents and workmen, perpetually enjoining and restraining them, and each of them, from the manufacture, sale and use, in any manner of the lamps described in said Re-issue Letters Patent No. 13,542, and particularly referred to in claim 4 thereof.

Sixth. That the plaintiffs recover of said defendants their costs and disbursements in this suit to be taxed.

Seventh. That the injunction granted herein is to be suspended pending appeal if appeal be promptly taken. If appeal be not taken within fifteen days from the entry of this decree, plaintiffs may apply, on five days' notice for a modification of the suspension of injunction herein provided.

JULIUS M. MAYER, *D. J.*

Approved as to form.

JAMES R. OFFIELD.

(Endorsed.)

Defendant's form of decree to limit recovery as against each defendant, etc., is premature and that point will be considered on the coming in of the Master's report if the decree is sustained.

JULIUS M. MAYER,
District Judge

District Court. Filed Mar. 10, 1915. S. D. of N. Y.

A true copy,

ALEX. GILCHRIST, Jr.,
Clerk.

[SEAL.]

69 *Petition for Appeal and Order Allowing Appeal.*

In the United States District Court, Southern District of New York.

In Equity. 10-219.

FREDERIC E. BALDWIN and JOHN SIMMONS CO., Intervenor,
Complainants,

vs.

ABERCROMBIE & FITCH COMPANY and JUSTRITE MANUFACTURING
COMPANY, Intervenor, Defendants.

To the Honorable the Judges of the District Court of the United States in and for the Southern District of New York:

The petition of Abercrombie & Fitch Company and Justrite Manufacturing Company, defendants herein, respectfully shows:

First. That hereinbefore complainants filed their Bill of Complaint against the defendants herein and that thereafter the defendants duly answered, whereupon, proofs having been taken in open Court, this cause came on to be heard on final hearing upon the pleadings and proofs before the Honorable Julius M. Mayer, in the District Court of the United States for the Southern District of New York, and that on the 10th day of March, 1915, a decree for an injunction and accounting was signed and entered herein in favor of complainants and against the defendants.

Second. Wherefore, Your petitioners, the defendants above named, feeling aggrieved by the entry of said Decree, hereby appeal therefrom to the United States Circuit Court of Appeals in and for the Second Circuit for the reasons specified in the Assignment of Errors filed herewith, and pray that this appeal may be allowed and that a duly authenticated transcript of said decree and of the records and proceedings thereto relating upon which said decree was made, not

be transmitted forthwith to the United States Circuit Court of Appeals for the Second Circuit.

ABERCROMBIE & FITCH COMPANY AND
JUSTRITE MANUFACTURING COMPANY,
By JAMES R. OFFIELD,

Solicitor for Defendants.

PHILIP B. ADAMS,

JAMES R. OFFIELD,

Of Counsel for Defendants.

And now, to wit, on the 23rd day of March, 1915, it is ordered that the above appeal be allowed as prayed for.

J. W. MAYER,

District Judge.

[Endorsed:] U. S. District Court—Filed Mar. 23, 1915—S. D. of N. Y.

Statement.

On March 23, 1915, a bond in the sum of \$250 for costs on appeal was duly approved and filed.

A true copy.

ALEX. GILCHRIST, JR.,

Clerk.

[SEAL.]

Mandate.

Certified Copy of Mandate of the Court of Appeals for the Second Circuit in the Suit of Baldwin et al. vs. Abercrombie & Fitch et al.

UNITED STATES OF AMERICA, ss:

The President of the United States of America to the Honorable the Judges of the District Court of the United States for the Southern District of New York, Greeting:

Whereas, Lately in the District Court of the United States for the Southern District of New York, before you, or some of you, in a cause between Frederick E. Baldwin, and another, and Abercrombie & Fitch Company, and another, a decree was entered in the office of the Clerk of said Court on the 10th day of February, 1915, in the words and figures following, to wit:

Decree.

This cause came on to be heard at the January Term 1915, of this Court, and was argued by counsel; and, thereupon, upon consideration thereof, it was ordered, adjudged and decreed as follows, viz:

First. That Frederic E. Baldwin was the first, original and sole inventor of the invention described in, and particularly recited in claim

4 of, United States Reissue Letters Patent Number 13,542, issued March 11, 1913, for Acetylene Gas Generating Lamps.

Second. That said Reissue Letters Patent No. 13,542, are as to claim 4 thereof good and valid in law, and that the title to said invention and Reissue Letters Patent is duly vested in the plaintiffs, Frederick E. Baldwin and John Simmons Company, as alleged in the bill of complaint.

Third. That the defendants, Abercrombie & Fitch Company and Justrite Manufacturing Company, have infringed upon claim 4 of said Reissue Letters Patent No. 13,542, by making, vending and using lamps containing or embodying the invention of said Reissue Letters Patent No. 13,542.

Fourth. That the plaintiffs do recover of said defendants the profits which they have derived, received or made by reason of the aforesaid infringement upon said claim 4 of said Reissue Letters Patent No. 13,542; and that said plaintiffs also recover of said defendants any and all damages they have sustained by reason of said infringement by said defendants; and it is hereby referred for the convenience of the parties, to Alfred W. Kiddle, Esq., as a Master of this Court, to make, state and report to this Court an account of such profits, and to ascertain and report thereto such damages, with all convenient speed; and that the said defendants, their and each of their confederates, associates, attorneys, solicitors, clerks, servants, agents and workmen, are hereby directed to attend before said Master, from time to time, as required by him and to produce before him such books, papers, documents and other proofs, as relate to the matter at issue, in such manner as said Master shall direct and to submit to such oral examination as the Master may require.

Fifth. That a perpetual injunction issue out of and under the seal of this Court directed to the said defendants, Abercrombie & Fitch Company, and Justrite Manufacturing Company, their and each of their confederates, associates, attorneys, solicitors, clerks, servants, agents and workmen, perpetually enjoining and restraining them, and each of them, from the manufacture, sale and use, in any manner of the lamps described in said Reissue Letters Patent No. 13,542, and particularly referred to in claim 4 thereof.

Sixth. That the plaintiffs recover of said defendants their costs and disbursements in this suit to be taxed.

Seventh. That the injunction granted herein is to be suspended pending appeal if appeal be promptly taken. If appeal be not taken within 15 days from the entry of this decree, plaintiffs may apply, on five days' notice, for a modification of the suspension of injunction herein provided for; as by the inspection of the transcript of the record of the said Court, which was brought into the United States Circuit Court of Appeals for the Second Circuit, by virtue of an appeal agreeably to the act of Congress, in such case made and provided, fully and at large appears.

And whereas, In the present term of October, in the year of our Lord one thousand nine hundred and fifteen, the said cause came on to be heard before the said United States Circuit Court of Appeals for the Second Circuit, and the said transcript of record, and was argued by counsel;

On consideration whereof, It is hereby ordered, adjudged and decreed, that the decree of said District Court be and it hereby is affirmed with costs taxed at the sum of \$25.25.

You, therefore, are hereby commanded that such further proceedings be had in said cause, in accordance with the decision of this Court as according to right and justice, and the terms of the United States, ought to be had, the said appeal notwithstanding.

Witness, The Honorable Edward D. White, Chief Justice of the United States, the 19th day of November, in the year of our Lord one thousand nine hundred and fifteen.

Costs of Appellees:

Clerk \$5.25

Certifying Record:

Attorney 20.00

\$25.25

WM. PARKIN,

*Clerk of the United States Circuit Court
of Appeals for the Second Circuit.*

Costs of Appellees:

1915 October Term.

Entering appearance \$.25

Filing brief 5.00

Attorney's docket fee 20.00

\$25.25

Test:

WM. PARKIN,

*Clerk of the United States Circuit Court
of Appeals for the Second Circuit.*

Order on Mandate.

At a Stated Term of the District Court of the United States for the Southern District of New York Held in the United States Court House and Post Office Building, Borough of Manhattan, City of New York, on the 23rd Day of November, 1915.

Present: Hon. Julius M. Mayer, Judge.

In Equity. E. 10 219.

FREDERIC E. BALDWIN and JOHN SIMMONS COMPANY, Intervenor,
Plaintiffs,

VS.

ABERCROMBIE & FITCH COMPANY and JUSTRITE MFG. COMPANY,
Intervenor, Defendants.

This cause having been brought on upon the Mandate sent down from the United States Circuit Court of Appeals for the Second Circuit and now on file in this Court, by which Mandate it appears that an appeal was taken by the above named defendants, Abercrombie & Fitch Company, and Justrite Mfg. Company, to the said United States Circuit Court of Appeals of the Second Circuit from the decree of this Court entered herein on or about the 10th day of February, 1915, in favor of the above named complainants and against the above named defendants, Abercrombie & Fitch Company and Justrite Mfg. Company, and that such appeal was argued by counsel, and that a decree has been entered herein, whereby it is ordered, adjudged and decreed that the said decree of this Court herein be affirmed with costs of appeal to said complainants, Frederic E. Baldwin and John Simmons Company, taxed in said United States Circuit Court of Appeals at the sum of Twenty-five and 25/100 Dollars; the said Mandate also directing that such further proceedings be had in said cause in accordance with the decision of said United States Circuit Court of Appeals as according to right and justice, and the laws of the United States, ought to be had, the said appeal notwithstanding.

Now, therefore, in compliance with said Mandate, it is, on motion of Messrs. Philipp, Sawyer, Rice & Kennedy, solicitors and of counsel for complainants herein,

Ordered, Adjudged and Decreed, That the judgment and
74 decree of the United States Circuit Court of Appeals for the Second Circuit be, and the same hereby is, made the judgment and decree of this Court; that the decree entered herein on or about the 10th day of February, 1915, be, and the same hereby is affirmed with costs to the complainants to be taxed; and it is further,

Ordered, adjudged and decreed, that the said complainants herein, Frederic E. Baldwin and John Simmons Company, do have

and recover from the said defendants Abercrombie & Fitch Company, and Justrite Manufacturing Company, the sum of Twenty-five and 25/100 Dollars, the costs in the United States Circuit Court of Appeals, as provided in said Mandate; that the said complainants have judgment and execution therefor, and that this Order or Decree be annexed to the Judgment Roll.

JULIUS M. MAYER,

U. S. D. J.

Endorsed: Order on Mandate. Filed Nov. 24, 1915, U. S. District Court, S. D. of N. Y.

A true copy.

[SEAL.]

ALEX. GILCHRIST, JR.,

Clerk.

75 *Certified Copy of the Petition for Certiorari.*

In the Suit of Baldwin et al. vs. Abercrombie & Fitch et al.

In the Supreme Court of the United States, October Term, A. D. 1915.

In the Matter of the Application of Abercrombie & Fitch Company and Justrite Manufacturing Company of New York for the Writ of Certiorari under Section 6 of the Act of Congress, Approved March 3, 1891, Creating the Circuit Courts of Appeal.

ABERCROMBIE & FITCH COMPANY and JUSTRITE MANUFACTURING COMPANY, Petitioners,

vs.

FREDERIC E. BALDWIN and JOHN SIMMONS COMPANY, Respondents.

On Petition for Writ of Certiorari Directed to the United States Circuit Court of Appeals for the Second Circuit.

Petition for Writ of Certiorari and Reasons Relied on for the Allowance of the Writ.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

The petition of Abercrombie & Fitch Company and Justrite Manufacturing Company of New York for a writ of certiorari, directed to the United States Circuit Court of Appeals for the Second Circuit, and ordering that the records and exhibits in a certain cause be certified to this Honorable Court for final review and determination, under the provision of Section 6 of the Act of Congress, of March 3, 1891, etc., said appeal cause being entitled as follows, in the Second Circuit: Frederic E. Baldwin and John

Simmons Company, Complainant-Appellees vs. Abercrombie & Fitch Company and Justrite Manufacturing Company of New York, Defendant-Appellants.

76 Statement of Case as to Parties, Subject-Matter, Present and Antecedent Litigations.

Your petitioners, Abercrombie & Fitch Company and Justrite Manufacturing Company of New York, respectfully shows and petitions this Honorable Court as follows:

First. That your petitioners are both corporations doing business under the laws of the State of New York; that your petitioner, Abercrombie & Fitch Company is not the manufacturer of the devices in question, but simply are sellers and dealers in the same, and that your petitioner, the Justrite Manufacturing Company manufactures said devices for the joint petitioner; that the subject-matter of this petition is the validity and scope of certain reissue letters patent in suit granted to one of the respondents, Frederic E. Baldwin, under date of March 11, 1913, being reissue No. 13,542, for Acetylene Gas Generating Lamps and that the co-respondent the John Simmons Company is the exclusive licensee and manufacturer of the lamp of said reissue patent. A copy of the original said letters patent dated May 22, 1906, numbered 821,580, and a copy of the reissue thereof is herewith attached and made part of this petition.

Second. The bill of complaint as originally filed contained another patent to the patentee and respondent, Frederic E. Baldwin, dated August 28, 1900, No. 656,874. On or before the trial of the case respondents' counsel dismissed patent No. 656,874 from the case, said patent being dated August 28, 1900, and stated in the record in open court that the respondents relied solely upon claim 4 of the reissue patent No. 13,542 (page 78 of the Rec., line 310).

Upon the trial of the case at the District Court his Honor, Judge Mayer, found the reissue patent valid and infringed as to claim 4 and so ordered in decree form. The Court of Appeals of the Second Circuit affirmed the decree of Judge Mayer.

Antecedent Litigation.

Third. In January, 1909, this patentee and respondent Frederic E. Baldwin, brought suit in the United States District Court for the Southern District of Illinois against Jacob Bleser for an alleged infringement of the original of the reissue patent in suit No. 821,580, dated May 22, 1906, together with one of his earlier patents. Judge Humphrey in the Bleser case found the earlier patent to Baldwin valid and infringed and the original patent of the reissue patent in this suit No. 821,580 valid and infringed as to claim 1 and 4. The Court of Appeals of the Seventh Circuit

77 reversed the District Court and found that the claims of the earlier patent No. 654,874 of August 28, 1900 were not infringed and that the relied upon claims of the original of the reissue patent in suit were not infringed. Claim 4 of the original patent reads as follows:

"In a lamp of the kind described, the combination with a water reservoir, and a receptacle for calcium carbid, of a water tube extending from the former a considerable distance into the latter and adapted to be embedded in the mass of carbid in the receptacle, and a rod extending through the water tube and constituting a stirrer to break up slaked carbid around the outlet of the water-tube as set forth."

The alleged infringing lamp on the Bleser case was the same as the alleged infringing lamp of your petitioners, in this case.

The Court of Appeals for the Seventh Circuit found that a rod extending through a water tube, and constituting a stirrer to break up slaked carbid around the outlet of the water tube, the rod operating to restrict and thus control the flow of water to the carbid, as set forth, was a rod with a stirrer or bent end particularly identified and pointed out in the specification and claims of the original patent and found that the rod with a straight end of the Bleser construction (being exactly the same construction as the rod of your petitioners) was not the rod of the original patent nor the rod contemplated under the terms or spirit of the specifications of the original patent, and certainly not the rod identified by claim 4, and Bleser did not infringe claim 4, 199 F. R., 133.

The decree in this Bleser case was rendered April 23, 1912. In February, 1913, Baldwin filed his application for reissue patent afterwards granted and containing his reconstructed claim 4, the only relied upon claim in this suit, such claim in this suit of the reissue patent reading as follows:

"In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbid, of a water tube extending from the former a considerable distance into the latter and adapted to be embedded in the mass of carbid in the receptacle, and a rod extending through the water tube, and constituting a stirrer to break up slaked carbid around the outlet of the water tube, *the rod operating to restrict and thus control the flow of water to the carbid, as set forth.*"

The italics in the claim are ours. The new element and function introduced into claim 4 on its face is identified by the italicized words. The specifications of the original patent described this purpose and function of the rod in the general description of the mechanism, but a rod for such purpose was nowhere identified or made part of the original claim; but this purpose and
78 function of the rod appearing in the general specification and not identified or made part of the claim was a small matter in comparison with the change in the specifications as to the stirring function of the rod of the original patent and claim 4 thereof.

A reading of the specifications of the reissue patent and com-

paring the same with the original patent beginning with line 71 to line 89, inclusive, on page 2, shows that the sole and only purpose of the reissue patent was an attempt to misleadingly and erroneously redescribe and change the stirrer element of the original patent, being the bent end of the rod with its wide sweep in a complete circle to stir and break up the slaked carbid around the outlet of the water tube, to a rod with a stirrer entirely removed and capable only of a defined vertical movement in a straight line by reason of the stirrer element or construction of the rod being removed, and the rod having a sole movement in the water tube of a piston in a pump. The purpose, effect and result of the reissue patent was to introduce into claim 4 an element not claimed or set forth as to structure, function or purpose in claim 4 of the original patent and to take out of claim 4 of the original patent the bent rod or stirrer of that patent which alone gave the original claim 4 vitality and patentability as a claim.

This Reissue Patent Declared Invalid as to Claim 4 by the United States Circuit Court of Appeals for the Third Circuit.

Upon the granting of the reissue patent the patentee and correspondent, Frederic E. Baldwin, began suit against Grier Bros. Company upon claim 4 of this reissue patent being the same claim at bar in this case and the construction, except as to outward appearance or dress, practically and identically the same as your petitioners and upon the same record as present in this case. The case in the Third Circuit first came up on motion for preliminary injunction before the late Judge Young, there also being involved in the bill in that case an unfair competition element. Judge Young denied the motion for preliminary injunction relating to the patent in said claim 4 but granted it as to the allegations of unfair competition (210 F. R., 560). Upon final hearing upon a completed record substantially the same as present in this case, a decree was entered finding for the respondent, Baldwin, upon both grounds of the bill of complaint, namely, infringement of said claim 4 and unfair competition (215 F. R., 735). An appeal thereupon was taken to the United States Circuit Court of Appeals for the Third Circuit (Grier Bros. Co. vs. Frederic E. Baldwin), and upon January 22, 1915, the Court of Appeals

79 reversed the decree of the District Court as to the present subject-matter and held the reissue patent invalid as to claim 4 for the reason principally that the reissue patent broadened the original and that it was not permissible so to do, after a lapse of time of seven years and after a claim had been limited and defined by final adjudication by the Court of Appeals, copy of opinion hereto attached.

The Diametrically Opposite Findings and Conclusions Upon the Same State of Facts Between the Circuit Court of Appeals of the Second Circuit in this Case and the Circuit Court of Appeals of the Third and Seventh Circuits as Shown by the Respective Opinions and Decrees.

Fourth. There is no possible doubt, as we have said or intended to say, that there is a difference in result and in decree upon substantially the same record in the litigations above identified. The Third Circuit having declared the Baldwin re-issue patent invalid as to claim 4 the only claim at issue for the reasons stated in the opinion, such patent being reissued and enlarged upon seven years after the date of its granting; and the Court of Appeals of the Seventh Circuit declaring that the lamp structure exactly like petitioners did not infringe claim 4 of the original patent and the Court of Appeals of the Second Circuit having declared upon substantially the same record that the fourth claim of the reissue patent was valid and was infringed by your petitioners, copy of opinion hereto attached.

The direct issue between these respective Courts of Appeal and difference in the respective decrees can be well brought out and comprehended simply by reading the opinions of the respective Courts of Appeals. The difference in result and decree between the Courts of Appeals of the Third and Seventh Circuits and the Court of Appeals of the Second Circuit stands out plainly when we understand the invention of Baldwin as stated in connection with his fourth claim of the original patent and we respectfully submit that seemingly this original Baldwin patent has been idealized and further judicially reissued by the opinion and reasoning of the Court of Appeals for the Second Circuit.

There would seem to be no fair ground for contention otherwise, than that the natural and normal reading of the original patent so far as the fourth claim is concerned meant and was intended to mean and identify a rod with a bent end as shown in all of the drawings of the patent and identified by claim 4, that extended through the water tube and constituted the stirrer to break up the slaked carbid around the outlet of the water tube. This rod fitted closely in the water tube, had a right-angle bend at the entrance of the rod to the tube to serve as a handle, and a right-angle bend at its exit of the water tube to serve as a stirrer. These shoulders or bends in the rod prevented absolutely any vertical movement of the rod and prescribed absolutely the only possible movement of the rod, that is, the revolving movement operating the stirrer.

There is no other kind of a rod shown or described or provided for in the original Baldwin patent and no other possible stirrer contemplated except that which follows the revolving operations of the rod and stirrer. The Court of Appeals of the Second Circuit we respectfully submit has idealized and inflated the mechanical structure of the patent and of claim 4 beyond any possibility of recognition by any rule laid down by this court as to reissued patents.

Manifestly if you cut off and removed the stirrer from the Baldwin rod of the original patent you do away with any possibility of a

straight remaining portion of the rod in any way constituting a stirrer or having any capacity whatever to stir, and to attribute any function or possibility to the straight rod of petitioners is to idealize and distort that rod out of all semblance to the purpose and rod of the Baldwin patent.

The petitioners' straight rod confined at both ends as to a single movement and having a capacity only of a short, definite, confined, vertical, reciprocating, plunger and piston movement of the blunt end of the rod to force or pump the water into the calcium carbide mass, has nothing of single feature or purpose with the bent rod or stirrer element of the Baldwin patent.

The Court of Appeals for the Seventh Circuit although finding claim 4 of the original Baldwin patent valid says plainly that it contained the minimum amount of patentable novelty and was plainly not infringed by a straight rod. In the meantime it had been ascertained both by Baldwin himself and others that the stirrer or bent rod of his patent was without any practical value or at least was wholly unnecessary and that both Bleser and your petitioners used the straight rod without a stirrer as shown by the Court of Appeals decision of the Seventh Circuit, and it was under these circumstances that Baldwin and his counsel brought out the reissue in suit to cover the construction of Bleser and of your petitioners of the rod from which the stirrer had been removed and the straight rod operating as a piston only was substituted therefor; no amount of sophistry or broadening of language out of its natural meaning, we respectfully submit, can alter this fact.

Fifth. We do not take it that at this time it is expected, or even permissible, to enter into an extended discussion or analysis of the record to show that the decree affirmed by the Court of Appeals for the Second Circuit was plain error in view of the facts proven in this record. If any such study of the record is admissible at this time we respectfully submit that abundant grounds for the granting of this petition and the reversal of the affirmed decree of the Second Circuit will be found (1) in the study of the old art; (2) the fact that your petitioners although engaged in business in a small way prior to the decision of the Court of Appeals of the Seventh Circuit relied upon that opinion and practically extended and built up their business subsequent thereto; (3) in view of the fact that under an ordinary reading the respondents' reissue patent by a lamp manufacturer, petitioners' lamp clearly does not infringe any claim of Baldwin's patent, and as shown, this fact and condition is recognized by the respondents except as to claim 4 of the reissue patent in this suit, and (4) the fact is plainly apparent by a study of the record that petitioners' structure is substantially and indeed exactly the same as the rejected and abandoned claim 6 of the Baldwin original patent, and the lamp structure manufactured by the petitioner herein complained of and enjoined under the decree is the structure made under and in accordance with the rejected and abandoned claim 6 of Baldwin's original patent.

Sixth. The decision of this court in *Miller vs. Brass Company* (104 U. S., 350) clearly defines the law of reissue and its application. This court says:

"It is manifest on the face of the patent, when compared with the original, that the suggestion of inadvertence and mistake in the specification was a mere pretense; or if not pretense, the mistake was so obvious as to be instantly discernible on opening the letters patent, and the right to have it corrected was abandoned and lost by unreasonable delay. The only mistake suggested is, that the claim was not as broad as it might have been. This mistake, if it was a mistake, was apparent upon the first inspection of the patent, and if any correction was desired, it should have been applied for immediately. * * * But it must be remembered that the claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed. It is a declaration that that which is not claimed is either not the patentee's invention, or, if his, he dedicates it to the public. * * * If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. Nothing but a clear mistake, or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the claim * * *

"The correction of a patent by means of a reissue, where it is invalid or inoperative for want of a full and clear description of the invention, cannot be attended with such injurious results as follow from the enlargement of the claim."

In the case of *James vs. Campbell*, 104 U. S., 357, immediately following *Miller vs. Brass Company*, supra, this Court more specifically stated the rule as follows:

"When a patent clearly and fully, without ambiguity or obscurity, describes and claims a specific invention, complete in itself, so that it cannot be said to be inoperative or invalid, by reason of a defective or insufficient specification, a reissue cannot be had for the purpose of expanding and generalizing the claim so as to make it embrace an invention not described and specified in the original."

In the case of *Parker vs. Yale*, 123 S. C., 87, and relating to the question of estoppel and intervening rights this Court said:

"In the present case the infringing clock was made by the defendant Lane more than six months before the reissue in suit was applied for. * * * This, therefore, is a case of the amendment of a patent so as to cover the improvement not covered by the patent and which came into use by others than the patentee and his licensee, free from the protection of the patent."

The patentee Baldwin cannot distinguish the combination of elements identified by his reissue claim 1 in suit from his original claim 6 by predicated the minimum amount of patentable novelty, recognized by the Court of Appeals for the Seventh Circuit—upon the omission of a valve, and then in this case urge that claim 1 is broad enough to cover the construction in which the valve is used as one of the elements of the combination.

In the case of *Leggett vs. Avery*, 101 U. S., 257, this court says:

"As before remarked, we consider it extremely doubtful whether reissued letters can be sustained in any case where they contain claims that have been once *been* formally disclaimed by the patentee, or rejected with his acquiescence and he has consented to such rejection in order to obtain his letters patent. Under such circumstances, the rejection of the claim can in no just sense be regarded as a matter of inadvertence or mistake. Even though it was such, the applicant should be estopped from setting it up on an application for a reissue."

83 A Particular Hardship to Your Petitioner, the Justrite Manufacturing Company, if This Petition is Not Granted.

Seventh. While your petitioner, the Justrite Manufacturing Company is doing business in the State of New York, it is as a manufacturing company an Illinois corporation, having its manufacturing plant at Chicago, Illinois, and appears in this case voluntarily by an intervening petition filed and granted to defend its principal New York customer, the Abercrombie & Fitch Company.

Its manufacture of the lamp in question is a right and just procedure under the Court of Appeals decision of the Seventh Circuit and for this reason we respectfully submit there exists a peculiar equity upon the part of your petitioner, the Justrite Manufacturing Company, to have this petition granted aside from the broad public equity and right of this great court to take up this Baldwin reissue patent and deciding its validity for all of the nine Circuits.

Eighth. Your petitioners finally shows unto your Honors that the question involved is of great public importance outside of the particular parties litigant in this case; that if any such construction is given to the Baldwin reissue patent in suit as appears in the Second Circuit, the same will be asserted by respondents to stand as a litigation determining, covering and controlling the construction and operation of any and all acetylene gas miner's lamps hereafter constructed, sold or used for and by the hundreds of thousands of miners employing and to employ an acetylene gas lamp now and until the expiration of such reissue Baldwin patent.

Conclusion.

In conclusion, your Honors, your petitioners respectfully submit that this, your petitioners' petition for the writ of certiorari should

be granted, and the record in this case sent up for final review and determination by this court as your petitioners are informed and believes is the rule and practice where there are direct differences of results as to findings and decrees in said courts, as is represented by the leading cases in this court so determined.

Mast Foss Co. vs. Stover Mfg. Co., 177 U. S., 485.

Columbus Watch Co. vs. Robbins, 148 U. S., 267.

Singer Co. vs. Cramer, 192 U. S., 265.

Diamond Rubber Co. of New York vs. Consolidated Rubber Tire Co. and Rubber Tire Wheel Co., 444, 220 U. S., 428.

84 Whereupon your petitioners respectfully pray that this Honorable Court will be pleased to grant a writ of certiorari requiring this said case in the Second Circuit to be certified to this Honorable Court for its review and determination.

JUSTRITE MANUFACTURING COMPANY,

By FREDERICK J. BECKER,

Pres.

ABERCROMBIE & FITCH COMPANY,

By JAMES R. OFFIELD,

Their Attorney.

We hereby certify that we have examined and read the foregoing petition for writ of certiorari and that in our opinion such petition is well founded, and should be granted by this Honorable Court, and that such petition is not filed for delay.

CHARLES K. OFFIELD,

JAMES R. OFFIELD,

Counsel for Petitioners.

November 30th, 1915.

Supreme Court of the United States.

I, James D. Maher, Clerk of the Supreme Court of the United States, do hereby certify that the foregoing printed pages, numbered from one to fourteen, inclusive, contain a true copy of the petition for writ of certiorari in the case of Abercrombie & Fitch Company et al., Petitioners, vs. Frederic E. Baldwin et al. No. 67, October Term, 1917, as the same remains upon the files of said Supreme Court.

In testimony whereof I hereunto subscribe my name and affix the seal of said Supreme Court, at the City of Washington, this 21st day of December, A. D. 1918.

[SEAL.]

JAMES D. MAHER,

Clerk of the Supreme Court of the United States.

85 & 87 Assignment by Frederic E. Baldwin to John Simmons Company of certain Patents, including Reissue Patent No. 13,544 of March 11, 1913, said assignment being dated July 9, 1918.

(As said assignment has already been printed as a part of Plaintiffs' Petition and Supplemental Bill filed January 10, 1919, it is not reprinted. See page 34 of this Record.)

Assignment by Frederick E. Baldwin to John Simmons Company of his right, etc., to recoveries, said assignment being dated July 9, 1919.

(As said assignment has already been printed as a part of Plaintiffs' Petition and Supplemental Bill filed January 10, 1919, it is not reprinted. See page 36 of this Record.)

Reissued Mar. 11, 1919.

13,542

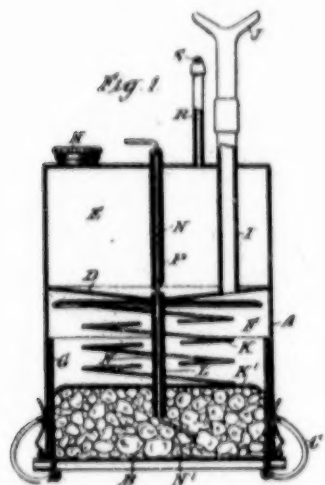


Fig. 1

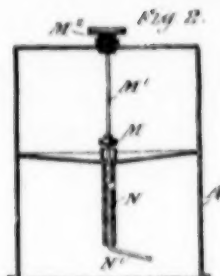


Fig. 2

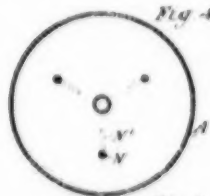


Fig. 3

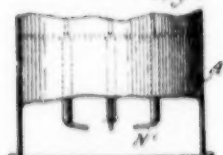
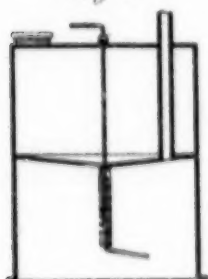


Fig. 5

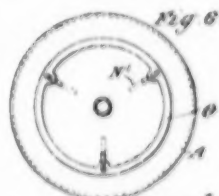


Fig. 6

Witnesses:
A. White
J. P. Donnan

Inventor
Frederic E. Baldwin
by his atty.
Philip J. Lamp, Re. & County

89 UNITED STATES PATENT OFFICE.

FREDERIC E. BALDWIN, OF NEW YORK, N. Y.

ACETYLENE-GAS-GENERATING LAMP.

13,542.

Specification of Reissued Letters Patent. Reissued Mar. 11, 1913.

Original No. 881,580 dated May 22, 1906, Serial No. 125,267. Application for reissue filed February 1, 1912. Serial No. 746,206.

To all whom it may concern:

Be it known that I, FREDERIC E. BALDWIN, a citizen of the United States, residing in New York, county of Richmond, and State of New York, have invented certain new and useful Improvements in Acetylene-Gas-Generating Lamps, fully described and represented in the following specification and the accompanying drawings, forming a part of the same.

The invention upon which is based the present application for Letters Patent is a lamp designed to generate and burn acetylene or similar gas, and is an improvement on the form described and shown in a patent granted to me August 28, 1900, No. 646,874. Like the lamps of said patent, that of the present application is intended for use and adapted to use as a bicycle, automobile, yacht, or miner's lamp, or for any other analogous purpose, it being necessary only to change its form or dimensions to adapt it to any one of the purposes mentioned.

In the drawings hereto annexed, Figure 1 is a central vertical section of the complete lamp. Fig. 2 is a similar view of a portion of the lamp, exhibiting a modification. Fig. 3 is a similar view of a further modification. Figs. 4, 5, and 6 are details of parts of the lamp, showing another modification.

The features of novelty which characterize my present invention reside in details of construction and will be pointed out in the course of the following description of the devices illustrated in the drawings and the manner of using the same, and more particularly specified in the subjoined claims.

Generally considered, the lamp is one comprising a metallic or other receptacle A, preferably provided with a bottom B, which may be readily detached and which when the lamp is in use is held firmly in position by suitable clamps C, so as to make a water and gas tight closure.

The receptacle is divided, preferably horizontally, by a partition D into two compartments, the upper one, E, designed to serve as a water-chamber or reservoir, the lower, F, as a gas-generating chamber adapted to contain a receptacle G for calcium carbide, which is generally attached to or forms the detachable bottom.

In the top of the lamp is an orifice closed by a screw cap H or similar device for the introduction of water to the reservoir, and

from the gas-generating chamber F through the water-reservoir E and out through the top of the lamp extends a tube I, which conducts the gas to the burner J.

I proceed now to a detailed description of the features enumerated below, which I have devised as improvements in lamps of the general character above described.

The means for effecting and controlling the generation of gas.—A quantity of calcium carbide, preferably in a finely divided condition, is placed in the receptacle G and retained by any suitable device, such as a spiral spring K, interposed between the bottom of the water reservoir E and a loosely fitting or perforated plate K', care being taken to adjust the tension of the spring so that the proper degree of pressure will be exerted upon the mass of carbide. A tube L leads from the water-reservoir down into the receptacle G and forms a duct which introduces the water into the body of carbide which said receptacle is designed to contain.

Various means have been employed to regulate or control the normal rate of flow of water through a water-supply tube. For example, the bore of the tube has been made of small diameter; but this plan has not been found practical for various reasons. In the first place, the discharge outlet thereof is under pressure of several inches of water, and it is practically impossible to make the bore so minute that the water will issue in sufficiently small quantity. If the attempt is made to secure this small flow by making the tube very minute, it then becomes so easily clogged that the operation of the lamp is rendered extremely uncertain. The smallest particle of foreign matter in the water or a bit of slaked carbide carried into the bore by back pressure of the gas will stop the flow completely, and the lamp will go out. Such a tube is also difficult, in fact, almost impossible, to clean. Another method which has been employed is to use a duct of comparatively large bore and fill the same with a wick of more or less loose texture for the purpose of checking the supply. This for a time operates with some degree of success, though from the very nature of the material used the precise amount of the feed can never be exactly determined. A valve is generally necessary to regulate the supply. Furthermore, when the lamp has been used for a time the wick, which of

course must act as a strainer, becomes filled with solid matter—such as sand, dirt, and organic particles contained in the water—so that the feed is reduced. This necessitates frequent adjustment of the valve to restore the proper supply. In time the wick becomes completely choked, and the user, often unskilful in such matters, must tamper with the lamp and insert a new wick, which is at best a troublesome procedure. Again, if the lamp has not been used for some time the wick dries out, and a very appreciable time is required to soak it up so that the water will again flow through.

The method which I have invented for securing the proper feed under all circumstances without the above objectionable features is to make the bore of the duct of comparatively large size, extend the tube, which forms the duct downward so that its end will be always embedded in the carbid, and then restrict the duct by means of a wire or rod preferably centrally located therein to leave a channel of the proper size. This arrangement is simple; but in a long experience it has been found to be entirely successful. It is possible to secure the correct drop-by-drop feed with a duct of considerable size, since the friction of the water on the large area of the tube-wall and wire reduces its flow. This retarding-friction may be regulated by varying the size of wire used. The duct does not become choked, since if foreign particles are deposited therein the water can take a zigzag course around it without the supply being appreciably affected. If it is at any time necessary to clean the tube, the wire is simply reciprocated and rotated a few times from the outside of the lamp without disturbing the position of other parts. This nice regulation of the flow enables me to entirely dispense with the troublesome adjustment of the valve. If a valve is used at all, it is employed to shut off the flow entirely and not to regulate it. The construction just described is shown in Fig. 1, in which L is the water-supply tube, and N the constricting wire. In this illustration the size of the parts is of course exaggerated. Fig. 2 shows a similar construction with a valve M on the constricting-wire M' which may be set by turning the screw-plug M' in the top of the lamp. In some cases, however, there is employed in connection with the means for introducing the water into the mass of carbid a device in the nature of a stirrer, which on proper manipulation may be used to break up the mass of carbid surrounding the outlet of the water duct and which by having become slaked and caked by the action of water prevents the proper percolation of the latter to the unslaked carbid in the receptacle G, Fig. 1. As such device I employ a stem or rod N, which extends down through

the tube L and is bent at substantially right angles to form an arm N'. This rod may form a prolongation of the valve-stem M' of Fig. 2 or in case no valve is used may extend from the top of the lamp down through the water-reservoir, as shown in Fig. 3. It will be understood from what has been said that the function of the stirrer is to break up, pierce or disturb the particles of the slaked carbid mass which, when the lamp is in use, forms at the delivery end of the tube. This slaked carbid mass tends to solidify and either shuts the water off altogether or restricts it so that less water is delivered from the water tube than the lamp demands for efficient operation. As it is sufficient, under certain circumstances, to insure the requisite water flow by so manipulating the stirrer, as to pierce, break up, or loosen the slaked carbid mass immediately around or at the mouth of the tube, it is obvious that the stirrer need not always be formed with a bent end or so as to extend radially from the mouth of the tube.

As calcium carbid possesses strongly absorptive properties, the introduction of water through the tube L will result in the gradual slaking of the material about its outlet; but the lime thus produced becomes gradually less permeable to the water, so that an insufficient quantity of gas is generated to maintain the proper flame. When this becomes noticeable, the rod N is turned, so as to cause the arm N' to break up to a greater or less extent the mass of lime, and in practice I have found that under ordinary conditions this is amply sufficient to insure a substantially uniform generation of gas until all of the carbid in the receptacle G is exhausted.

In the larger-sized lamps it is desirable to employ two or more water-tubes L and, if desired, stirring-rods N, extending down to different points in the carbid-receptacle. This is indicated in Fig. 4, which is an under plan view of the bottom D of the water-reservoir, showing three water-tubes L in section. It is, however, desirable when a plurality of stirring rods are employed that some means be provided for actuating all of them simultaneously. A device suitable for this purpose is shown in Fig. 6, in which O is a ring placed on top of the lamp, with which bent ends of all the rods N engage, so that a partial rotation of the ring will impart a corresponding movement to each rod.

The means for consuming an excess of gas.—Although the means described above effect a remarkably uniform generation of gas, it sometimes occurs that an amount of gas in excess of that required for the burner is temporarily produced, and the usual plan is to provide some channel for its escape into the air. When the lamps are used in con-

lined places, however, this method of disposing of the unconsumed gas is objectionable, owing to its very disagreeable odor. To remedy this, I provide a channel of escape, which terminates in the immediate vicinity of the burner proper, so that any excess of gas which may issue will be ignited by the flame of the burner and consumed. This may be accomplished in various ways; but the most practical of which I am at present aware is that shown in Fig. 1. In this figure there is shown a tube P, which extends downward from the top of the lamp to a point near the orifice of the water-tube L in the lower part of the water-reservoir E. The rod N extends through this tube without leaving sufficient space for passage of escaping gas. The air to replace the water which flows into the carbide-chamber enters through the burner and tube hereinafter described. When more gas is generated than is carried off by the burner tube, it forces the water up through the tube L and enters the water-reservoir. Practically none of the gas will find its way up the tube P under any circumstances, but rising to the upper part of the reservoir E it escapes through a tube R, provided with a vent S of such character as to constitute a burner and in such close proximity to the main burner J that any gas issuing through it will be ignited by the flame of the latter and burned.

The specific construction of the various parts of my lamp may be, as will be seen from a consideration of the nature of the improvements, very greatly varied without departing from the invention.

What I claim is:—

1. In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbide, of a tube extending from the former a considerable distance into the latter so as to be embedded in the mass of carbide contained in said receptacle, and a rod or stem extending through said tube into the carbide-receptacle and having its end formed as a stirrer to break up the slaked carbide around the outlet of the water-tube, as set forth.
2. In a lamp of the kind described, the

combination with a water-reservoir, and a receptacle for calcium carbide, of a tube extending from the former into the latter so as to be embedded in the mass of carbide contained in the receptacle, a rod extending from a point outside of the lamp through the tube and into the carbide-chamber and having its end bent to form a stirrer for breaking up the slaked carbide around the outlet of the water-tube, as set forth.

3. In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbide, of a plurality of tubes extending from the former into the latter so as to be embedded in the mass of carbide contained in the receptacle, a stirrer passing through each tube adapted to break up the slaked carbide around the end of the tube, and means for actuating all the stirrers simultaneously, as set forth.

4. In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbide, of a water-tube extending from the former a considerable distance into the latter and adapted to be embedded in the mass of carbide in the receptacle, and a rod extending through the water-tube, and constituting a stirrer to break up slaked carbide around the outlet of the water tube, the rod operating to restrict and thus control the flow of water to the carbide, as set forth.

5. In a lamp of the kind described, the combination with a water-reservoir, a carbide-receptacle, and a tube restricted by a wire extending into the carbide-receptacle from outside the lamp and open to the water-reservoir, a tube exterior to the lamp, connected with the reservoir and adjacent to the main burner, and equipped with a burner, said auxiliary burner acting as an air-vent to admit air during the normal operation of the lamp.

In witness whereof I have hereunto set my hand in the presence of two subscribing witnesses.

FREDERIC E. BALDWIN.

Witnesses:

AGUSTA WHITE,
JAMES Q. RICE.

F. E. BALDWIN.
ACETYLENE GAS GENERATING LAMP.

APPLICATION FILED JULY 19, 1903.

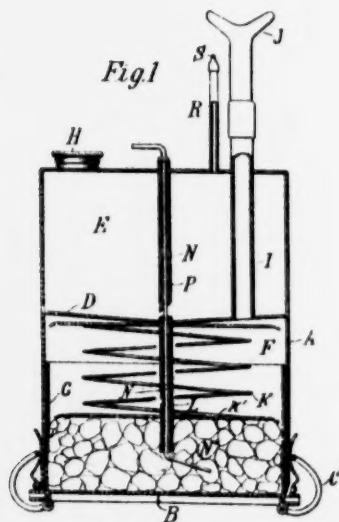
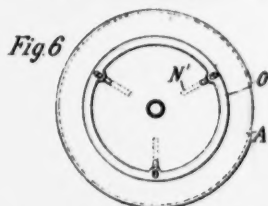
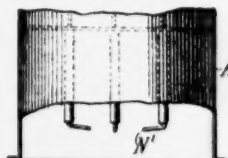
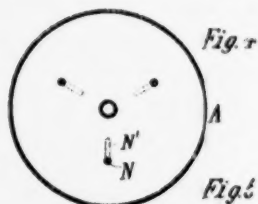
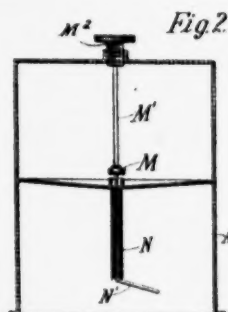
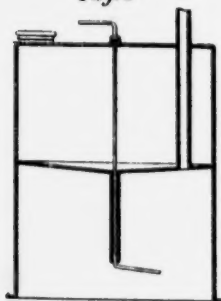


Fig. 3



Witnesses:
Thos. J. Rymer
Ed. Dunham

Frederic E. Baldwin Inventor
by Kerr, Page & Co. Pat. Attys

95 UNITED STATES PATENT OFFICE.

FREDERIC E. BALDWIN, OF NEW YORK, N. Y.

ACETYLENE-GAS-GENERATING LAMP.

No. 821,880.

Specification of Letters Patent.

Patented May 22, 1906.

Application filed July 15, 1903. Serial No. 185,587.

REISSUED

To all whom it may concern:

Be it known that I, FREDERIC E. BALDWIN, a citizen of the United States, residing at New Brighton, in the city of New York, county of Richmond, and State of New York, have invented certain new and useful Improvements in Acetylene-Lamps, of which the following is a specification, reference being had to the drawings accompanying and forming a part of the same.

The invention upon which is based the present application for Letters Patent is a lamp designed to generate and burn acetylene or similar gas, and is an improvement on the form described and shown in a patent granted to me August 28, 1900, No. 656,874. Like the lamps of said patent, that of the present application is intended for use and adapted to use as a bicycle, automobile, yacht, or miner's lamp or for any other analogous purpose, it being necessary only to change its form or dimensions to adapt it to any one of the purposes mentioned.

In the drawings hereto annexed, Figure 1 is a central vertical section of the complete lamp. Fig. 2 is a similar view of a portion of the lamp, exhibiting a modification. Fig. 3 is a similar view of a further modification. Figs. 4, 5, and 6 are details of parts of the lamp, showing another modification.

The features of novelty which characterize my present invention reside in details of construction and will be pointed out in the course of the following description of the devices illustrated in the drawings and the manner of using the same, and more particularly specified in the subjoined claims.

Generally considered, the lamp is one comprising a metallic or other receptacle A, preferably provided with a bottom B, which may be readily detached and which when the lamp is in use is held firmly in position by suitable clamps C, so as to make a water and gas tight closure.

The receptacle is divided, preferably horizontally, by a partition D into two compartments, the upper one, E, designed to serve as a water-chamber or reservoir, the lower, F, as a gas-generating chamber adapted to contain a receptacle G for calcium carbide, which is generally attached to or forms the detachable bottom.

In the top of the lamp is an orifice closed by a screw-cap H or similar device for the introduction of water to the reservoir, and from the gas-generating chamber F through the

water-reservoir E and out through the top of the lamp extends a tube I, which conducts the gas to the burner J.

I proceed now to a detailed description of the features enumerated below, which I have devised as improvements in lamps of the general character above described.

The means for effecting and controlling the generation of gas.—A quantity of calcium carbide, preferably in a finely-divided condition, is placed in the receptacle G and retained by any suitable device, such as a spiral spring K, interposed between the bottom of the water-reservoir E and a loosely fitting or perforated plate K', care being taken to adjust the tension of the spring so that the proper degree of pressure will be exerted upon the mass of carbide. A tube L leads from the water-reservoir down into the receptacle G and forms a duct which introduces the water into the body of carbide which said receptacle is designed to contain.

Various means have been employed to regulate or control the normal rate of flow of water through a water-supply tube. For example, the bore of the tube has been made of small diameter; but this plan has not been found practical for various reasons. In the first place, the discharge-outlet thereof is under pressure of several inches of water, and it is practically impossible to make the bore so minute that the water will issue in sufficiently small quantity. If the attempt is made to secure this small flow by making the tube very minute, it then becomes so easily clogged that the operation of the lamp is rendered extremely uncertain. The smallest particle of foreign matter in the water or a bit of slaked carbide carried into the bore by back pressure of the gas will stop the flow completely, and the lamp will go out. Such a tube is also difficult, in fact almost impossible, to clean. Another method which has been employed is to use a duct of comparatively large bore and fill the same with a Wick of more or less loose texture for the purpose of checking the supply. This for a time operates with some degree of success, though from the very nature of the material used the precise amount of the feed can never be exactly determined. A valve is generally necessary to regulate the supply. Furthermore, when the lamp has been used for a time the Wick, which of course must act as a strainer, becomes filled with solid matter—such as sand, dirt, and organic particles contained in the water—so that the

feed is reduced. This necessitates frequent adjustment of the valve to restore the proper supply. In time the wick becomes completely choked, and the user, often unskilful in such matters, must tamper with the lamp and insert a new wick, which is at best a troublesome procedure. Again, if the lamp has not been used for some time the wick dries out, and a very appreciable time is required to soak it up so that the water will again flow through.

The method which I have invented for securing the proper feed under all circumstances without the above objectionable features is to make the bore of the duct of comparatively large size and then restrict it by means of a wire or rod preferably centrally located therein to leave a channel of the proper size. This arrangement is simple; but in a long experience it has been found to be entirely successful. It is possible to secure the correct drop-by-drop feed with a duct of considerable size, since the friction of the water on the large area of the tube-wall and wire reduces its flow. This retarding-friction may be regulated by varying the size of wire used. The duct does not become choked, since if foreign particles are deposited therein the water can take a zigzag course around it without the supply being appreciably affected. If it is at any time necessary to clean the tube, the wire is simply reciprocated and rotated a few times from the outside of the lamp without disturbing the position of other parts. This nice regulation of the flow enables me to entirely dispense with the troublesome adjustment of the valve. If a valve is used at all, it is employed to shut off the flow entirely and not to regulate it. The construction just described is shown in Fig. 1, in which L is the water-supply tube, and N the constricting-wire. In this illustration the size of the parts is of course exaggerated. Fig. 2 shows a similar construction with a valve M on the constricting-wire M', which may be set by turning the screw-plug M'' in the top of the lamp. In some cases, however, there is employed in connection with the means for introducing the water into the mass of carbide a device in the nature of a stirrer, which on proper manipulation may be used to break up the mass of carbide surrounding the outlet of the water-duct and which by having become alaked and caked by the action of water prevents the proper percolation of the latter to the unalaked carbide in the receptacle G, Fig. 1. As such device I employ a stem or rod N, which extends down through the tube L and is bent at substantially right angles to form an arm N'. This rod may form a prolongation of the valve-stem M' of Fig. 2 or in case no valve is used may extend from the top of the lamp down through the water-reservoir, as shown in Fig. 3.

As calcium carbide possesses strongly absorbent properties, the introduction of water through the tube L will result in the gradual alaking of the material about its outlet; but the lime thus produced becomes gradually less permeable to the water, so that an insufficient-quantity of gas is generated to maintain the proper flame. When this becomes noticeable, the rod N is turned, so as to cause the arm N' to break up to a greater or less extent the mass of lime, and in practice I have found that under ordinary conditions this is amply sufficient to insure a substantially uniform generation of gas until all of the carbide in the receptacle G is exhausted.

In the larger-sized lamps it is desirable to employ two or more water-tubes L and, if desired, stirring-rods N, extending down to different points in the carbide-receptacle. This is indicated in Fig. 4, which is an under plan view of the bottom D of the water-reservoir, showing three water-tubes L in section. It is, however, desirable when a plurality of stirring-rods are employed that some means be provided for actuating all of them simultaneously. A device suitable for this purpose is shown in Fig. 6, in which O is a ring placed on top of the lamp, with which bent ends of all the rods N engage, so that a partial rotation of the ring will impart a corresponding movement to each rod.

The means for consuming an excess of gas.—Although the means described above effect a remarkably uniform generation of gas, it sometimes occurs that an amount of gas in excess of that required for the burner is temporarily produced, and the usual plan is to provide some channel for its escape into the air. When the lamps are used in confined places, however, this method of disposing of the unconsumed gas is objectionable, owing to its very disagreeable odor. To remedy this, I provide a channel of escape, which terminates in the immediate vicinity of the burner proper, so that any excess of gas which may issue will be ignited by the flame of the burner and consumed. This may be accomplished in various ways; but the most practical of which I am at present aware is that shown in Fig. 1. In this figure there is shown a tube P, which extends downward from the top of the lamp to a point near the orifice of the water-tube L in the lower part of the water-reservoir E. The rod N extends through this tube without leaving sufficient space for passage of escaping gas. The air to replace the water which flows into the carbide-chamber enters through the burner and tube hereinafter described. When more gas is generated than is carried off by the burner-tube, it forces the water up through the tube L and enters the water-reservoir. Practically none of the gas will find its way up the tube P under any circumstances, but rising to the upper part of the reservoir E it escapes through

a tube R, provided with a vent S of such character as to constitute a burner and in such close proximity to the main burner J that any gas issuing through it will be ignited by the flame of the latter and burned.

The specific construction of the various parts of my lamp may be, as will be seen from a consideration of the nature of the improvements, very greatly varied without departing from the invention.

What I claim is —

1. In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbid, of a tube extending from the former a considerable distance into the latter so as to be embedded in the mass of carbid contained in said receptacle, and a rod or stem extending through said tube into the carbid-receptacle and having its end formed as a stirrer to break up the slaked carbid around the outlet of the water-tube, as set forth.

2. In a lamp of the kind described, the combination with a water-reservoir, and a receptacle for calcium carbid, of a tube extending from the former into the latter so as to be embedded in the mass of carbid contained in the receptacle, a rod extending from a point outside of the lamp through the tube and into the carbid-chamber and having its end bent to form a stirrer for breaking up the slaked carbid around the outlet of the water-tube, as set forth.

3. In a lamp of the kind described, the

combination with a water-reservoir, and a receptacle for calcium carbid, of a plurality of tubes extending from the former into the latter so as to be embedded in the mass of carbid contained in the receptacle, a stirrer passing through each tube adapted to break up the slaked carbid around the end of the tube, and means for actuating all the stirrers simultaneously, as set forth.

4. In a lamp of the kind described, the combination with a water-reservoir and a receptacle for calcium carbid, of a water-tube extending from the former a considerable distance into the latter and adapted to be embedded in the mass of carbid in the receptacle, and a rod extending through the water-tube and constituting a stirrer to break up slaked carbid around the outlet of the water-tube, as set forth.

5. In a lamp of the kind described, the combination with a water-reservoir, a carbid-receptacle, and a tube restricted by a wire extending into the carbid-receptacle from outside the lamp and open to the water-reservoir, a tube exterior to the lamp, connected with the reservoir and adjacent to the main burner, and equipped with a burner, said auxiliary burner acting as an air-vent to admit air during the normal operation of the lamp.

FREDERIC E. BALDWIN.

Witnesses:

N. LAWSON DYER,
S. S. DUNHAM.

98 In the United States Circuit Court of Appeals for the Third Circuit, March Term, 1920.

No. 2535.

GRIER BROTHERS COMPANY, Appellant,

vs.

FREDERIC E. BALDWIN and JOHN SIMMONS COMPANY, Appellees.

And afterwards, to wit, on the second and third days of March, 1920, come the parties aforesaid by their counsel aforesaid, and this case being called for argument sur pleadings and briefs, before the Hon. Joseph Bullington, Hon. Victor B. Woolley and Hon. Thomas G. Haight, Circuit Judges, and the Court not being fully advised in the premises, takes further time for the consideration thereof.

And afterwards, to wit, on the sixteenth day of April, 1920, come the parties aforesaid by their counsel aforesaid, and the Court now being fully advised in the premises, renders the following decision:

In the Circuit Court of the United States for the Third Circuit, March Term, 1920.

No. 2535.

GRIER BROTHERS COMPANY, Appellant,

vs.

FREDERIC E. BALDWIN and JOHN SIMMONS COMPANY, Appellees.

Appeal from the District Court of the United States for the Western District of Pennsylvania.

Before Bullington, Woolley and Haight, Circuit Judges.

BUFFINGTON, J.:

In this case, Frederic E. Baldwin and the John Simmons Company, citizens of New York State, filed a Bill in Equity in the court below against The Grier Brothers Company, a citizen of Pennsylvania, invoking its jurisdiction on such diversity of citizenship. The Bill charged unfair competition. By the same Bill, invoking jurisdiction on the ground of patent subject-matter, the same plaintiffs, being the owners of Reissue Patent No. 13542 on No. 821,580, issued to said Baldwin on May 22, 1906, for an acetylene gas lamp, charged the same defendant with infringement thereof. On application for a preliminary injunction on both causes of action, the Court below in an opinion reported at 210 Fed. Rep. 560, held the cause of action for unfair competition was established, and granted the preliminary

injunction prayed for. As to the second cause of action, viz: 99 infringement of the patent, it deferred action by injunction until final hearing. On such final hearing that Court, pursuant to an opinion reported at 215 Fed. Rep. 740, entered a decree, holding the reissue patent valid and infringed, and that the defendant was also guilty of unfair competition. On appeal, this Court, pursuant to an opinion reported at 219 Fed. Rep. 735, affirmed the lower Court's decree on the cause of action of unfair competition, but reversed it on the patent cause of action. Pursuant to this opinion, which was rendered January 22, 1915, the record, with this Court's mandate, was remitted to the Court below on February 24, 1915. No steps were taken in the Court below by either party, to enter a decree in accordance with the mandate, for almost a year, when at the plaintiff's suggestion, the decree was entered, to which we later refer.

In this intervening year, the plaintiffs were engaged in other litigation on this patent. They had filed a Bill in the Southern District of New York, charging a third party with infringement of this patent. In this case the Court on February 6, 1915, filed an opinion, reported at 227 Fed. Rep. 455, holding the patent valid and infringed. On appeal, this decree was affirmed by the Circuit Court of Appeals of the Second Circuit in an opinion dated November 9, 1915, and reported at 228 Fed. Rep. 895, and as we hereafter note, the case was affirmed by the Supreme Court at 245 U. S. 198. On December 20, 1915, the defendant in the said case, presented to the Supreme Court of the United States a petition for a writ of certiorari to review the foregoing opinion, and on January 10, 1916, the Supreme Court granted such writ. Such being the situation, and the plaintiffs being, as we have seen, parties to the then pending case in the Supreme Court of the United States, they on January 5, 1916, presented to the Court below a form of decree for entry in the present case in pursuance of the mandate of this Court, which decree stated it was on motion of plaintiffs' counsel, and was entered on said day. As to the cause of action for unfair competition, such decree adjudged the defendant guilty of unfair competition, referred such cause of action to a master for ascertainment of damages, and granted a permanent injunction enjoining defendant from selling the lamps which constituted unfair competition. As to the patent cause of action, the decree dismissed the bill.

After this decree was thus entered on January 5, 1916, the term ended without further action, and it so remained for some two years, when on January 26, 1918, the plaintiffs filed a Bill to review the decree which had been entered on their motion on January 5, 1916. The ground on which this Bill of Review rested, was the recited decision of the Supreme Court made subsequent to the entry of the decree in the Court below. The latter Court, in an opinion printed in the margin,* sustained this contention and held that as to

* "While bills of review are not favored in equity, yet they have long been recognized as effective means of securing relief against decrees of the Court. Their uses and their limitations in the past are well considered in the opinion delivered by Mr. Justice Baldwin, while sitting in the Circuit Court of the

100 the sixth paragraph of the decree of January 5, 1916, which read, "6th. That the bill of complaint herein as to infringement of Reissue Patent No. 13542 in suit, be, and the same hereby is, dismissed," be vacated and that it now be decreed the said patent was valid and infringed. Accordingly, on November 7, 1919, such decree vacating the said sixth paragraph of the decree of January 5, 1916, awarding a permanent injunction and directing an accounting, was entered. Thereupon this appeal was taken, and the question before us is whether, under the facts and circumstances of this case, the bill to review would lie.

United States for the Eastern District of Pennsylvania, in *Poole vs. Nixon*, 9th Peters, 765. The recognition by him of the embodiment of Lord Bacon's ordinance as part of the law in equity, which has been adopted by the constitution of the United States, has been many times approved. That ordinance provides that "no bill of review shall be admitted except it contain either error in law appearing in the body of the decree, without further examination of matters of fact, or some new matter which hath arisen in time after the decree," etc. In the case at bar, plaintiffs do not rely upon any new matter which has arisen after the decree, but rely upon an error of law. That error of law is charged to be the decision by the Court of Appeals of the Third Circuit, that the re-issue patent aforesaid is invalid, in that the said re-issue had the effect of broadening the original patent. The plaintiffs, in support of their contention that the decree was based upon an error of law, offered the decree aforesaid of the Supreme Court of the United States sustaining the decision of the Court of the Second Circuit and thereby holding, as a matter of law, that said re-issue patent did not broaden the original patent.

It must be found that there was error of law as charged. In the first place, the law, as interpreted by the Supreme Court of the United States, is the law which should govern all subordinate Federal Courts. In the second place, if the later decision of the Supreme Court of the United States cannot be invoked for the relief of the plaintiffs, they are in a situation not contemplated by the States when they gave authority to Congress to secure to inventors the exclusive right to their discoveries and inventions for a limited period, or by the Congress of the United States when it legislated in pursuance of such authority. By the decision of the Supreme Court of the United States, the validity of the re-issue patent may secure to the plaintiffs rights thereunder in all parts of the United States, except within the limitations of the Third Judicial Circuit. Plaintiffs' rights to the invention would not be exclusive for any period within that Circuit in which is embraced the great anthracite and bituminous coal fields of the State of Pennsylvania.

The plaintiffs are not seeking to correct supposed erroneous deductions or conclusions from the evidence submitted in the original case. They set up an error of law apparent on the face of the record, without any further examination of matters of fact. The error of law was the alleged improper application of the provisions of the Revised Statutes Section 4916 relating to re-issue of defective patents, to the re-issued patent in suit. The effect of the decision of the Court of Appeals of the Third Circuit is that the Commissioner exceeded the authority vested in him by said section, whereas, the decision of the Supreme Court aforesaid was to the effect that the Commissioner did not exceed the authority granted to him by said section.

The defendant has cited *Scotten vs. Littlefield*, 235 U. S. 407, as a complete precedent which should govern the present case and require a dismissal of the bill of review. Had the Court in that case not dismissed the bill of review, there would have necessarily been a further examination of matters of fact and the consideration of a question which was held back in other proceedings and subsequently made the subject of a bill of review. It is insisted by counsel for the defendant that in the case just cited, the Supreme Court squarely holds that a subsequent decision by it will not lay the ground for a bill of review. To this proposition the Court cannot agree.

It is objected on the part of the defendant, that the plaintiffs have lost their

It will be noticed from the recital of the different steps in this litigation, that the situation is one of the plaintiffs' own creation. 101 After the decision of this Court was made but before its mandate went down, the plaintiffs knew of the decision of the District Court in the case in the Second Circuit, but they made no request to this Court to withhold its mandate. After the mandate went down and before a decree pursuant thereto had been entered in the Court below, they knew of the affirmance of the latter case by the Circuit Court of Appeals of the Second Circuit, and that the two Circuits were in conflict, but they made no requests to either

right to file a bill of review by their failure to petition to the Supreme Court for a writ of certiorari to review the judgment of the Circuit Court of Appeals for the Third Circuit. At that time, the petition for writ of certiorari would have shown to the Supreme Court that there was involved nothing but a matter of private interest which the Supreme Court, in accordance with its practice, would probably have refused to consider. It was not until the decision of the Court of Appeals for the second Circuit had been made that there appeared to be a conflict between two Courts of Appeal. The conflict between the two Courts of Appeal created a condition which, under the decisions of the Supreme Court, gave promise to the unsuccessful party in the later case, that the writ of certiorari would be granted.

In *Forsyth vs. Hammond*, 106 U. S. 506-514, we find expression by the Supreme Court of the extent of its power in certiorari and also of its practice and intent to exercise that power sparingly and only when the circumstances of the case satisfy us that the importance of the question involved, the necessity of avoiding conflict between two or more Courts of Appeal, or between Courts of Appeal and the Courts of a State, or some matter affecting the interests of this Nation, in its internal or external relations, demands such exercise.

The plaintiffs in this case had no right of appeal from the decision in the Third Circuit and had no right to a writ of certiorari to review the decree of that Court. They should not be deemed to have prejudiced their standing to maintain this bill of review, because they did not seek the remedy by certiorari which the decisions of the Supreme Court should lead them to believe would not be granted. There was no delay on the part of the plaintiffs in filing the bill after the decision of the Supreme Court which sustained the validity of the re-issued patent. There was good excuse for the prior delay in filing the bill, because of the pendency of the question before the Supreme Court of the United States.

Henry vs. A. B. Dick Company, 224 U. S. 1, involving certain phases of the law of patents, was decided March 11, 1912. In the case of *Motions Picture Patents Company vs. Universal Film Manufacturing Company*, 243 U. S. 352-518, the decision in *Henry vs. Dick Company* was squarely overruled by an opinion handed down on April 9, 1917. On May 21, 1917, a motion was made in the Supreme Court for leave to file a bill of review in the District Court of the United States for the Southern District of New York, in the said case of *Henry vs. A. B. Dick Company*, which motion was granted by the Supreme Court on June 11, 1917. In that case lapse of time was not permitted to prevent administration of justice. It follows necessarily that the plaintiffs are not only entitled to maintain their bill of review, but that the decree of this Court entered in pursuance of the mandate of the Court of Appeals for the Third Circuit, in so far as it held re-issued Patent No. 13,544 invalid, must be vacated and set aside and that a decree should be entered sustaining the validity of claim 4 of said re-issue, and finding the defendant guilty of infringement thereof. Plaintiffs are entitled also to an accounting for such infringement, but such accounting should be limited so that it should not antedate the date of the filing of the bill of review, for the decision of the Court of Appeals for the Third Circuit was the law of the case between the parties, at least until proceedings were instituted to have it set aside. Such limitation however, should not affect, in any way, the plaintiffs' rights to recover for unfair competition.

Court in this Circuit to have the entry of a decree withheld. On the contrary, with knowledge that the Supreme Court had on December 20, 1915, under consideration a petition for certiorari in the case in the Second Circuit, the plaintiffs became the actors in the quiescent case in this Circuit, and without advising the Court of the pendency of the matter in the Supreme Court, they prepared and on their motion had entered on January 5, 1916, the decree of dismissal, and thereafter, when the Supreme Court had on January 10, 1916, granted the certiorari, they allowed the term to end without any move to suspend, open or vacate the said decree of January 5, 1916. Under such circumstances, and in view of the fact that the entry of the decree at once gave them affirmative relief on their cause of action for unfair competition, it is quite manifest that the plaintiffs themselves and of their own motion, and without compulsion from anyone, chose to change the status of the case by themselves causing the decree, of which they afterwards complained, to be entered. At the time they prepared and had the decree entered, they knew the situation was one where they were making possible the bringing about of just such a situation as they now complain of. Such being the facts, the plaintiffs themselves, by their own course, brought about this situation. We start with the fact that if seeming hardship ensues, the plaintiffs and not the law have brought it on themselves.

Turning now to their alleged right by a bill of review to relieve themselves of this self-created situation, we note the general principle that a bill of review will not lie where the decree in question was a consent one: *Thompson vs. Maxwell*, 95 U. S. 391. Now, while the decree before us is not a decree based on a compromise or consent of the parties, yet as the entry of a decree dismissing the bill as to the patent was one in favor of the defendant, and the defendant was taking no step, it would seem that there is substantial ground for contending that when the plaintiffs themselves took the matter into their own hands and themselves prepared, moved and had entered the decree which dismissed their patent bill, such voluntary action on their part in entering the decree in favor of their adversary, was not only in form but in substance, and by positive act on their part, a consent, and, so far as they were concerned, a consent decree.

But, passing by the voluntary consent nature of this decree, we turn to the legal question whether the subsequent decision of the Supreme Court is a ground for a bill of review. Before entering on that legal question, we note the unsettling effect such a holding would have on the whole system of patents, if a final decree holding a patent invalid can be vacated years afterwards because in a case between other litigants, in another jurisdiction, the same patent has been adjudged valid by the Supreme Court of the United States.

Nor must we be misled by the at first sight seemingly grave situation of a patentee whose patent has in one Circuit been adjudged valid by the Supreme Court, at the same time adjudged invalid by a Circuit Court of Appeals in another Circuit. For such a situation is not one either created by law but wholly by the plaintiffs not avail-

ing themselves of the opportunity the law afforded them of preventing it. For, when the Circuit Court of Appeals of the Second Circuit held this patent valid and infringed, and there was a conflict of decision between two Circuit Courts of Appeals, such situation gave the plaintiffs reasonable ground for applying to the Supreme Court for a certiorari to review the adverse decree of this Court. We do not say the plaintiffs were bound to do so; we only say they could have so petitioned, and if an anomalous situation has arisen it is not because the law created it, nor is it a fault of our patent system, but it is one that might have been avoided by acts of commission or omission of the plaintiffs, (a) in petitioning the Supreme Court for a certiorari of the Third Circuit case, when on November 9, 1915, the Circuit Court of Appeals of the Second Circuit held the patent valid and infringed; (b) by applying to the Circuit Court of Appeals of the Third Circuit, when on December 20, 1915, the Supreme Court was petitioned for a writ of certiorari, to withhold entry of its decree pending action by the Supreme Court; and (c) by the plaintiffs abstaining from entering the decree of dismissal in the lower Court until the Supreme Court acted.

Such being the courses open to the plaintiffs before they procured the entry of this decree, we turn to the grave unsettling of patents which would follow if the stability and finality of a final patent decree once made is to be undermined by decisions subsequently made. For we are here dealing with the rights of individual litigants. Whatever effect such subsequent decisions may have on other cases and other litigants, it must not be overlooked that every question, uncertainty of litigation or doubt as to future conduct, are all centered and finally merged in the stability of a final decree, and that such decree being entered it becomes the settled law as between these particular litigants.

Such being the case, a final decree can only be set aside by a bill of review, and the principles on which bills of review rest are settled and form the bulwark of the stability of judicial decrees. The two and only grounds for a bill of review, are, first, error of law apparent on the face of the record without further examination of matters of fact; second, new facts discovered since the decree, which should materially affect the decree and probably induce a different result. *Scotten vs. Littlefield*, 235 U. S. 410. Such being the law as to bills of review, this case resolves itself into the question whether the subsequent decision of the Supreme Court on this patent at 245 U. S. 198, constituted one or both of such grounds. That it did not is, we think, decided by the Supreme Court itself in the case last cited, where that Court had occasion to pass on the question whether its decision in the *Gorman* case, 229 U. S. 19, made subsequent to a decree of the United States District Court, was a basis for a bill of review of the later case. That contention the Supreme Court met by holding "Such subsequent decision will not lay the ground for a bill of review for errors of law apparent, or for new matter in pais discovered since the decree and probably requiring a different result." In support of that view, the Court refers to *Tilghman vs. Werk*, 30 Fed. Rep. 380, and *Hoffman vs. Knox*, 50 Fed. Rep. 484. These

cases, which have thus been adopted as expressive of the views of the Supreme Court, are decisive of the case before us. In the 104 *Tilghman vs. Werk* case, it appeared that the Supreme Court had in *Mitchell vs. Tilghman*, 19 Wallace, 287, held a decree of the lower Court "was based upon the decision of the Supreme Court of the United States in case of *Mitchell vs. Tilghman*, 19 Wall., 287, holding the complainant's patent to be invalid, and that subsequently, in the case of *Tilghman vs. Proctor*, the Supreme Court had changed its ruling on said patent, holding the same to be valid, and that the decision in *Mitchell vs. Tilghman* was erroneous." Thereupon it was sought by a bill of review, to set aside the decree made before such decision, it being contended that the last decision of the Supreme Court "constitutes new matter in pais occurring since the decree, and furnished a good ground for sustaining the petition as to a bill of review." Addressing itself to that question, the Court said: "The question is presented whether a change of its ruling or decision by the Supreme Court on a question of law or fact, or upon a mixed question of law and fact, constitutes such new matter as will sustain a bill of review to vacate decrees of the Circuit Court pronounced before such change was made. We think upon principle and authority, this proposition cannot be maintained.—Such a rule would prolong litigation greatly, and render judicial decisions unstable in the highest degree." In *Hoffman vs. Knox*, supra, the Circuit Court entered a final decree, which adjudged a priority of liens pursuant to a state statute of Virginia. Subsequently this statute was held unconstitutional by the highest Court of Virginia. Thereupon it was sought by a bill of review to vacate such decree on the ground of this later decision, but the Court held "The fact that nearly eighteen months after the decree of October 14, 1887, the Court of Appeals of Virginia decided those laws to be unconstitutional for the reason stated, was not enough in itself to create error of law apparent, and justify a bill of review on that ground or that of new matter in pais."

These two decisions, as we have seen, having been cited with approval by the Supreme Court of the United States, we are of opinion that in deciding as we do, that the plaintiffs had shown no ground for a bill of review, this Court is following the decisions of the Supreme Court. We therefore restrict ourselves to referring to the views expressed by that Court in its own language, in *Scotten vs. Littlefield*, supra, and to its language by adoption in *Tilghman vs. Werk*, and *Hoffman vs. Knox*. And if we are right in so reading these decisions, we are warranted in refraining from discussing other decisions and text books bearing on this question.

In accordance with these views, the decree entered below on November 7, 1919, will be vacated and the decree entered by the Court below on January 5, 1916, will be reinstated.

Endorsements: 2535. Opinion of the Court by Buffington J. Received & Filed Apr. 16, 1920. Saunders Lewis, Jr., Clerk.

105 In the United States Circuit Court of Appeals for the Third Circuit, March Term, 1920.

No. 2535 (List No. 11.)

GRIER BROTHERS Co., Appellant,

vs.

FRED E. BALDWIN and JOHN SIMMONS COMPANY, Appellees.

Appeal from the District Court of the United States for the Western District of Pennsylvania.

This cause came on to be heard on the transcript of record from the District Court of the United States, for the Western District of Pennsylvania, and was argued by counsel.

On consideration whereof, it is now here ordered, adjudged and decreed by this Court, that the decree of the said District Court in this cause be, and the same is hereby reversed, with costs, with direction to the District Court that the decree entered on November 7, 1919, be vacated and that the decree entered on January 5, 1916, be reinstated.

Philadelphia, April 16, 1920.

JOS. BUFFINGTON,

Circuit Judge.

Endorsements: 2535. Order Reversing Decree, etc. Received & Filed Apr. 16, 1920. Saunders Lewis, Jr., Clerk.

UNITED STATES OF AMERICA,

Eastern District of Pennsylvania,

Third Judicial Circuit, etc.:

I, Saunders Lewis, Jr., Clerk of the United States Circuit Court of Appeals, for the Third Circuit, do hereby Certify the foregoing to be a true and faithful copy of the original record and proceedings in this Court in case of: Grier Brothers Company, Appellant, vs. Fred E. Baldwin, et al., Appellees, on file, and now remaining among the records of the said Court, in my office.

In Testimony Whereof, I have hereunto subscribed my name and affixed the seal of the said Court, at Philadelphia, this nineteenth day of July in the year of our Lord one thousand nine hundred

and twenty and of the Independence of the United States the one hundred and forty-fifth.

[Seal of the United States Circuit Court of Appeals, Third Circuit.]

SAUNDERS LEWIS, JR.,
*Clerk of the U. S. Circuit Court
of Appeals, Third Circuit.*

106 UNITED STATES OF AMERICA, ss:

[Seal of the Supreme Court of the United States.]

The President of the United States of America to the Honorable the Judges of the United States Circuit Court of Appeals for the Third Circuit, Greeting:

Being informed that there is now pending before you a suit in which The Grier Brothers Company is appellant, and Frederic E. Baldwin and John Simmons Company are appellees, No. 2535, which suit was removed into the said Circuit Court of Appeals by virtue of an appeal from the District Court of the United States for the Western District of Pennsylvania, and we, being willing for certain reasons that the said cause and the record and proceedings therein should be certified by the said Circuit Court of Appeals and removed into the Supreme Court of the United States, I
107 hereby command you that you send without delay to the said Supreme Court, as aforesaid, the record and proceedings in said cause, so that the said Supreme Court may act thereon as of right and according to law ought to be done.

Witness the Honorable Edward D. White, Chief Justice of the United States, the eleventh day of June, in the year of our Lord one thousand nine hundred and twenty.

JAMES D. MAHER,
Clerk of the Supreme Court of the United States.

Return to Writ of Certiorari.

UNITED STATES OF AMERICA,
Third Circuit, ss:

In obedience to the command of the within writ of certiorari, I herewith transmit to the Supreme Court of the United States a duly certified transcript of the record and proceedings in the within entitled cause, with all things concerning the same.

In testimony whereof, I hereunto subscribe my name and affix the seal of the United States Circuit Court of Appeals for the Third

Circuit in the City of Philadelphia, Pennsylvania, this 19th day of July, 1920.

[Seal of the United States Circuit Court of Appeals, Third Circuit.]

SAUNDERS LEWIS, JR.,
*Clerk U. S. Circuit Court of
Appeals for the Third Circuit.*

108 [Endorsed:] File No. 27,687. Supreme Court of the United States. No. 932. October Term, 1919. John Simmons Company vs. The Grier Brothers Company. Writ of Certiorari. Received Jul- 16, 1920. Saunders Lewis, Jr., Clerk.

109 [Endorsed:] File No. 27,687. Supreme Court U. S. October Term, 1920. Term 342. John Simmons Company, Petitioner, vs. The Grier Brothers Company. Writ of Certiorari and Return. Filed July 20th, 1920.

(1976)

Su
THE

PETIT

Office Supreme Court, U. S.
201 T. B. Y.

MAY 15 1920

No. 93234-57

JAMES D. MAHER,

Supreme Court of the United States.

OCTOBER TERM, A. D. 1919.

JOHN SIMMONS COMPANY,

Petitioner,

vs.

THE GRIER BROTHERS COMPANY,

Respondent.

On Petition for Writ of Certiorari
directed to the United States
Circuit Court of Appeals for the
Third Circuit.

PETITION FOR WRIT OF CERTIORARI AND REASONS RELIED
ON FOR THE ALLOWANCE OF THE WRIT.

JAMES Q. RICE,

Counsel for Petitioner.



IN THE
Supreme Court of the United States.

JOHN SIMMONS COMPANY, Petitioner, AGAINST THE GRIER BROTHERS COM- PANY, Respondent.	}
--	---

Notice of Motion.

TO THE GRIER BROTHERS COMPANY, the above named respondent.

PLEASE TAKE NOTICE that on Monday, May 31, 1920, at the opening of court on that day or as soon thereafter as counsel can be heard, a motion for a *writ of certiorari*, of which motion a copy is annexed hereto, will be submitted to the Supreme Court of the United States, at the City of Washington, District of Columbia, for the decision of the Court thereon. In support of said motion a petition and brief will also be presented to said Court, copies whereof are herewith served upon you.

Respectfully,

JAMES Q. RICE,
Attorney and Counsel for Petitioner.

Service of the foregoing notice of motion is hereby admitted this 12th day of May, 1920.

C. P. BYRNES,
Attorney and Counsel for Respondent.

IN THE
SUPREME COURT OF THE UNITED STATES.

JOHN SIMMONS COMPANY, Petitioner,	}
AGAINST	
THE GRIER BROTHERS COMPANY, Respondent.	

Motion.

Now comes John Simmons Company, by James Q. Rice, its attorney and counsel, and moves this Honorable Court that it should, by *writ of certiorari* or other proper process directed to the Honorable the Judges of the United States Circuit Court of Appeals for the **THIRD** Circuit, require said court to certify to this court for its review and determination, a certain cause in said court lately pending, wherein The Grier Brothers Company was appellant and Frederic E. Baldwin and John Simmons Company were appellees, and to that end now tenders herewith its petition, together with a certified copy of the entire record in said cause in said United States Circuit Court of Appeals.

JAMES Q. RICE,
Attorney and Counsel for John Simmons Company.

Service of the foregoing motion is hereby admitted this 12th day of May, 1920.

C. P. BYRNES,
Attorney and Counsel for Respondent.

IN THE
SUPREME COURT OF THE UNITED STATES.

October Term, A. D. 1919.

JOHN SIMMONS COMPANY,
Petitioner,

vs.

THE GRIER BROTHERS COM-
PANY,
Respondent.

On petition for
Writ of Certi-
orari directed
to the United
States Circuit
Court of Ap-
peals for the
Third Circuit.

PETITION.

TO THE HONORABLE THE CHIEF JUSTICE AND ASSO-
CIATE JUSTICES OF THE SUPREME COURT OF THE
UNITED STATES:

The petition of John Simmons Company, a cor-
poration of the State of New York, respectfully
prays for a *writ of certiorari*, directed to the
United States Circuit Court of Appeals for the
Third Circuit, ordering that the records and ex-
hibits in the case there entitled, The Grier Brothers
Company, Defendant-Appellant, *vs.* Frederic E.
Baldwin & John Simmons Company, Plaintiffs-
Appellants, Docket No. 2535, be certified to this

Honorable Court for a final review and determination, under the provisions of Section 6 of the Act of Congress of March 3, 1891, and represents:

FIRST: That the decision of the United States Circuit Court of Appeals of the Third Circuit holding that a bill of review will not lie in this cause is in direct conflict with the decision of the United States Circuit Court of Appeals of the Eighth Circuit in *Omaha Electric Light Co. v. City of Omaha*, 216 F. 848.

SECOND: That the decision of said United States Circuit Court of Appeals of the Third Circuit on the bill of review is directly contrary to the practice authorized by this Court in *Henry v. Dick Co.*, 244 U. S. 651.

THIRD: That the United States Circuit Court of Appeals of the Third Circuit erroneously held that the decree in *Baldwin v. Grier*, against which the bill of review was filed, is a consent decree.

FOURTH: That the United States Circuit Court of Appeals of the Third Circuit erroneously held that the decree, against which the bill of review was filed, is a final decree.

FIFTH: That the United States Circuit Court of Appeals of the Third Circuit misinterpreted the ground of the bill of review, and the authorities it cites do not apply.

SIXTH: That the decree works irreparable injury to the plaintiffs.

SEVENTH: That a bill of review is the proper remedy in this cause.

WHEREFORE, your petitioner prays that a writ of *certiorari* may be issued out of and under the seal of this Honorable Court, directed to the United States Circuit Court of Appeals for the Third Circuit, commanding said Court to certify and send to this Court a full and complete transcript of the record and all proceedings of said court in the said cause entitled The Grier Brothers Company, defendant-appellant, *versus* Frederic E. Baldwin and John Simmons Company, plaintiffs-appellees, to the end that the said cause may be reviewed and determined by this Court, as provided by law; and your petitioner prays that the judgment of the said United States Circuit Court of Appeals for the Third Circuit in the said cause may be reversed by this Honorable Court.

And your petitioner will ever pray, &c.

JOHN SIMMONS COMPANY,

By CHARLES H. SIMMONS,

President.

JAMES Q. RICE,

Attorney and Counsel for Petitioner.

City and County of New York, ss.:

CHARLES H. SIMMONS, being duly sworn, deposes and says: That he is the President of John Simmons Company, the foregoing petitioner; that he has read the foregoing petition subscribed by him, and that the facts therein stated are true to the best of his knowledge, information and belief.

CHARLES H. SIMMONS.

Subscribed and sworn to be-
fore me this 12th day of }
May, 1920.

AUGUSTA WHITE,

[SEAL]

Notary Public,

N. Y. Co.

I hereby certify that I have examined and read the foregoing petition for *writ of certiorari* and that in my opinion such petition is well founded, and should be granted by this Honorable Court, and that such petition is not filed for delay.

JAMES Q. RICE,

Counsel for Petitioner.

May 10, 1920.

BRIEF.

History of the Litigation.

Generally, the history of this litigation, so far as this application for *writ of certiorari* is concerned, is as follows:

The Court of Appeals of the Third Circuit in the case of *Baldwin & Simmons Co. v. Grier*, at final hearing, reversing the District Court for the Western District of Pennsylvania, held the Baldwin reissue patent 13,542 for a Miner's Lamp invalid on the ground that the reissue had been broadened (219 F. 735; Tr. pp. 3 to 10).

Thereafter, the Court of Appeals of the Second Circuit in *Baldwin & Simmons Co. v. Abercrombie & Fitch Co. and Justrite Manufacturing Co.*, affirming the District Court for the Southern District of New York, held this same Baldwin reissue patent 13,542 valid and infringed by the same lamp structure which was before the Court of Appeals for the Third Circuit (228 F. 895).

A *writ of certiorari* having been granted, this Court affirmed the Court of Appeals of the Second Circuit, and in its opinion (Tr. pp. 20-28) stated that it had given attention to

"especially the decision and reasoning of the Circuit Court of Appeals of the Third Circuit in *Baldwin et al. v. Grier Bros. Co.*, 219 Fed. 735, but we are constrained to a different conclusion. Indeed, we are of opinion that the original patent did not need the exposition of the reissue. It exhibited an invention of merit, certainly one entitled to invoke the doctrine of equivalents. *Paper Bag Patent Case*, 210 U. S. 405" (Tr. p. 26).

As soon as the mandate of this Court came down in this Second Circuit case, an application was made for leave to file a bill of review in the District Court for the Western District of Pennsylvania against the decree which had been entered on the mandate of the Court of Appeals of the Third Circuit. The application was denied on the ground that the District Court had no jurisdiction to act, but without prejudice to the renewal of the application to the Court of Appeals of the Third Circuit. Such application was accordingly made, whereupon the Court of Appeals of the Third Circuit made the following order:

"It is hereby ordered that the said plaintiffs-appellees have leave to make an application to said District Court to file a bill of review, and that said District Court be, and the same is, hereby authorized and empowered to take such action upon said petition as to it seems proper" (Tr. p. 15).

The District Court for the Western District of Pennsylvania thereupon allowed the bill of review to be filed and, upon final hearing, sustained the bill, vacated the decree which had been entered on the mandate of the Court of Appeals of the Third Circuit (Tr. pp. 43-48), and entered a new decree in accordance with the decision of this Court holding the patent valid and infringed. Defendant appealed to the Court of Appeals of the Third Circuit, which reversed the Court below, holding that the bill of review would not lie.

Thereupon this petition for a *writ of certiorari* is made to this court, praying this court to finally review this decision of the Court of Appeals of the Third Circuit and the proceedings relating to the bill of review.

Specifically, the history of the various proceedings in this cause is as follows:

- Oct. 14, 1913. Bill filed in the Western District of Pennsylvania by Baldwin & Simmons Co. *v.* Grier Bros. Co. charging infringement of reissue patent to Baldwin 13,504, for Miners' Lamp, and also charging unfair competition in trade.
- July 7, 1914. Decision of District Court of the Western District of Pennsylvania (Orr, *J.*) holding reissue patent 13,542 valid and infringed and finding defendant guilty of unfair competition in trade (215 F. 735).
- Jan. 22, 1915. Decision of the Court of Appeals of the Third Circuit, affirming the lower court as to unfair competition in trade but holding the reissue patent invalid because the reissue was broadened (219 F. 735; Tr. p. 3).
- Feb. 24, 1915. Mandate of the Court of Appeals of the Third Circuit sent down (Tr. p. 11).
- Jan. 5, 1916. Decree on the Mandate of the Court of Appeals for the Third Circuit entered in the District Court on motion of plaintiffs' solicitors (Tr. p. 13).
- May 20, 1913. Bill filed in the Southern District of New York on the same reissue patent 13,542, and against the same lamp structure, against Abercrombie & Fitch Co. and Justrite Mfg. Co. (Tr. p. 57).

- Feb. 6, 1915. Decision of the District Court of Southern District of New York (Mayer, J.) declining to follow the Court of Appeals of the Third Circuit, holding the patent valid and infringed (227 F. 455).
- Nov. 9, 1915. Decision of the Court of Appeals of the Second Circuit affirming the court below (228 F. 895).
- Dec. 20, 1915. Petition for *writ of certiorari* to this Court on the ground of conflicting decisions, on the same state of facts, by the Courts of Appeals of the Third and Second Circuits (Tr. p. 75).
- Jan. 10, 1916. Petition for *writ of certiorari* granted by this Court.
- Dec. 10, 1917. Decision of this Court affirming the Court of Appeals of the Second Circuit (Tr. p. 20; 245 U. S. 198).
- Jan. 18, 1918. Mandate of this Court sent down and order entered thereon (Tr. pp. 28-30).
- Jan. 26, 1918. Application to the District Court for the Western District of Pennsylvania, for permission to file a bill of review against the decree standing in that court.
- Mar. 13, 1918. Order of the Court of Appeals of the Third Circuit referring the petition for leave to file bill of review to the District Court (Tr. p. 15).
- Apr. 11, 1918. Bill of review filed (Tr. p. 17).
- Jan. 10, 1919. Supplemental bill filed in the District Court of the Third Circuit because of change of title (Tr. p. 37).

- Oct. 7, 1919. Opinions of the District Court sustaining the bill of review and vacating the degree standing therein (Tr. pp. 43-48).
- Apr. 14, 1920. Decision of the Court of Appeals of the Third Circuit, holding that the bill of review will not lie.

The decision of the Court of Appeals of the Third Circuit holding that a bill of review will not lie in this cause is in direct conflict with the decision of the Court of Appeals of the Eighth Circuit in Omaha Electric Light Co. v. City of Omaha, 216 F. 848.

The decision of the Court of Appeals of the Third Circuit, when the case was originally before it and in which it reversed the court below, was based solely on the ground that the patent in suit was invalid, the decision holding that the patent had been broadened by reissue. This Court on the *writ of certiorari* in the Second Circuit case specifically held that the reissue was not broadened. After quoting the matter which had been inserted in the specification and which the Court of Appeals of the Third Circuit held broadened the reissue, this Court said:

"We are unable to assign to this the extent of alteration that counsel do, nor do we think it necessary to rehearse the details of their argument. We have given it attention and the cases it cites, especially the decision and reasoning of the Circuit Court of Appeals of the Third Circuit in Baldwin *et al.* v. Grier Bros. Co., 219 Fed. 735, but we are constrained to a

different conclusion. Indeed, we are of opinion that the original patent did not need the exposition of the reissue. It exhibited an invention of merit, certainly one entitled to invoke the doctrine of equivalents. *Paper Bag Patent Case*, 219 U. S. 565 (Tr. p. 26).

There was, therefore, error of law apparent on the face of the decision of the Court of Appeals of the Third Circuit, this error being apparent without further examination of the facts. This error was an incorrect interpretation of Revised Statutes, Sec. 4916, relating to the issue of defective patents, and the misapplication of the provisions of this section to the patent in suit, this section being subsequently correctly interpreted and applied to the patent in suit by the District Court and the Court of Appeals of the Second Circuit. **This error was not made apparent nor was it caused to exist by reason of the decision of this Court.** It existed in the decision of the Court of Appeals *ab initio*, but after this Court had spoken the existence of this error of law was not open to denial.

The Court of Appeals of the Third Circuit in holding that a bill of review will not lie against its erroneous decision, under these circumstances, is in direct conflict with the decision of the Court of Appeals of the Eighth Circuit in *Omaha Electric Light Co. v. City of Omaha*, 216 F. 848. In this case, an electric light company brought suit to enjoin the City of Omaha from interfering with its transmitting wires. The Court of Appeals for the Eighth Circuit held that plaintiff's franchise had expired and an appeal to this Court was dismissed on the ground that a federal question was not

raised. Thereafter, Old Colony Trust Co., trustee of a mortgage on the Electric Light Company's property, brought suit against the City for the same purpose. The Court of Appeals again held that the franchise had expired. The case went to this Court which held (230 U. S. 100) that the franchise had not expired, thus reversing the decision of the Court of Appeals of the Eighth Circuit. A bill of review was thereupon filed in the first suit, *i. e.*, the suit in which the Electric Light Co. was the plaintiff. The Court of Appeals of the Eighth Circuit entertained this bill of review and vacated its decree in the first suit, saying (216 F., p. 851):

"If we have the power to revise our decree and issue a mandate in harmony with that of the Supreme Court, it is plainly our duty to do so. This we should do not only to protect the rights of the plaintiff as a litigant, but as a matter of public policy to preserve the orderly administration of justice and avoid an unseemly conflict of judicial mandates."

Again, pages 855, 856, the Court of Appeals said, referring to the decision of this Court in the other case:

"While no mandate can run from its decision to our decree, a mandate of judicial authority does run from it, which we ought not to disregard. * * * Certainly our duty is plain. We ought to harmonize our decree and mandate with those of the Supreme Court.

"* * * It is entirely plain that if the decision of the Supreme Court had been rendered before our decree, our decree would have been different. Applying the analogies of Lord Bacon's first ordinance in regard to bills of review, that decision constitutes new matter

which hath arisen since the decree. In fact, it is precisely the kind of new matter which the Chancellor had in mind in framing the second clause of his ordinance. This is plain from his sixth ordinance, which reads as follows:

'No decree shall be made upon pretense of equity against the express provision of an act of Parliament. Nevertheless, if the construction of such act of Parliament hath for a time gone one way in general opinion and reputation, and after, by a later judgment, hath been controlled, then relief may be given upon matter of equity for cases arising before the said judgment, because the subject was in no default.' * * *

In the case at bar and in the Omaha case there was, therefore, error of law on the face of the record which was apparent without further examination of questions of fact.

In the case at bar this error consisted in an erroneous application of the reissue statute. In the Omaha case it consisted in an erroneous application of the law relating to the expiration of the Electric Company's franchise. In each of these cases, there could be no doubt as to the existence of error after this Court had spoken. In each case a bill of review was filed. The Court of Appeals of the Eighth Circuit entertained the bill of review and reversed its former decision. The Court of Appeals of the Third Circuit has held that under the same circumstances a bill of review will not lie. There is, therefore, a direct conflict between the Courts of Appeal of the Third and Eighth Circuits as to the conditions under which a bill of review lies, and the matter should be finally determined by this Court.

The Omaha case was urged upon the Court of

Appeals of the Third Circuit but that Court does not refer to it in its opinion.

This matter becomes of grave importance in view of Section 1228a Compiled Statutes, in effect September 6, 1916, providing that a *writ of certiorari* will not be entertained unless the petition is applied for within three months after the entry of the judgment or decree complained of. It is obvious that two conflicting decisions of two courts of appeals and the judgments thereon, especially in patent cases, will, practically speaking, never be rendered within three months of each other. Until such conflicting decisions are rendered, there is usually no ground for application for *writ of certiorari*. If, after such conflicting decisions, a writ be granted in the second case and this Court renders a decision affirming the decision in the second case, the principles announced in the decision of this Court can never be applied to the first case, unless a bill of review will lie, no matter what the equities may be or how strongly the circumstances of the case may demand it.

The decision of the Court of Appeals of the Third Circuit on the bill of review is directly contrary to the practice authorized by this Court in *Henry v. Dick Co.*, 244 U. S. 651.

The case of *Henry v. Dick*, 224 U. S. p. 1, was certified to this Court from the Second Circuit. The question involved was that of contributory infringement and the decision of this Court was regarded as finally settling the law on that point. A final decree was entered in the Southern District of New York, this decree, among other things,

holding the patent valid and infringed and that an injunction issue.

After the decision of this Court in *Motion Picture Patents Co. v. Universal Film Co.*, 242 U. S. 637, overruling *Henry v. Dick*, the defendant Henry applied to this Court for permission to file a bill of review in the District Court for the Southern District of New York, against the decree which had been entered in *Henry v. Dick*. Although a final decree had then been entered for more than four years after the term in which that case had been disposed of by this Court, this Court granted the motion for permission to file a bill of review (244 U. S. 651). The bill of review was accordingly filed, the decree was revised and the injunction vacated.

Although the action of this Court in granting the bill of review in *Henry v. Dick* was strongly urged upon the Court of Appeals of the Third Circuit, it does not refer to it in its opinion.

Defendant urged at the argument before the Court of Appeals of the Third Circuit that the ruling of this Court in *Henry v. Dick* did not apply because there it enabled the Court to relieve the defendant from an injunction. Defendant's argument was reduced to this, namely, that where there is error in a patent case, if the error works injustice to the defendant the error may be corrected, but if the error works injustice to the plaintiff no remedy exists. It cannot be true that the defendant in a patent case has a remedy from a mistaken view of the law while the plaintiff is remediless. There cannot be one kind of law for a defendant and another for a plaintiff.

If a bill of review will lie to relieve a defendant from a miscarriage of justice in a patent case, and

this Court has held that it will, there certainly is no reason why a bill of review will not lie to relieve a plaintiff from a miscarriage of justice.

The Court of Appeals of the Third Circuit erroneously held that the decree in Baldwin v. Grier against which the bill of review was filed, is a consent decree.

The Court of Appeals of the Third Circuit announced the proposition that when a party to a suit prepares and presents for entry in a District Court a form of decree in accordance with the opinion and mandate of a Court of Appeals, the decree entered, so far as the party preparing and presenting is concerned, becomes a consent decree.

The Court of Appeals of the Third Circuit rests its decision that a bill of review will not lie in this case, in part on this extraordinary proposition:

The Court said:

"We note the general principle that a bill of review will not lie where the decree in question was a consent one: *Thompson v. Maxwell*, 95 U. S. 391. Now, while the decree before us is not a decree based on a compromise or consent of the parties, yet as the entry of a decree dismissing the bill as to the patent was one in favor of the defendant, and the defendant was taking no step, it would seem that there is substantial ground for contending that when the plaintiffs themselves took the matter into their own hands and themselves prepared, moved and had entered the decree which dismissed their patent bill, such voluntary action on their part in entering the decree in favor of their adversary, was not only in form but in substance, and by positive act on their part, a consent, and, so far as they were concerned, a consent decree.

The Court of Appeals of the Third Circuit adduces no authority for the doctrine here announced, and we know of none.

It is, of course, true that a bill of review will not lie from a consent decree, but it is equally true that an appeal will not lie from a consent decree. If, however, this pronouncement of the Court of Appeals of the Third Circuit is the law, if an unsuccessful plaintiff prepares and presents for entry a decree in accordance with the decision of the Court, that decree, as to the plaintiff, becomes a consent decree and the plaintiff by the act of preparing and presenting it *ipso facto* cuts himself off from the right of appeal. In such a case if the defendant refuses to prepare and present the decree all right of appeal would be cut off.

The Court of Appeals of the Third Circuit in its opinion refers to the fact that the decree gave the plaintiff "affirmative relief", referring thereby to plaintiff's right to begin accounting proceedings.

Now, in a patent case, in which a part of the claims are found valid and infringed and a part found invalid or not infringed, if the plaintiff prepares and presents a decree ordering an injunction and accounting on the claims sustained, he gains affirmative relief on the claims sustained. If the Court of Appeals of the Third Circuit is correct, however, he thereby cuts himself off from any right of appeal on the claims on which the Court has found against him, because the decree becomes, by the act of preparing and presenting it, a consent decree on the part of the plaintiff.

Further, a fair account in any case is an advantage to both parties and the plaintiffs in this case went no further with their accounting proceedings than to get an account stated and the books in the

hand of the Master. Accountings at best are difficult proceedings and where they cover transactions for a period of years anterior to the decree, books become lost and witnesses die or forget. The plaintiffs, therefore, gained no advantage, in taking steps to get the account stated and the books filed, which the defendant did not share equally with it, because it was as much an advantage to the defendant to get a fair accounting as it was to the plaintiffs.

It seems unnecessary to point out that the entry of the decree in this case was necessary in order to perfect plaintiffs' right to a bill of review. It is, of course, basic to the right to file a bill of review against a decree that the decree against which the bill is to be filed must be entered.

The Court of Appeals of the Third Circuit erroneously held that the decree, against which the bill of review was filed, is a final decree.

The Court of Appeals of the Third Circuit refers to the decree entered on its mandate in *Baldwin v. Grier* and against which the bill of review is filed, as a final decree, and bases its reasoning largely on that statement. While that decree dismissed the bill as to infringement, the case was referred to a Master on the unfair competition branch of the case, and proceedings are still pending before the Master.

That decree was, therefore, necessarily interlocutory and a new decree must be entered after the Master's report. It seems clear that there cannot be two final decrees in a case. It follows, therefore, that the decree entered on the mandate of the Court of Appeals of the Third Circuit is not a final

decree and that the District Court had jurisdiction of the cause and the parties at the time the bill of review was filed. (See *Lodge v. Twill*, 135 U. S. 232, and authorities there cited.)

The Court of Appeals of the Third Circuit misinterprets the ground of the bill of review, and the authorities it cites do not apply.

The bill of review was applied for because there was an error of law apparent on the face of the former decision of the Court of Appeals of the Third Circuit. This error of law consisted in the misapplication of the reissue statute to the Baldwin Reissue patent, and this error was apparent on the face of the decision as soon as it was handed down. The District Court (*Orr, J.*) in its opinion on the bill of review states:

"The error of law was the alleged improper application of the provisions of the Revised Statutes, Section 4916, relating to the reissue of defective patents, to the reissued patent in suit" (Tr. p. 46).

There was no change in the reissue law in the period between the decision of the Court of Appeals of the Third Circuit and the decision of this Court; nor had there been any change in the interpretation of the reissue law by this Court during this period. The decision of this Court on the former *writ of certiorari* did not change the interpretation of the reissue law and thus convert the decision of the Court of Appeals into an erroneous decision. As before stated the decision of the Court of Appeals of the Third Circuit was wrong *ab initio*.

The Court of Appeals of the Third Circuit, how-

ever, after stating, in its opinion, the familiar propositions of law, that the two grounds for a bill of review are, an error of law apparent on the face of the record without further examination of matters of fact, and new facts which will materially affect the decree and probably produce a different result, goes on to say:

"Such being the law as to bills of review, this case resolves itself into the question whether the subsequent decision of the Supreme Court on this patent at 245 U. S. 198, constituted one or both of such grounds" (Tr. p. 103).

The Court of Appeals of the Third Circuit, therefore, appears to be of opinion that its decision was originally right and that the error therein was injected into it by the decision of this Court. Putting it another way, the Court of Appeals of the Third Circuit appears to be of opinion that there was no error in its decision until this Court handed down the opinion on the *writ of certiorari* (245 U. S. 198). In brief, what this Court held was that the Court of Appeals of the Second Circuit was right in its interpretation of the reissue law and the Court of Appeals of the Third Circuit was wrong in its interpretation of the law. The decision of this Court did not make the decision of the Court of Appeals of the Second Circuit right and the decision of the Court of Appeals of the Third Circuit wrong. The decision of this Court did, however, afford an authoritative ground on which the error in the decision of the Court of Appeals of the Third Circuit could be brought to its attention. Under these conditions, it seems clear that the authorities referred to by the Court of Appeals of the Third Circuit do not apply.

Referring to *Tilghman v. Werk*, decided by Judge

Jackson, afterwards Mr. Justice Jackson, 39 F. 680, the facts which led up to this decision were as follows:

The Tilghman patent was involved in three suits, one against Mitchell, one against Proctor and one against Werk. In the Mitchell suit this Court decided that the patent was not infringed (*Mitchell v. Tilghman*, 19 Wall. 287).

The suit of *Tilghman v. Proctor* next went to this Court and is reported 102 U. S. 707. On a somewhat different record this Court found the patent to be valid and infringed.

Thereafter *Tilghman v. Werk* came before Judge Jackson on a petition to vacate a decree of April 9, 1878, dismissing the Werk suit, this decree having been entered prior to the decision of this Court in *Tilghman v. Proctor*. In dismissing this petition, which was not a bill of review, Judge Jackson said:

"the question is presented whether a change of its ruling or decision by the Supreme Court on a question of law or fact, or upon a mixed question of law and fact, constitutes such new matter as will sustain a bill of review to vacate decrees of the circuit court pronounced before such change was made. We think, upon principle and authority, this proposition cannot be maintained."

The decision in *Tilghman v. Werk* cannot apply here, because in the case at bar there has been no change of ruling or decision by the Supreme Court on any question of law or fact or upon a mixed question of law and fact. As before pointed out, the interpretation of the reissue law was not changed by the decision of this Court on the former writ of *certiorari*.

In this connection, we call attention to the fact that the ruling of this Court in allowing a bill of review in the case of *Henry v. Dick*, 224 U. S. 651, is directly contrary to this *dicta* in the decision in *Tilghman v. Werk*. This Court, by its decision in *Motion Picture Patent Co. v. Universal Film Co.*, 243 U. S. 224, directly overruled *Henry v. Dick*, and in so doing, changed the construction of the patent law so far as it applies to the question of contributory infringement. The bill of review which was later allowed in *Henry v. Dick*, *supra*, was allowed because this Court had changed its ruling on a question of law.

We further call attention to the comment of the Court of Appeals of the 8th Circuit on the decision of *Tilghman v. Werk*, in the Omaha case, *supra*.

"If there was no change in the situation of the parties after the entering of the decree in the first case cited, so as to make a revision of the decree inequitable, we should have thought a bill of review would have properly lain in that case after the decision of the Supreme Court of the United States in *Tilghman v. Proctor*, 102 U. S. 707; 26 L. Ed. 279."

Judge Hand in *re Brown*, 213 F., 701, commented on this case as follows:

"In *Tilghman v. Werk* (C. C.) 39 Fed. 680, Judge Jackson declined to regard a change in the decision of the Supreme Court as the ground for a bill on newly discovered evidence; whether he might have held it good as error apparent of the record does not appear."

In *Hoffman v. Knox*, 50 Fed. 484, the Circuit Court entered a final decree pursuant to a statute of the State of Virginia, which statute was subsequently held unconstitutional by the highest court

of Virginia. Thereafter, a petition for rehearing was filed which it was held came too late, but which the Circuit Court held could be treated as a bill of review for error apparent. On appeal to the Court of Appeals of the Fourth Circuit, Justice Fuller, afterwards Chief Justice, held:

"The fact that nearly eighteen months after the decree of October 14, 1887, the Court of Appeals of Virginia decided these laws to be unconstitutional for the reasons stated was not enough in itself to create error of law apparent and justify a bill of review on that ground or that of new matter *in pais*. * * * but this rule cannot be applied where the construction contended for has not been announced at the time of the final adjudication by the United States Court so as to make the law erroneous on its face by relation."

In other words, this decision holds that the law of Virginia upon which the first decision was based not having been held unconstitutional at the time the decision was rendered there was no error on the face of the decision, and the subsequent declaration, by the highest court of Virginia, that the law was unconstitutional did not inject error into the decision.

The distinction between this case and the decision of the Court of Appeals of the Third Circuit in *Baldwin v. Grier* is clear. In *Hoffman v. Knox* it was sought to impose an error on the face of the decision by reason of the subsequent declaration of the highest court of Virginia that the law on which the decision was based was unconstitutional, *i. e.*, it was sought to impose an error on the face of the decision because there had been a change in the law. In *Baldwin v. Grier*, the error was not im-

posed on the face of the decision by any subsequent change of law.

We also call attention to the statement of Judge Hand respecting this decision in *re Brown, supra*:

"Thus in *Hoffman v. Knox*, 50 Fed. 484, the Circuit Court made its own ruling upon the constitutionality under the state Constitution of a state statute. Later the state court held differently in another case, a decision which is usually as absolutely conclusive as a ruling of the Supreme Court itself. The Court of Appeals for the Sixth Circuit, Chief Justice Fuller presiding, held that such a ruling did not constitute error apparent on the record. It must be conceded, however, that it is not certain that the ground of decision was not in part due to the unwillingness of the court, as matter of substantive law, to make the state decision apply as *ex post facto*."

Scotten v. Littlefield, 235 U. S. 410, was a bankruptcy case and one of a number which grew out of the bankruptcy of A. O. Brown & Co. of New York. *Scotten* and *Scotten & Snyder* had certain claims which with a number of others were passed on by the Court of Appeals of the Second Circuit in *In re Brown*, 193 F. 24. These claims were subsequently determined adversely to the claimants by this Court in *First National Bank of Princeton v. Littlefield*, 226 U. S. 110. In the meantime another creditor, one Gorman, had instituted a separate proceeding against *Littlefield* (the Trustee in Bankruptcy) to reclaim certain shares of copper stock, and the Court of Appeals of the Second Circuit held that this stock was not sufficiently identified (184 F. 454). From this decision, appeal was taken to this Court, which reversed on the ground that there was sufficient proof of identity. (*Gorman v. Littlefield*, 229 U. S.

19.) Scotten, and Scotten and Snydercker, then petitioned for leave to file a bill of review. This was refused, the Court of Appeals of the Second Circuit (213 F. 705) saying:

"It is the theory of these claimants that if the rule enunciated in *Gorman v. Littlefield* had been applied to the facts in their cases it would have been held that as to their steel stock identity had been proved. *They therefore bring this bill of review which in substance and effect prays for a retrial of their respective claims. They contend that they did not present any argument to the District Court or to the Court of Appeals or to the Supreme Court as to this part of their claim and that in their record on appeal they left out some of the testimony that referred to the steel stock; also that the appellate courts did not deal with that question.*

It appears then that these claimants originally advanced the claim which is the subject of their bill of review; that they either took all the testimony they could muster in its support, or had full opportunity to do so before the referee. That they elected not to argue before the District Court the proposition that they had traced their steel stock into the block of 1,000 shares which was pledged to the Hanover Bank. That, although many months before their appeal was argued in this court the *Gorman* case had been disposed of here and an appeal from our decision therein taken (by their own counsel, who also appeared for *Gorman*), they elected not to present and argue the question (or at least present and reserve it) that our decision in the *Gorman* Case was unsound. That before the Supreme Court they elected not to call attention to this same question, although for some reason the appeal in the *Princeton Bank* and these two cases came on for argument there before the earlier appeal in the *Gorman* Case.

Their theory seems to be that they may bottle up part of their claim, which was, as originally presented, a single one, during review by three successive courts and then years afterwards bring it forth de novo to be presented for decision." (Italics ours.)

From this decision of the Court of Appeals of the Second Circuit, it is clear that the alleged bill of review said to be filed in the Scotten case was not a bill of review for error apparent on the face of the proceedings without further examination of questions of fact. On the contrary, as the Court points out, this bill of review sought a retrial of the case, including the taking of additional testimony and the presentation of an additional question to the appellate courts. It was not contended that as this case was presented to the Court of Appeals there was error, but that if the claimants had opportunity to retry their case, in view of the decision of this Court, announced in *Gorman v. Littlefield*, it could be retried in such a way as to establish the claims. On appeal, this Court said:

"Both courts below put their decisions on the ground that the appeal to the circuit court of appeals from the original order of the district court in the reclamation proceedings really involved the claim for the United States Steel stock in its present aspect, and that if not presented to the court of appeals when there on appeal it could not be held back and made the subject of a bill of review, as is now attempted to be done. We think this decision was clearly right. Furthermore, the ground alleged for the bill of review now is that the principles which determined the disposition of the *Gorman Case*, 229 U. S. 19 (decided May 26, 1913, a little more than two years after the decree in the district court), reversing (411) the circuit court of appeals in the same case

(99 C. C. A. 315, 175 Fed. 769), would, had they been applied in this case, have required a different result in the district court in dealing with the original petition in reclamation, so far as the three hundred shares of the United States Steel stock, pledged with the Hanover National Bank, are concerned.

Bills of review are on two grounds: first, error of law apparent on the face of the record without further examination of matters of fact; second, new facts discovered since the decree, which should materially affect the decree and probably induce a different result. 2 Bates, Fed. Eq. Proc. 762; 2 Street, Fed. Eq. Pr., Sec. 2151.

If the decision in the Gorman Case would have required a different result if the principles upon which it was decided had been applied in the original proceeding, which we do not find it necessary to decide, such subsequent decision will not lay the foundation for a bill of review for errors of law apparent, or for new matter *in pais* discovered since the decree, and probably requiring a different result. *Tilghman v. Werk*, 39 Fed. 680 (opinion by Judge Jackson, afterwards Mr. Justice Jackson of this court); *Hoffman v. Knox*, circuit court of appeals, fourth circuit, 1 C. C. A. 535, 8 U. S. App. 19, 50 Fed. 484, 491 (opinion by Chief Justice Fuller)."

The District Court for the Western District of Pennsylvania (Orr, J.) refers to this decision as follows:

"The defendant has cited *Scotten v. Littlefield*, 235 U. S. 407, as a complete precedent which should govern the present case and require a dismissal of the bill of review. Had the Court in that case not dismissed the bill of review, there would have necessarily been a further examination of matters of fact and the consideration of a question which was held

back in other proceedings and subsequently made the subject of a bill of review. It is insisted by counsel for the defendant that in the case just cited, the Supreme Court squarely holds that a subsequent decision by it will not lay the ground for a bill of review. To this proposition the Court cannot agree" (Tr. p. 46).

It is believed that this summary of this case by the District Court for the Western District of Pennsylvania is correct.

The differences between *Scotten v. Littlefield* and the case at bar are sufficiently marked. In the case at bar no question "was held back in other proceedings and subsequently made the subject of a bill of review". The bill of review is sought not for the purpose of retrial, but because of an error apparent on the face of the record, that is, in the decision of the Court of Appeals of the Third Circuit.

Certainly, in view of the entire dissimilarity of the facts involved, *Scotten v. Littlefield* can have no bearing on the case at bar, and this is made the more apparent by the fact that the cases cited therein, namely, *Tilghman v. Werk*, 39 F. 680, and *Hoffman v. Knox*, 50 F. 484, have no application to the case at bar.

The Decree Works Irreparable Injury to the Plaintiffs.

The reissue here involved has been found to be valid by the highest authority, *i. e.*, by this Court in its decision, 245 U. S. 198. That this defendant is an infringer there is no doubt. Infringement was found by the District Court of the Western District of Pennsylvania and that finding was not

disturbed by the Court of Appeals of the Third Circuit. The lamp complained of in the Second Circuit is identical with the lamp put out by this defendant except for a difference in shape which, of course, is immaterial. Therefore, the exact structure complained of in this case was determined by this Court to be an infringement of this patent. The patent is valid as against every one in the United States except this defendant, and the effect of the decree now standing is to practically constitute this defendant a part owner of the patent. Having built up a business on a flagrant infringement—for its lamps was held to be an exact and unfair copy of plaintiff's commercial lamp—it can manufacture in the Third Circuit, and, under *Kessler v. Eldred*, 206 U. S. 285, can sell infringing lamps anywhere in the United States in direct competition with plaintiff's licensees and on better terms because it pays no license fee. Defendant is, therefore, by an erroneous application of the law, placed in a better position in respect to this patent than any one in the country. Surely, it needs no argument to show that this condition of affairs violates all principles of justice and equity.

As this Court pointed out in its decision on the former *writ of certiorari*:

"The plaintiffs (we shall so designate respondents) struggled through some years and some litigation to the success of the decrees in the pending case. In a suit brought in the District Court for the Southern District of Illinois a device like that of the defendants herein was held to be an infringement of certain claims of the original patent. The holding was reversed by the Circuit Court of Appeals for the Seventh Circuit. *Bleser vs. Baldwin*, 199 Fed. 133.

Subsequently, the reissue having been granted, suit was brought in the Western District of Pennsylvania against an asserted infringer. Unfair competition was also alleged, and, holding the latter to exist, the court granted a preliminary injunction (210 Fed. 560). Upon final hearing that holding was repeated, and infringement of a claim of the re-issue patent decreed. 215 Fed. 735. The decree was reversed by the Circuit Court of Appeals (Third Circuit) on the ground that the claim of the re-issue patent found to have been infringed was broader than a corresponding claim of the original letters patent and therefore void. The holding of the District Court as to unfair competition was sustained. 219 Fed. 735. Aided by the reasoning in the opinions of those cases and the discussion of counsel, we pass to the consideration of the proposition in controversy" (Tr. pp. 21, 22).

The record before this Court on the *writ of certiorari* to the Second Circuit showed that the plaintiffs were the first to develop a portable miner's acetylene lamp and that through their efforts a market had been established for this lamp in the face of unusual difficulties and in spite of the prejudice against the adoption of this new illuminant. If, however, the decision of the Court of Appeals of the Third Circuit stands, all these efforts and all this previous litigation may go for naught. The defendant in this case, Grier Bros. Co., as above stated, occupying as it does a better position with respect to the trade because it has no investment in the patent and no license fees to pay, can manufacture in the Third Circuit and can make better terms as to price and drive plaintiff and its licensees from the market.

As stated by the District Court for the Western District of Pennsylvania (Orr, J.):

"In the first place, the law, as interpreted by the Supreme Court of the United States, is the law which should govern all subordinate Federal Courts. In the second place, if the later decision of the Supreme Court of the United States cannot be invoked for the relief of the plaintiffs, they are in a situation not contemplated by the States when they gave authority to Congress to secure to inventors the exclusive right to their discoveries and inventions for a limited period, or by the Congress of the United States when it legislated in pursuance of such authority. By the decision of the Supreme Court of the United States, the validity of the reissue patent may secure to the plaintiffs rights thereunder in all parts of the United States, except within the limitations of the Third Judicial Circuit. Plaintiffs' rights to the invention would not be exclusive for any period within that Circuit in which is embraced the great anthracite and bituminous coal fields of the State of Pennsylvania" (Tr. p. 45).

A Bill of Review is the Proper Remedy in this Cause.

The Court of Appeals of the Third Circuit bases its refusal to follow the decision of this Court purely on the procedure adopted. Its opinion recognizes the inequities created by its decision and indicates that its action would have been different had the procedure been such as to prevent the entry of the decree against which the bill of review is filed.

The purpose of a bill of review is, of course, to set aside a decree which has been entered and which is erroneous, either for error apparent or new mat-

ter *in pais*. That the decision of the Court of Appeals of the Third Circuit in *Baldwin v. Grier* contained error of law apparent in holding that the reissue was a broadened reissue is, we think, not open to question. This Court pronounced the reissue valid, and prior to this pronouncement by this Court three other courts had held the same way. Nor does there appear to be any reason why a bill of review should not lie. Certainly, the fact that a decree had been *entered* on the mandate of the Court of Appeals of the Third Circuit cannot be a reason.

The Court of Appeals of the Third Circuit, however, suggests that plaintiff might have applied to it to withhold its mandate after the decision by the District Court in the Southern District of New York. We may, it is believed, pass without consideration the suggestion that the Court of Appeals of the Third Circuit would have withheld its mandate because a District judge in another circuit had declined to follow its decision.

The Court of Appeals of the Third Circuit also suggests that application might have been made to it to prevent the entry of a decree on its mandate after the conflicting decision of the Court of Appeals of the Second Circuit. How the situation would have been changed had the plaintiff thus applied to the Court of Appeals of the Third Circuit does not appear, for that Court, at that time, had no power over its mandate. The mandate went down on the 24th of February, 1915. The term ended in March of that year a second term had elapsed, and a third term had begun before the decision of the Court of Appeals of the Second Circuit came down.

It is well settled law that a court has no power

to revoke its mandate and direct the entry of a different decree below after the term has expired during which the mandate has gone down. *Sibbald v. U. S.*, 12 Peters, 488; *Reynolds v. Manhattan Trust Co.*, 109 F. 97; *Waskey v. Hammer et al.*, 179 F. 273.

The Court of Appeals of the Third Circuit also suggests that the plaintiff might have applied for a *certiorari* in *Baldwin v. Grier*. The Court, however, says:

“We do not say that the plaintiffs were bound to do so; we only say they could have so petitioned.”

There was no ground for applying for *certiorari* in this case until after the decision of the Court of Appeals of the Second Circuit in *Baldwin v. Abercrombie & Fitch*, and the defendant began proceedings for the writ very shortly after this decision. Now, the sole ground on which the writ was applied for and granted was the conflicting decisions of the Courts of Appeals of the Second and Third Circuits (see Petition, Tr. p. 75 *et al.*). The lamp structures involved are identical in their relation to the patent. There was no question of infringement in either case. The sole question presented in both cases was the validity of the reissue. In other words, the sole question involved was a question of law, the facts being identical in both cases. There was, therefore, nothing in the record in this case which would have in any way enlightened this court, or which would have tended to change the decision rendered in *Baldwin v. Abercrombie & Fitch*. That case was, in fact, a test case, and there was not only no reason for not taking up to this court the same state of facts and the same question of law in two cases, but such course was unneces-

sary and improper. Further, the taking up of the case of *Baldwin v. Grier* to this Court would have imposed unnecessary labor on this Court and would have involved unnecessary expense, because the record in *Baldwin v. Grier* contained not only the same facts as to the patent question which was before this Court in *Baldwin v. Abercrombie & Fitch*, but it also contained a large amount of testimony relating to unfair competition with which this Court would have had nothing to do.

Again, the defendant has suffered no injury and the plaintiff has gained no advantage by the course which has been pursued.

The writ of *certiorari* could not have been applied for in this case until the decree on the mandate of the Court of Appeals of the Third Circuit had been entered. This Court would certainly not have granted a writ with the case hanging in the air. Had a writ been asked, this Court might have very well declined to grant it on the ground that the sole question involved was already before it in *Baldwin v. Abercrombie & Fitch*, but had it granted a writ, the only way in which the condition of the case would have been changed is that it would have been mandatory upon the Court of Appeals of the Third Circuit to do that which it now has the power to do, as we see the matter, under the bill of review. Under these circumstances, it seems that the proper course and practice was to do that which has been done, namely, to await the decision of this Court in *Baldwin v. Abercrombie & Fitch* and then apply for a bill of review in the Third Circuit.

Further, there are no facts in this case which make this bill of review inequitable. While the decision of the Court of Appeals of the Third Circuit was rendered January 22, 1915, the order on

the mandate was not entered in the court below until a year later, that is, January 5, 1916. If defendant sold any lamps during that year it acted in direct defiance of the injunction issued by the court below, as that injunction was in effect until the decree on the mandate of the Court of Appeals was entered. During this year, however, the litigation in the Second Circuit was completed and the *certiorari* asked for. Judge Mayer rendered his opinion February 10, 1915, the Court of Appeals its affirming opinion November 23, 1915, and the application for *certiorari* was granted January 10, 1916, that is, only five days after the court below had entered its decree on the mandate of this Court.

Now, the defendant must have been fully apprised of these proceedings. The president of the defendant, Justrite Mfg. Co., in the New York suit, Fred. J. Becker, and its superintendent, Hansen, both testified for the defendant here, and Becker introduced as exhibits two of the Justrite lamps which were complained of in the New York suit. With this close connection between the defendants in these suits, and the inevitable knowledge in the trade of what was going on, it is impossible that this defendant was not fully informed as to the proceedings in the New York case, including the grant of the *certiorari*.

Conclusion.

In conclusion, your petitioner respectfully submits that this petition for a *writ of certiorari* should be granted and the record in this case sent up for final review and determination by this Court.

JOHN SIMMONS COMPANY,

By JAMES Q. RICE,

Their Attorney.

INDEX.

	PAGE
General Statement	1
History of Litigation	3
Decision of C. C. A., 3rd Cir., that bill of review will not lie contrary to decision of this Court in <i>National Brake & Elec. Co. v. Christensen</i> , U. S. Sup. Ct. Adv. Op. 1920-21, p. 188.....	8
Decision of C. C. A., 3rd Cir., contrary to practice authorized by this Court in <i>Henry v. Dick</i> , 244 U. S. 651.....	10
Decision of C. C. A., 3rd Cir., in conflict with decision of C. C. A., 8th Cir., in <i>Omaha Elec. Light Co. v. City of Omaha</i> , 216 F. 848.....	11
C. C. A., 3rd Cir., erroneously held decree in <i>Baldwin v. Grier</i> , against which bill of review is filed, a consent decree....	15
C. C. A., 3rd Cir., bases refusal to follow decision of this Court on procedure; recognizes inequities created by its de- cision and indicates its action would have been different had the decree against which bill of review is filed not been entered	17
C. C. A., 3rd Cir., misinterprets ground of bill of review, and the authorities it cites do not apply.....	20
Decree works irreparable injury to plain- tiff	30

II

	PAGE
Mere fact decision has been rendered by a C. C. A. in a patent case does not ex- cept decision from operation of a bill of review	33
No change has occurred in status of parties since the entry of decree and there are no facts which make this bill of review inequitable	35
Under bill of review accounting should be allowed for entire period of infringe- ment	37
Conclusion	42

CASES REFERRED TO

Baldwin & Simmons Co. <i>v.</i> Grier, 215 F. 735	5
Baldwin & Simmons Co. <i>v.</i> Grier, 219 F. 735	3, 6
Baldwin & Simmons Co. <i>v.</i> Abercrombie & Fitch, 227 F. 455	6, 36
Baldwin & Simmons Co. <i>v.</i> Abercrombie & Fitch, 228 F. 895	4, 6
Baldwin & Simmons Co. <i>v.</i> Abercrombie & Fitch, 245 U. S. 198	2, 4, 7, 11, 21
Bush <i>v.</i> U. S., 13 F. 625	38, 39
<i>In re</i> Brown, 193 F. 24	25
<i>In re</i> Brown, 213 F. 701	23, 24, 25
First National Bank <i>v.</i> Littlefield, 226 U. S. 110	25
Foster Fed. Prac., par. 354, p. 1123.....	38
Gorman <i>v.</i> Littlefield, 184 F. 454.....	25
Gorman <i>v.</i> Littlefield, 229 U. S. 19	25, 27
Griggs <i>v.</i> Gear, 3 Gilman, Sup. Ct. Ill.	38, 39

III

	PAGE
Henry <i>v.</i> Dick, 224 U. S. 1	10, 11, 23
Henry <i>v.</i> Dick, 244 U. S. 651	10, 11, 22, 23
Hoffman <i>v.</i> Knox, 45 F. 484	23, 24, 29
Kessler <i>v.</i> Eldred, 206 U. S. 285	31
Mitchell <i>v.</i> Tilghman, 19 Wall. 287	22
Mitford & Tyler's Eq. Pleadings, Ed. 1878, p. 186	38
Motion Picture Patents Co. <i>v.</i> Universal Film Co., 243 U. S. 502	11, 23
National Brake & Electric Co. <i>v.</i> Christensen, U. S. Sup. Ct. Adv. Op. 1920-21, p. 188.8, 17, 20	
Omaha Elec. Light Co. <i>v.</i> City of Omaha, 216 F. 848	11, 12, 13, 23
Old Colony Trust Co. <i>v.</i> City of Omaha, 230 U. S. 100	13
Reynolds <i>v.</i> Manhattan Trust Co., 109 F. 97	18
Rubber Tire cases, 220 U. S. 428	29
Scotten <i>v.</i> Littlefield, 235 U. S. 407	25, 27, 29
Section 122a Compiled Stat. Sept. 6, 1916..	35
Sibbald <i>v.</i> U. S., 12 Peters, 488	18
Story's Eq. Pleadings, 10th Ed., Par. 403, p. 455	38
Sturrock <i>v.</i> Littlejohns, 68 L. J. 165, Q. B. ..	40, 41
Tilghman <i>v.</i> Proctor, 102 U. S. 707	22
Tilghman <i>v.</i> Werk, 39 F. 680	21, 22, 29
Waskey <i>v.</i> Hammer, 179 F. 273	18
Wharton's Legal Maxims, Maxim 58, p. 132	34



Supreme Court of the United States,

OCTOBER TERM, 1920.

No. 342.

JOHN SIMMONS COMPANY,
Petitioner,

vs.

THE GRIER BROTHERS COMPANY,
Respondent.

BRIEF FOR PETITIONER.

This case arises out of a patent litigation. The patent involved is the Baldwin reissue patent No. 13,542, granted March 11, 1913, for a Miner's Lamp and is owned by the petitioner, John Simmons Company, a corporation of New York, having a place of business in New York City. The respondent is Grier Bros. Co., a Pennsylvania corporation, having a place of business in Pittsburgh.

This Baldwin patent was before this court on a *writ of certiorari*, the case being entitled Abercrombie & Fitch Co. and Justrite Mfg. Co., Petitioners, vs. Frederick E. Baldwin & John Simmons Co., No. 67, Oct. Term, 1917. This former *writ of certiorari* was granted because of conflicting de-

cisions as to the validity of the re-issue by the Courts of Appeals of the Third and Second Circuits. The Court of Appeals for the Third Circuit, reversing the District Court for the Western District of Pennsylvania, held this reissue patent invalid. Subsequently, the Court of Appeals of the Second Circuit, affirming the District Court for the Southern District of New York, held the reissue valid and infringed by the same lamp structure that was before the courts of the Third Circuit. Thereupon, this Court granted a *writ of certiorari* January 10, 1916, and on December 10, 1917, handed down a decision (opinion by Mr. Justice McKenna) affirming the Court of Appeals of the Second Circuit and finding the patent valid and infringed (245 U. S. 198).

The case at bar comes before this Court on a *writ of certiorari* directed to the Court of Appeals of the Third Circuit. After this Court had handed down its decision on the case as brought before it by the first *writ of certiorari*, the District Court for the Western District of Pennsylvania, permission having first been obtained from the Court of Appeals of the Third Circuit, allowed a bill of review to be filed against the decree entered on the mandate of the Circuit Court of Appeals of the Third Circuit after said Court had found the reissue patent invalid, said bill of review bringing before the court the facts in the New York case and the decision of this Court.

After taking testimony under said bill of review and final hearing thereon, the District Court for the Western District of Pennsylvania, handed down a decision vacating the former decree and directing the entry of a decree in accordance with the decision of this Court on said first *writ of certiorari*.

The defendant-respondent appealed to the Court

of Appeals of the Third Circuit. That Court reversed the District Court and denied the right of the plaintiff-petitioner to file a bill of review. The Court of Appeals while admitting the hardship caused by its former decision, which was, as we have pointed out, squarely *contra* to the decision of this Court, held that the plaintiff had cut itself off from any relief in the premises because the plaintiff's solicitors had prepared and presented for approval of the court the form of decree which was entered in the District Court for the Western District of Pennsylvania on the mandate of the Court of Appeals. The Court of Appeals held that the presentation by plaintiff's solicitors of the decree thus entered made the decree, as to plaintiff, a consent decree, and that therefore a bill of review would not lie. The Court of Appeals further indicated that the practice which the plaintiff had adopted for bringing to its attention the decision of this Court on the former *writ of certiorari* was not the proper practice (265 F. 481).

Thereupon this Court was petitioned for a *writ of certiorari*. This Court granted this petition on June 11, 1920, directed the writ to issue, and the case is now before this Court for hearing thereon.

The various antecedent proceedings in the entire litigation are more specifically set out in the following history:

History of the Litigation.

The Court of Appeals of the Third Circuit in the case of Baldwin & Simmons Co. *v.* Grier, at final hearing, reversing the District Court for the Western District of Pennsylvania, held the Baldwin reissue patent 13,542 for a Miner's Lamp invalid on the ground that the reissue had been broadened (219 F. 735; Tr. pp. 3 to 9).

Thereafter, the Court of Appeals of the Second Circuit in *Baldwin & Simmons Co. v. Abercrombie & Fitch Co. and Justrite Manufacturing Co.*, affirming the District Court for the Southern District of New York, held this same Baldwin reissue patent 13,542 valid and infringed by the same lamp structure which was before the Court of Appeals for the Third Circuit (228 F. 895).

A writ of *certiorari* having been granted, this Court affirmed the Court of Appeals of the Second Circuit, and in its opinion (Tr. pp. 19-25) stated that it had given attention to

"especially the decision and reasoning of the Circuit Court of Appeals of the Third Circuit in *Baldwin et al. v. Grier Bros. Co.*, 219 Fed. 735, but we are constrained to a different conclusion" (Tr. p. 24).

Immediately the mandate of this Court came down application was made for leave to file a bill of review in the District Court for the Western District of Pennsylvania against the decree which had been entered on the mandate of the Court of Appeals of the Third Circuit. The application was denied on the ground that the District Court had no jurisdiction to act, but without prejudice to the renewal of the application to the Court of Appeals. Such application was accordingly made, whereupon the Court of Appeals of the Third Circuit made the following order:

"It is hereby ordered that the said plaintiffs-appellees have leave to make an application to said District Court to file a bill of review, and that said District Court be, and the same is, hereby authorized and empowered to take such action upon said petition as to it seems proper" (Tr. p. 13).

The District Court thereupon filed the bill of review and, upon final hearing, sustained the bill, vacated the decree which had been entered on the mandate of the Court of Appeals (Tr. pp. 38-43), and entered a new decree, in accordance with the decision of this Court, holding the patent valid and infringed. Defendant appealed to the Court of Appeals of the Third Circuit, which reversed the Court below, holding that the bill of review would not lie.

Petition for a *writ of certiorari* was then addressed to this Court, praying this Court to finally review this decision of the Court of Appeals of the Third Circuit and the proceedings relating to the bill of review.

This petition was granted and the case is now before this Court for hearing.

The full history of the various proceedings is as follows:

- Oct. 14, 1913. Bill filed in the Western District of Pennsylvania by Baldwin & Simmons Co. v. Grier Bros. Co. charging infringement of reissue patent to Baldwin 13,504, for Miners' Lamp, and also charging unfair competition in trade.
- July 7, 1914. Decision of District Court of the Western District of Pennsylvania (Orr, J.) holding reissue patent 13,542 valid and infringed and finding defendant guilty of unfair competition in trade (215 F. 735).
- Jan. 22, 1915. Decision of the Court of Appeals of the Third Circuit, affirming the lower court as to unfair competi-

tion in trade but holding the re-issue patent invalid because the re-issue was broadened (219 F. 735; Tr. p. 3).

- Feb. 24, 1915. Mandate of the Court of Appeals of the Third Circuit sent down (Tr. p. 10).
- Jan. 5, 1916. Decree on the Mandate of the Court of Appeals for the Third Circuit entered in the District Court on motion of plaintiffs' solicitors (Tr. p. 11).
- May 20, 1913. Bill filed in the Southern District of New York on the same reissue patent 13,542, and against the same lamp structure, against Abercrombie & Fitch Co. and Justrite Mfg. Co. (Tr. p. 51).
- Feb. 6, 1915. Decision of the District Court of Southern District of New York (Mayer, J.) declining to follow the Court of Appeals of the Third Circuit, holding the patent valid and infringed (227 F. 455).
- Nov. 9, 1915. Decision of the Court of Appeals of the Second Circuit affirming the court below (228 F. 895).
- Dec. 20, 1915. Petition for *writ of certiorari* to this Court on the ground of conflicting decisions, on the same state of facts, by the Courts of Appeals of the Third and Second Circuits (Tr. p. 67).
- Jan. 10, 1916. Petition for *writ of certiorari* granted by this Court.

- Dec. 10, 1917. Decision of this Court affirming the Court of Appeals of the Second Circuit (Tr. p. 19; 245 U. S. 198).
- Jan. 18, 1918. Mandate of this Court sent down and order entered thereon (Tr. pp. 25-27).
- Jan. 26, 1918. Application to the District Court for the Western District of Pennsylvania, for permission to file a bill of review against the decree standing in that court.
- Mar. 13, 1918. Order of the Court of Appeals of the Third Circuit referring the petition for leave to file bill of review to the District Court (Tr. p. 13).
- Apr. 11, 1918. Bill of review filed (Tr. p. 15).
- Jan. 10, 1919. Supplemental bill filed in the District Court of the Third Circuit because of change of title (Tr. p. 33).
- Oct. 7, 1919.) Opinions of the District Court sus-
Nov. 7, 1919.) taining the bill of review and vacat-
ing the decree standing therein
(Tr. pp. 38-43; F.).
- Apr. 14, 1920. Decision of the Court of Appeals of the Third Circuit, holding that the bill of review will not lie (Tr. pp. 85-91; 265 F. 481).
- May 15, 1920. Petition for *writ of certiorari* directed to the Court of Appeals of the Third Circuit from its decision on the Bill of Review.
- June 11, 1920. Petition for *writ of certiorari* granted by this Court (Tr. p. 93).

The decision of the Court of Appeals of the Third Circuit holding that a bill of review will not lie in this case is contrary to the decision of this Court in *National Brake and Electric Co. v. Christensen*, U. S. Sup. Ct. Adv. Op. 1920-21, Feb. 1, page 188.

In *National Brake & Electric Co. v. Christensen* the two patents in suit were adjudged valid and infringed by decisions of the Court of Appeals of the Seventh Circuit and the District Court for the Eastern District of Wisconsin, and an accounting was begun. On March 11, 1916, the plaintiffs in the Seventh Circuit litigation, Christensen and Allis-Chalmers, filed a bill against the Westinghouse Traction Brake Co. in the District Court for the Western District of Pennsylvania. The District Court and the Court of Appeals of the Third Circuit found one of the patents in suit invalid and dismissed the bill as to the other patent for want of prosecution.

Thereupon, the defendants in the Wisconsin case petitioned the Circuit Court of Appeals for the Seventh Circuit to take jurisdiction of the petition to inquire into and determine the status of the case and the force and effect of the final judgment of the District Court of the Western District of Pennsylvania, to hold the same to be a final adjudication, and to hold that the petitioner was entitled to a final decree in the suit in Wisconsin dismissing the same for want of equity. The Court of Appeals of the Seventh Circuit refused to consider this petition. Petition was then addressed to this Court for a *writ of certiorari* which was granted. In re-

versing the decree of the Circuit Court of Appeals for the Seventh Circuit, this Court said:

"In such case the Brake & Electric Company, if it wished to avail itself of the Pennsylvania decree, had the right to apply by petition in the appellate court of the seventh circuit for leave to file a bill in the court of original jurisdiction, in the nature of a bill of review, setting up the new matter as a bar to further proceedings. Such applications are addressed to the sound discretion of the appellate tribunal, and should be decided upon considerations addressed to the materiality of the new matter and diligence in its presentation. *Goodyear Rubber Co. v. Goodyear*, 9 Wall. 805, 19 L. ed. 828; *Re Gamewell Fire-Alarm Telg. Co.*, 20 C. C. A. 111, 33 U. S. App. 452, 73 Fed. 908; *Keith v. Alger*, 59 C. C. A. 552, 124 Fed. 32; *Society of Shakers v. Alger*, 23 C. C. A. 263, 47 U. S. App. 170, 77 Fed. 512."

And further:

"That leave to file a supplemental petition in the nature of a bill of review may be made after the judgment of the appellate court, and after the going down of the mandate at the close of the term at which judgment was rendered, was held in *Re Gamewell Fire-Alarm Teleg. Co.*, 20 C. C. A. 111, 33 U. S. App. 452, 73 Fed. 908, in a carefully considered opinion rendered by the circuit court of appeals for the first circuit, reciting the previous consideration of the question in cases in this court. We think these cases settle the proper practice in applications of this nature."

The facts in this case are essentially the same as those of the case at bar and this decision by this Court disposes of the basic proposition of the Court of Appeals of the Third Circuit that the proper practice was not followed in the case at bar and

that a bill of review will not lie. The fact that the plaintiff has filed a bill of review in the case at bar, whereas the defendant was given the right to file one in the Seventh Circuit litigation certainly cannot amount to a distinction.

Respondent argued before the Court of Appeals of the Third Circuit that the ruling of this Court in *Henry v. Dick*, 244 U. S., p. 651, which will be later referred to, did not apply, the substance of the argument being that where there is error in a patent case, if the error works injustice to the defendant, the error may be corrected, but if the error works injustice to the plaintiff, no remedy exists. It cannot be true that the defendant in a patent case has a remedy from a mistaken view of the law, while the plaintiff is remediless. There cannot be one kind of law for a defendant and another for a plaintiff.

If a bill of review will lie to relieve a defendant from miscarriage of justice in a patent case, and this Court has held that it will, there is certainly no reason why a bill of review will not lie to relieve a plaintiff from a miscarriage of justice.

The decision of the Court of Appeals of the Third Circuit is contrary to the practice authorized by this Court in *Henry v. Dick Co.*, 244 U. S. 651.

The case of *Henry v. Dick*, 224 U. S. p. 1, was certified to this Court from the Second Circuit, the question involved being that of contributory infringement. After the decision of this Court a final decree was entered in the Southern District of New York, this decree, holding the patent valid and infringed and ordering an injunction.

After the decision of this Court in *Motion Picture Patents Co. v. Universal Film Co.*, 243 U. S. 502, overruling *Henry v. Dick* (224 U. S. 1), defendant applied to this Court for permission to file a bill of review in the District Court for the Southern District of New York, against the decree which had been entered in *Henry v. Dick*. Although a final decree had then been entered for more than four years after the term in which that case had been disposed of by this Court, this Court granted permission to file a bill of review (244 U. S. 651). The bill of review was accordingly filed, the decree was revised and the injunction vacated.

Although the action of this Court in granting the bill of review in *Henry v. Dick* was referred to by the District Court in its opinion (Tr. p. 42) and was strongly urged upon the Court of Appeals of the Third Circuit, it does not refer to it in its opinion.

The decision of the Court of Appeals of the Third Circuit is in conflict with the decision of the Court of Appeals of the Eighth Circuit in *Omaha Electric Light Co. v. City of Omaha*, 216 F. 848.

The decision of the Court of Appeals of the Third Circuit, when the case was originally before it, was based solely on the ground that the patent in suit was invalid because it had been broadened by re-issue. This Court on the *writ of certiorari* in the Second Circuit case specifically held the contrary. After quoting the matter which the Court of Appeals of the Third Circuit held broadened the re-issue, this Court said:

"We are unable to assign to this the extent of alteration that counsel do, nor do we think

it necessary to rehearse the details of their argument. We have given it attention and the cases it cites, especially the decision and reasoning of the Circuit Court of Appeals of the Third Circuit in *Baldwin et al. v. Grier Bros. Co.*, 219 Fed. 735, but we are constrained to a different conclusion. Indeed, we are of opinion that the original patent did not need the exposition of the reissue. It exhibited an invention of merit, certainly one entitled to invoke the doctrine of equivalents. *Paper Bag Patent Case*, 210 U. S. 405" (Tr. p. 24).

There was, therefore, error of law apparent on the face of the decision of the Court of Appeals of the Third Circuit, this error being apparent without further examination of the facts. This error was an incorrect interpretation of Revised Statutes, Sec. 4916, relating to the reissue of defective patents, and the misapplication of the provisions of this section to the patent in suit, this section being subsequently correctly interpreted and applied to the patent in suit by the District Court and the Court of Appeals of the Second Circuit, these decisions being subsequently affirmed by this Court. **This error was not made apparent nor was it caused to exist by reason of the decision of this Court.** It existed in the decision of the Court of Appeals *ab initio*, but after this Court had spoken the existence of this error of law was not open to denial.

In *Omaha Electric Light Co. v. City of Omaha*, 216 F. 848, an Electric Light Company brought suit to enjoin the City of Omaha from interfering with its transmitting wires. The Court of Appeals for the Eighth Circuit held that plaintiff's franchise had expired and an appeal to this Court was dismissed on the ground that a federal question was

not raised. Thereafter, Old Colony Trust Co., trustee of a mortgage on the Electric Light Company's property, brought suit against the City for the same purpose. The Court of Appeals again held that the franchise had expired. On appeal this Court reversed holding (230 U. S. 100) that the franchise had not expired. A bill of review was thereupon filed in the first suit, *i. e.*, the suit in which the Electric Light Co. was the plaintiff. The Court of Appeals of the Eighth Circuit entertained this bill of review and vacated its decree in the first suit, saying (216 F., p. 851) :

"If we have the power to revise our decree and issue a mandate in harmony with that of the Supreme Court, it is plainly our duty to do so. This we should do not only to protect the rights of the plaintiff as a litigant, but as a matter of public policy to preserve the orderly administration of justice and avoid an unseemly conflict of judicial mandates."

Again, pages 855, 856, the Court of Appeals said, referring to the decision of this Court in the other case :

"While no mandate can run from its decision to our decree, a mandate of judicial authority does run from it, which we ought not to disregard. * * * Certainly our duty is plain. We ought to harmonize our decree and mandate with those of the Supreme Court.

"* * * It is entirely plain that if the decision of the Supreme Court had been rendered before our decree, our decree would have been different. Applying the analogies of Lord Bacon's first ordinance in regard to bills of review, that decision constitutes new matter which hath arisen since the decree. In fact, it is precisely the kind of new matter which the

Chancellor had in mind in framing the second clause of his ordinance. This is plain from his sixth ordinance, which reads as follows:

'No decree shall be made upon pretense of equity against the express provision of an act of Parliament. Nevertheless, if the construction of such act of Parliament hath for a time gone one way in general opinion and reputation, and after, by a later judgment, hath been controlled, then relief may be given upon matter of equity for cases arising before the said judgment, because the subject was in no default.' " * * *

In the case at bar and in the Omaha case there was, therefore, error of law on the face of the record which was apparent without further examination of questions of fact.

In the case at bar this error consisted in an erroneous application of the reissue statute. In the Omaha case it consisted in an erroneous application of the law relating to the expiration of the Electric Company's franchise. In each of these cases, there could be no doubt as to the existence of error after this Court had spoken. In each case a bill of review was filed. The Court of Appeals of the Eighth Circuit entertained the bill of review and reversed its former decision. The Court of Appeals of the Third Circuit has held that under the same circumstances a bill of review will not lie.

The Omaha case was urged upon the Court of Appeals of the Third Circuit but it is not referred to in the opinion.

The Court of Appeals of the Third Circuit erroneously held that the decree in *Baldwin v. Grier* against which the bill of review is filed, is a consent decree.

The Court of Appeals of the Third Circuit announced the proposition that when a party to a suit prepares and presents for entry in a District Court a form of decree in accordance with the opinion and mandate of a Court of Appeals, the decree entered, so far as the party preparing and presenting is concerned, becomes a consent decree.

The Court said:

"We note the general principle that a bill of review will not lie where the decree in question was a consent one: *Thompson v. Maxwell*, 95 U. S. 391. Now, while the decree before us is not a decree based on a compromise or consent of the parties, yet as the entry of a decree dismissing the bill as to the patent was one in favor of the defendant, and the defendant was taking no step, it would seem that there is substantial ground for contending that when the plaintiffs themselves took the matter into their own hands and themselves prepared, moved and had entered the decree which dismissed their patent bill, such voluntary action on their part in entering the decree in favor of their adversary, was not only in form but in substance, and by positive act on their part, a consent, and, so far as they were concerned, a consent decree" (Tr. p. 89).

The Court of Appeals of the Third Circuit adduces no authority for the doctrine here announced, and we know of none.

It is, of course, true that a bill of review will not lie from a consent decree, but it is equally true that an appeal will not lie from a consent decree,

But under this pronouncement of the Court of Appeals of the Third Circuit, if an unsuccessful plaintiff prepares and presents for entry a decree in accordance with the decision of the court, that decree, as to the plaintiff, becomes a consent decree and the plaintiff by preparing and presenting it *ipso facto* cuts himself off from the right of appeal. In such a case if the defendant refuses to prepare and present the decree all right of appeal would be cut off.

The Court of Appeals of the Third Circuit in its opinion refers to the fact that the decree gave the plaintiff "affirmative relief", referring thereby to plaintiff's right to begin accounting proceedings.

Now, in a patent case, in which a part of the claims are found valid and infringed and a part found invalid or not infringed, if the plaintiff prepares and presents a decree ordering an injunction and accounting on the claims sustained, he gains affirmative relief on the claims sustained. If the Court of Appeals of the Third Circuit is correct, however, he thereby cuts himself off from any right of appeal on the claims on which the court has found against him, because the decree becomes, by the act of preparing and presenting it, a consent decree on the part of the plaintiff.

It seems unnecessary to point out that the entry of the decree in this case was necessary in order to perfect plaintiffs' right to a bill of review. It is, of course, basic to the right to file a bill of review against a decree that the decree against which the bill is to be filed must be entered.

Further, a fair account in any case is an advantage to both parties, and the plaintiffs in this case went no further with their accounting proceedings than to get an account stated and the books in the

hand of the Master. Accountings at best are difficult proceedings and where they cover transactions for a period of years anterior to the decree, books become lost and witnesses die or forget. The plaintiffs, therefore, gained no advantage, in taking steps to get the account stated and the books filed, which the defendant did not share equally with it, because it was as much an advantage to the defendant to get a fair accounting as it was to the plaintiffs.

The Court of Appeals of the Third Circuit bases its refusal to follow the decision of this Court on the procedure adopted. It recognizes the inequities created by its decision and indicates that its action would have been different had the procedure been such as to prevent the entry of the decree against which the bill of review is filed.

The question, if there was any, as to the proper practice in this case has now been settled by the decision of this Court in *National Brake and Electric Co. v. Christensen*, *supra*.

The Court of Appeals of the Third Circuit, however, suggests that plaintiff might have applied to it to withhold its mandate after the decision by the District Court in the Southern District of New York. We pass without consideration the suggestion that the Court of Appeals of the Third Circuit would have withheld its mandate because a District judge in another circuit had declined to follow its decision, especially in view of the fact that, in making its decision, it reversed a District Court of its own circuit.

The Court of Appeals of the Third Circuit also

suggests that application might have been made to it to prevent the entry of a decree on its mandate after the conflicting decision of the Court of Appeals of the Second Circuit. How the situation would have been changed had the plaintiff made such application does not appear, for the Court of Appeals of the Third Circuit, at that time, had no power over its mandate. The mandate went down on the 24th of February, 1915. The term ended in March of that year; a second term had elapsed, and a third term had begun before the decision of the Court of Appeals of the Second Circuit came down.

It is well settled that a court has no power to revoke its mandate and direct the entry of a different decree below after the term has expired during which the mandate has gone down. *Sibbald v. U. S.*, 12 Peters, 488; *Reynolds v. Manhattan Trust Co.*, 109 F. 97; *Waskey v. Hammer et al.*, 179 F. 273.

The Court of Appeals of the Third Circuit also suggests that the plaintiff might have applied for a *certiorari* in *Baldwin v. Grier*. The Court, however, says:

"We do not say that the plaintiffs were bound to do so; we only say they could have so petitioned."

There was no ground for applying for *certiorari* in this case until after the decision of the Court of Appeals of the Second Circuit in *Baldwin v. Abercrombie & Fitch*, and proceedings for the writ were begun very shortly after this decision. Now, the sole ground on which the writ was applied for and granted was the conflicting decisions of the Courts of Appeals of the Second and Third Circuits (see *Petition*, Tr. p. 67 *et al.*). The lamp structures in-

volved are identical in their relation to the patent. There was no question of infringement in either case. The sole question presented in both cases was the validity of the reissue. In other words, the sole question involved was a question of law, the facts being identical in both cases. There was, therefore, nothing in the record in this case which would have in any way enlightened this court, or which would have tended to change the decision rendered in *Baldwin v. Abercrombie & Fitch*. That case was, in fact, a test case, and there was not only no reason for not taking up to this court the same state of facts and the same question of law in two cases, but such course was unnecessary and improper. Further, the taking up of the case of *Baldwin v. Grier* to this Court would have imposed unnecessary labor on this Court and would have involved unnecessary expense, because the record in *Baldwin v. Grier* contained not only the facts before this Court in *Baldwin v. Abercrombie & Fitch*, but also a large amount of testimony relating to unfair competition with which this Court would have had nothing to do.

Again, the defendant has suffered no injury and the plaintiff has gained no advantage by the course which has been pursued.

A writ of *certiorari* could not have been applied for in this case until the decree on the mandate of the Court of Appeals of the Third Circuit had been entered. This Court would certainly not have granted a writ with the case hanging in the air. Had a writ been asked, this Court might have very well declined to grant it on the ground that the sole question involved was already before it in *Baldwin v. Abercrombie & Fitch*, but had it granted a writ, the only way in which the condition of the case would have been changed is that it would have

been mandatory upon the Court of Appeals of the Third Circuit to do that which it had the power to do, and should have done, under the bill of review, according to the principles announced by this Court in *National Brake and Electric Co. v. Christensen*, *supra*.

The Court of Appeals of the Third Circuit misinterprets the ground of the bill of review, and the authorities it cites do not apply.

The bill of review was applied for because of error apparent on the face of the former decision of the Court of Appeals of the Third Circuit. The District Court (Orr, *J.*) in its opinion on the bill of review states:

“The error of law was the alleged improper application of the provisions of the Revised Statutes, Section 4916, relating to the reissue of defective patents, to the reissued patent in suit” (Tr. p. 41).

This error of law did not result from any change in the reissue law in the period between the decision of the Court of Appeals of the Third Circuit and the decision of this Court; nor any change in the interpretation of the reissue law. The decision of this Court on the former *writ of certiorari* did not change the interpretation of the reissue law and thus convert the decision of the Court of Appeals into an erroneous decision. As before stated the decision of the Court of Appeals of the Third Circuit was wrong *ab initio*.

The Court of Appeals of the Third Circuit, how-

ever, after stating the familiar two grounds for a bill of review, goes on to say:

"Such being the law as to bills of review, this case resolves itself into the question whether the subsequent decision of the Supreme Court on this patent at 245 U. S. 198, constituted one or both of such grounds" (Tr. p. 90).

The Court of Appeals of the Third Circuit, therefore, holds that its decision was originally right and that the error therein was injected into it by the decision of this Court. Putting it another way, the Court of Appeals of the Third Circuit appears to be of opinion that there was no error in its decision until this Court handed down the opinion on the *writ of certiorari* (245 U. S. 198). In brief, what this Court held was that the Court of Appeals of the Second Circuit was right in its interpretation of the reissue law and the Court of Appeals of the Third Circuit was wrong in its interpretation of the law. The decision of this Court did not make the decision of the Court of Appeals of the Second Circuit right and the decision of the Court of Appeals of the Third Circuit wrong. The decision of this Court did, however, afford an authoritative ground on which the error in the decision of the Court of Appeals of the Third Circuit could be brought to its attention. Under these conditions, the authorities referred to by the Court of Appeals of the Third Circuit do not apply.

Referring to *Tilghman v. Werk*, decided by Judge Jackson, afterwards Mr. Justice Jackson, 39 F. 680, the facts which led up to this decision were as follows:

The Tilghman patent was involved in three suits, one against Mitchell, one against Proctor and one

against Werk. In the Mitchell suit this Court decided that the patent was not infringed (*Mitchell v. Tilghman*, 19 Wall. 287).

The suit of *Tilghman v. Proctor* next went to this Court and is reported 102 U. S. 707. On a somewhat different record this Court found the patent to be valid and infringed.

Thereafter *Tilghman v. Werk* came before Judge Jackson on a petition to vacate a decree of April 9, 1878, dismissing the Werk suit, this decree having been entered prior to the decision of this Court in *Tilghman v. Proctor*. In dismissing this petition, which was not a bill of review, Judge Jackson said:

"the question is presented whether a change of its ruling or decision by the Supreme Court on a question of law or fact, or upon a mixed question of law and fact, constitutes such new matter as will sustain a bill of review to vacate decrees of the circuit court pronounced before such change was made. We think, upon principle and authority, this proposition cannot be maintained."

The decision in *Tilghman v. Werk* cannot apply here, **because in the case at bar there has been no change of ruling or decision by the Supreme Court on any question of law or fact or upon a mixed question of law and fact.** As before pointed out, the interpretation of the reissue law not was changed by the decision of this Court on the former *writ of certiorari*.

In this connection, we call attention to the fact that the ruling of this Court in allowing a bill of review in the case of *Henry v. Dick*, 244 U. S. 651, is contrary to this *dicta* in the decision in *Tilghman v. Werk*. This Court, by its decision in Motion

Picture Patents Co. *v.* Universal Film Co., 243 U. S. 502, directly overruled *Henry v. Dick*, 224 U. S. 1, and in so doing, changed the construction of the patent law so far as it applies to the question of contributory infringement. The bill of review, which was later allowed in *Henry v. Dick*, 244 U. S. 651, was allowed because this Court had changed its ruling on a question of law.

We further call attention to the comment of the Court of Appeals of the 8th Circuit on the decision of *Tilghman v. Werk*, in the Omaha case, *supra*.

"If there was no change in the situation of the parties after the entering of the decree in the first case cited, so as to make a revision of the decree inequitable, we should have thought a bill of review would have properly lain in that case after the decision of the Supreme Court of the United States in *Tilghman v. Proctor*, 102 U. S. 707; 26 L. Ed. 279."

Judge Hand in *re Brown*, 213 F. 701, commented on this case as follows:

"In *Tilghman v. Werk* (C. C.) 39 Fed. 680, Judge Jackson declined to regard a change in the decision of the Supreme Court as the ground for a bill on newly discovered evidence; whether he might have held it good as error apparent of the record does not appear."

In *Hoffman v. Knox*, 50 Fed. 484, the Circuit Court entered a final decree pursuant to a statute of the State of Virginia, which statute was subsequently held unconstitutional by the highest court of Virginia. Thereafter, a petition for rehearing was filed which it was held came too late, but which the Circuit Court held could be treated as a bill of review for error apparent. On appeal to the Court

of Appeals of the Fourth Circuit, Justice Fuller, afterwards Chief Justice (p. 491), held:

"The fact that nearly eighteen months after the decree of October 14, 1887, the Court of Appeals of Virginia decided these laws to be unconstitutional for the reasons stated was not enough in itself to create error of law apparent and justify a bill of review on that ground or that of new matter *in pais*. * * * but this rule cannot be applied where the construction contended for has not been announced at the time of the final adjudication by the United States Court so as to make the law erroneous on its face by relation."

In other words, this decision holds that the law of Virginia, upon which the first decision was based, not having been held unconstitutional at the time the decision was rendered there was no error on the face of the decision, and the subsequent declaration, by the highest court of Virginia, that the law was unconstitutional did not inject error into the decision.

The distinction between this case and the decision of the Court of Appeals of the Third Circuit in *Baldwin v. Grier* is clear. In *Hoffman v. Knox* it was sought to impose an error on the face of the decision by reason of the subsequent declaration of the highest court of Virginia that the law on which the decision was based was unconstitutional, *i. e.*, it was sought to impose an error on the face of the decision because there had been a change in the law. In *Baldwin v. Grier*, the error was not imposed on the face of the decision by any subsequent change of law.

We also call attention to the statement of Judge Hand respecting this decision in *re Brown, supra*:

"Thus in *Hoffman v. Knox*, 50 Fed. 484, the Circuit Court made its own ruling upon the

constitutionality under the state Constitution of a state statute. Later the state court held differently in another case, a decision which is usually as absolutely conclusive as a ruling of the Supreme Court itself. The Court of Appeals for the Sixth Circuit, Chief Justice Fuller presiding, held that such a ruling did not constitute error apparent on the record. It must be conceded, however, that it is not certain that the ground of decision was not in part due to the unwillingness of the court, as matter of substantive law, to make the state decision apply as *ex post facto*."

Scotten v. Littlefield, 235 U. S. 410, was one of a number of bankruptcy cases which grew out of the bankruptcy of A. O. Brown & Co. *Scotten and Scotten & Snyder* had certain claims which, with a number of others, were passed on by the Court of Appeals of the Second Circuit in *In re Brown*, 193 F. 24. These claims were subsequently determined adversely to the claimants by this Court in *First National Bank of Princeton v. Littlefield*, 226 U. S. 110. In the meantime another creditor, one Gorman, had instituted a separate proceeding against Littlefield (Trustee in Bankruptcy) to reclaim certain shares of copper stock, and the Court of Appeals of the Second Circuit held that this stock was not sufficiently identified (184 F. 451). From this decision, appeal was taken to this Court, which reversed on the ground that there was sufficient proof of identity. (*Gorman v. Littlefield*, 229 U. S. 19.) *Scotten*, and *Scotten and Snyder*, then petitioned for leave to file a bill of review. This was refused, the Court of Appeals of the Second Circuit (*In re Brown*, 213 F. 705) saying:

"It is the theory of these claimants that if the rule enunciated in *Gorman v. Littlefield* had been applied to the facts in their cases it

would have been held that as to their steel stock identity had been proved. *They therefore bring this bill of review which in substance and effect prays for a retrial of their respective claims. They contend that they did not present any argument to the District Court or to the Court of Appeals or to the Supreme Court as to this part of their claim and that in their record on appeal they left out some of the testimony that referred to the steel stock; also that the appellate courts did not deal with that question.*

It appears then that these claimants originally advanced the claim which is the subject of their bill of review; that they either took all the testimony they could muster in its support, or had full opportunity to do so before the referee. That they elected not to argue before the District Court the proposition that they had traced their steel stock into the block of 1,000 shares which was pledged to the Hanover Bank. That, although many months before their appeal was argued in this court the Gorman case had been disposed of here and an appeal from our decision therein taken (by their own counsel, who also appeared for Gorman), they elected not to present and argue the question (or at least present and reserve it) that our decision in the Gorman Case was unsound. That before the Supreme Court they elected not to call attention to this same question, although for some reason the appeal in the Princeton Bank and these two cases came on for argument there before the earlier appeal in the Gorman Case.

Their theory seems to be that they may bottle up part of their claim, which was, as originally presented, a single one, during review by three successive courts and then years afterwards bring it forth de novo to be presented for decision." (Italics ours.)

This decision of the Court of Appeals of the Second Circuit makes it clear that the alleged bill

of review in the *Scotten* case was not a bill of review for error apparent on the face of the proceedings without further examination of questions of fact. On the contrary, as the Court points out, this bill of review sought a retrial of the case, including the taking of additional testimony and the presentation of an additional question to the appellate courts. It was not contended that as this case was presented to the Court of Appeals there was error, but that if the claimants had opportunity to retry their case, in view of the decision of this Court, announced in *Gorman v. Littlefield*, it could be retried in such a way as to establish the claims. On appeal, this Court said:

"Both courts below put their decisions on the ground that the appeal to the circuit court of appeals from the original order of the district court in the reclamation proceedings really involved the claim for the United States Steel stock in its present aspect, and that if not presented to the court of appeals when there on appeal it could not be held back and made the subject of a bill of review, as is now attempted to be done. We think this decision was clearly right. Furthermore, the ground alleged for the bill of review now is that the principles which determined the disposition of the *Gorman Case*, 229 U. S. 19 (decided May 26, 1913, a little more than two years after the decree in the district court), reversing (411) the circuit court of appeals in the same case (99 C. C. A. 345, 175 Fed. 769), would, had they been applied in this case, have required a different result in the district court in dealing with the original petition in reclamation, so far as the three hundred shares of the United States Steel stock, pledged with the Hanover National Bank, are concerned.

Bills of review are on two grounds: first, error of law apparent on the face of the record

without further examination of matters of fact; second, new facts discovered since the decree, which should materially affect the decree and probably induce a different result. 2 Bates, Fed. Eq. Proc. 762; 2 Street, Fed. Eq. Pr., Sec. 2151.

If the decision in the Gorman Case would have required a different result if the principles upon which it was decided had been applied in the original proceeding, which we do not find it necessary to decide, such subsequent decision will not lay the foundation for a bill of review for errors of law apparent, or for new matter *in pais* discovered since the decree, and probably requiring a different result. *Tilghman v. Werk*, 39 Fed. 680 (opinion by Judge Jackson, afterwards Mr. Justice Jackson of this court); *Hoffman v. Knox*, circuit court of appeals, fourth circuit, 1 C. C. A. 535, 8 U. S. App. 19, 50 Fed. 484, 491 (opinion by Chief Justice Fuller)."

The District Court for the Western District of Pennsylvania (Orr, J.) refers to this decision as follows:

"The defendant has cited *Scotten v. Littlefield*, 235 U. S. 407, as a complete precedent which should govern the present case and require a dismissal of the bill of review. Had the Court in that case not dismissed the bill of review, there would have necessarily been a further examination of matters of fact and the consideration of a question which was held back in other proceedings and subsequently made the subject of a bill of review. It is insisted by counsel for the defendant that in the case just cited, the Supreme Court squarely holds that a subsequent decision by it will not lay the ground for a bill of review. To this proposition the Court cannot agree" (Tr. p. 41).

It is believed that this summary of this case by the District Court for the Western District of Pennsylvania is correct.

The differences between *Scotten v. Littlefield* and the case at bar are sufficiently marked. In the case at bar no question "was held back in other proceedings and subsequently made the subject of a bill of review". The bill of review is sought not for the purpose of retrial, but because of an error apparent on the face of the record, that is, in the decision of the Court of Appeals of the Third Circuit.

Certainly, in view of the entire dissimilarity of the facts involved, *Scotten v. Littlefield* can have no bearing on the case at bar, and this is made the more apparent by the fact that the cases cited therein, namely, *Tilghman v. Werk*, 39 F. 680, and *Hoffman v. Knox*, 50 F. 484, have no application to the case at bar.

In its brief in opposition to the grant of the writ respondent relied on the *Rubber Tire Cases* (*Diamond Rubber Co. v. Rubber Tire Co.*, 220 U. S. 428). The *Rubber Tire Cases* neither raised nor decided any question involved here. The Court of Appeals of the Sixth Circuit held the Grant tire patent invalid, and thereafter the Court of Appeals of the Second Circuit held this patent valid, which holding was affirmed by this Court. There were, in all, three litigations aside from that in the Second Circuit, two in the Sixth Circuit and one in the Seventh Circuit. The successful defendants in these litigations were respectively the Goodyear Tire Co., the Kokomo Tire Co. and the Victor Tire Co.

The Court of Appeals of the Second Circuit properly excepted from its injunction wheels, that is, assembled tire, rims and retaining rings, made by

the Goodyear, Kokomo and Victor concerns, because the decrees under which they were operating were in force. It may be remarked, however, that it was subsequently held in several cases that the tires or rubber shoes made by these companies in the Sixth and Seventh Circuits could not be sold and combined by the purchaser outside these circuits with rims and holding rings.

The Court of Appeals of the Second Circuit excepted from its injunction the wheels made by the three companies referred to, because the decrees in the Sixth and Seventh Circuits under which they were operating could not, of course, be set aside by the Court of Appeals of the Second Circuit. No attempt was made to set aside those decrees in the circuits in which they were made, and they could not, of course, be collaterally attacked in another circuit.

In this case, we are directly attacking, by the bill of review, the decrees between Grier Bros. Co. and John Simmons Co. We are not collaterally attacking that decree in a circuit outside that in which the decree was rendered. What was done in the Rubber Tire Cases, therefore, can have no bearing in this proceeding.

The Decree Works Irreparable Injury to the Plaintiffs.

The reissue here involved has been found to be valid by the highest authority, *i. e.*, by this Court in its decision, 245 U. S. 198. That this respondent is an infringer there is no doubt. Infringement was found by the District Court of the Western District of Pennsylvania and that finding was not disturbed by the Court of Appeals. The lamp complained of in the Second Circuit is identical with

the lamp put out by this defendant except for a difference in shape which, of course, is immaterial. Therefore, the exact structure complained of in this case was determined by this Court to be an infringement of this patent. The patent is valid as against every one in the United States except this respondent, and the effect of the decree now standing is to practically constitute this respondent a part owner of the patent. Having built up a business on a flagrant infringement—for its lamps was held to be an exact and unfair copy of plaintiff's commercial lamp—it can manufacture in the Third Circuit, and, under *Kessler v. Eldred*, 206 U. S. 285, can sell infringing lamps anywhere in the United States in direct competition with plaintiff's licensees and on better terms because it pays no license fee. Respondent is therefore, by an erroneous application of the law, placed in a better position in respect to this patent than any one in the country. Surely, it needs no argument to show that this condition of affairs violates all principles of justice and equity.

As this Court pointed out in its decision on the former *writ of certiorari*:

"The plaintiffs (we shall so designate respondents) struggled through some years and some litigation to the success of the decrees in the pending case. In a suit brought in the District Court for the Southern District of Illinois a device like that of the defendants herein was held to be an infringement of certain claims of the original patent. The holding was reversed by the Circuit Court of Appeals for the Seventh Circuit. *Bleser vs. Baldwin*, 199 Fed. 133.

Subsequently, the reissue having been granted, suit was brought in the Western District of Pennsylvania against an asserted infringer. Unfair competition was also alleged,

and, holding the latter to exist, the court granted a preliminary injunction (210 Fed. 560). Upon final hearing that holding was repeated, and infringement of a claim of the re-issue patent decreed. 215 Fed. 735. The decree was reversed by the Circuit Court of Appeals (Third Circuit) on the ground that the claim of the re-issue patent found to have been infringed was broader than a corresponding claim of the original letters patent and therefore void. The holding of the District Court as to unfair competition was sustained. 219 Fed. 735. Aided by the reasoning in the opinions of those cases and the discussion of counsel, we pass to the consideration of the proposition in controversy" (Tr. p. 20).

The record before this Court on the *writ of certiorari* to the Second Circuit showed that the plaintiffs were the first to develop a portable miner's acetylene lamp and that through their efforts a market had been established for this lamp in the face of unusual difficulties and in spite of the prejudice against the adoption of this new illuminant. If, however, the decision of the Court of Appeals of the Third Circuit stands, all these efforts and all this previous litigation may go for naught. The respondent, Grier Bros. Co., as above stated, occupying as it does a better position with respect to the trade because it has no investment in the patent and no license fees to pay, can manufacture in the Third Circuit and can make better terms as to price and drive plaintiff and its licensees from the market.

As stated by the District Court for the Western District of Pennsylvania (Orr, J.):

"In the first place, the law, as interpreted by the Supreme Court of the United States, is the law which should govern all subordinate

Federal Courts. In the second place, if the later decision of the Supreme Court of the United States cannot be invoked for the relief of the plaintiffs, they are in a situation not contemplated by the States when they gave authority to Congress to secure to inventors the exclusive right to their discoveries and inventions for a limited period, or by the Congress of the United States when it legislated in pursuance of such authority. By the decision of the Supreme Court of the United States, the validity of the reissue patent may secure to the plaintiffs rights thereunder in all parts of the United States, except within the limitations of the Third Judicial Circuit. Plaintiffs' rights to the invention would not be exclusive for any period within that Circuit in which is embraced the great anthracite and bituminous coal fields of the State of Pennsylvania" (Tr. p. 41).

The mere fact that a decision has been rendered by a Court of Appeals in a patent case does not except the decision from the operation of a bill of review.

Respondent argued, and the Court of Appeals of the Third Circuit seems to be of opinion, that the mere fact that a Court of Appeals has rendered a final decision in a patent case excepts the decree entered thereon from the action of a bill of review,—that such a decree is characterized by a peculiar sanctity which renders it irrevocably "settled law" between the litigants.

It seems to be argued that the setting aside of a final decree in a patent case by a bill of review is fraught with much graver results than where the decree affects any other sort of property and that, therefore, a defendant in a patent case becomes vested absolutely with the right to continue

the infringement of a valid patent although such right rests on an erroneous decree.

Wharton's Legal Maxims, Maxim 58 (p. 132), seems to apply to a patent case as well as to any other.

"Though a judgment binds the parties until it is reversed, yet it cannot be alleged against a reversal of it."

After pointing out that this may be thought to be contrary to the maxim that it is for the interest of the state that there be an end of lawsuits and that no one ought to be twice punished for the same fault, Wharton states:

"But error in judgment does not come within either of these rules; for it is a failure of justice, and must be remedied under the maxim, '*De fide et officio judicis non recipitur questio: sed de scientia sive sit juris aut facti.*'"

[Of the good faith and intention of a judge a question cannot be entertained; but it is otherwise as to his knowledge, or error, be it in law or in fact.]

Further, since the purpose of a bill of review is to set aside an erroneous decree we see no reason why a decree entered on the decision of a circuit court of appeals in a patent case should be excepted from its operation. As we view the matter, once error in a decree is established, no matter whether it be a decree entered on the decision of a circuit court of appeals or any other court, or whether it relates to a patent or any other form of property, then a condition has arisen in which a bill of review may be applied for. Whether such application shall be allowed depends, of course, on the circumstances of the case. As this Court

points out in *National Brake and Electric Co. v. Christensen*, *supra*,

"such applications are addressed to the sound discretion of the appellate tribunal and should be decided upon considerations addressed to the materiality of the new matter and the diligence in its presentation."

This matter becomes of grave importance in view of Section 1228a Compiled Statutes, in effect September 6, 1916, providing that a *writ of certiorari* will not be entertained unless the petition is applied for within three months after the entry of the judgment or decree complained of. It is obvious that two conflicting decisions of two courts of appeals and the judgments thereon, especially in patent cases, will, practically speaking, never be rendered within three months of each other. Until such conflicting decisions are rendered, there is usually no ground for application for *writ of certiorari*. If, after such conflicting decisions, a writ be granted in the second case and this Court renders a decision affirming the decision in the second case, the principles announced in the decision of this Court can never be applied to the first case, unless a bill of review will lie, no matter what the equities may be or how strongly the circumstances of the case may demand it.

No change has occurred in the status of the parties since the entry of the decree and there are no facts in the case which make this bill of review inequitable.

After the Court of Appeals of the Third Circuit had referred the application for leave to file the bill of review to the District Court, it was

open to the defendant-respondent, in opposing the application, to show if it could, by affidavits or otherwise, any facts relating to a change in the status of the parties which would render the filing of a bill of review in this case inequitable. It made no such showing.

After the bill of review was filed, plaintiff-petitioner took testimony thereunder to introduce into the record the decision of this court, to introduce the proceedings in the Second Circuit litigation, and to prove that the lamp before the Second Circuit courts was the same so far as the patent was concerned as the lamp involved in the Third Circuit litigation. Here, again, defendant-respondent had opportunity to establish, by testimony, any facts which would render a bill of review in this case inequitable. It took no testimony. It follows, therefore, that the status of the parties is precisely the same as it was when the Decree was entered on the mandate of the Court of Appeals of the Third Circuit.

Further, there are no facts in this case which make this bill of review inequitable. While the decision of the Court of Appeals of the Third Circuit was rendered January 22, 1915, the order on the mandate was not entered in the court below until a year later, that is, January 5, 1916. The injunction issued by the District Court was in effect until the decree on the mandate of the Court of Appeals was entered. During this year, however, the litigation in the Second Circuit was completed and the *certiorari* asked for. Judge Mayer rendered his opinion February 6, 1915, the Court of Appeals its affirming opinion November 9, 1915, and the application for *certiorari* was granted January 10, 1916, that is, only five days after the court

below had entered its decree on the mandate of this Court.

Now, the defendant must have been fully apprised of these proceedings. The president of the defendant, Justrite Mfg. Co., in the New York suit, Fred. J. Becker, and its superintendent, Hansen, both testified for the defendant here, and Becker introduced as exhibits two of the Justrite lamps which were complained of in the New York suit. With this close connection between the defendants in these suits, and the inevitable knowledge in the trade of what was going on, it is impossible that this defendant was not fully informed as to the proceedings in the New York case including the grant of the *certiorari*.

Under the bill of review an accounting should be allowed for the entire period of infringement.

The District Court in its first opinion excepted from the accounting the period of infringement antedating the filing of the bill of review, but its supplemental opinion (Tr. p. 43), filed after argument on the settlement of the decree, reversed its holding and held that

“Reliance upon a decree which is erroneous should not protect a party when such decree is subsequently set aside for error.”

And further stated that

“It seems to be the correct principle that as between the parties to the original litigation, the vacation of a decree by a bill of review leaves such original parties in the same position as if the original decree had not been entered” (Tr. p. 43).

Of course, the sole purpose of a bill of review is to review an erroneous decree and restore the parties to the same position which they would have occupied had the erroneous decree not been rendered.

Story's Equity Pleadings, 10th Edition, Par. 403 (p. 455), states:

"A bill of review is in the nature of a writ of error, and its object is to procure an examination, and alteration, or reversal of a decree made upon a former bill."

In *Griggs v. Gear*, 3 Gilman, Supreme Court, Ill., it is stated:

"Bills of review are in the nature of writs of error filed in the same court where the decree in the original cause was entered, calling upon the court to review and reverse the former decree."

In Mitford & Tyler's Equity Pleadings, Edition of 1878, page 186, it is said, referring to bills of review and particularly to the decree

"If it (the decree) has been carried into execution, the bill may also pray the further decree of the court, to put the party complaining of the former decree into the situation in which he would have been if that decree had not been executed."

See also Foster's Fed. Practice, Par. 354, p. 1123.

In *Bush v. U. S.*, 13 Fed. 625, the United States had brought an action against Griswold and others, Bush being among the defendants. Bush thereafter filed his bill of review against the decree in *U. S. v. Griswold*. A motion to dismiss was filed on the ground that, as the United States could not be sued without its consent, and as it had not con-

mented to the filing of this bill of review, the bill had no standing in court. The court held that the bill of review was not an original proceeding, but that it was an auxiliary or supplementary proceeding growing out of the former action and that the United States was already in court. The Court said:

"A bill of review is an established mode of proceeding in a court of equity by which the defendant may have a decree given against him reviewed for errors upon its face by the court that pronounced it. It is only a more formal mode of rehearing the case and is an incident to the original suit."

Applying these principles to the case at bar, it is clear that the effect of filing the bill of review was to reopen the entire case and to put it in the same position as though the decision of the Court of Appeals had not been rendered; that is, the effect of filing the bill of review was to refer the parties to their *status quo ante*. When the petition for leave to file the bill of review was referred by the Court of Appeals to the District Court below with power to act, that court was given the power to affirm or vacate the former decree. When that court, in the exercise of the power thus given, vacated the former decree, and directed the entry of another decree, that decree properly placed the parties in the same position in which they would have been had the former decision of the Court of Appeals never been rendered.

Indeed, following the principles laid down in *Griggs v. Gear*, *Foster's Fed. Practice*, and *Bush v. U. S.*, *supra*, no other course was open. A bill of review, if sustained, can have no effect except to

put the parties in the position which they would have occupied had the decision originally been the other way.

This is pointed out in *Sturrock v. Littlejohn*, 68 L. J. 165 Q. B. In this case, the plaintiff—a former defendant—filed his bill of review against the former decision. The court sustained the bill of review and allowed costs to the plaintiff *in both actions*, saying, referring to the present plaintiff and former defendant:

“He ought to be replaced in the same position as though that action (*i. e.*, the former action) had been brought to its legitimate conclusion in his favor.

This case is a complete precedent for the decree which was entered under the bill of review. Petitioner, on the bill of review, must necessarily “be replaced in the same position as though” the former action “had been brought to its legitimate conclusion in petitioner’s favor”. The District Court properly therefore gave an accounting for the full period of the infringement and allowed costs in both actions.

We further call attention to the fact that a decree giving petitioner an accounting in this case takes nothing from respondent. Respondent having infringed the patent, has made gains and profits from that infringement which it ought not to be entitled to keep. It has been frequently held that an infringer is a trustee for the owner of the patent for profits made from an infringement and as such trustee in this case respondent should be compelled to account for the profits and gains it has made.

Assume, for instance, that an action between A and B as to ownership of a building, the court of

last resort finds the title in A and subsequently, on the filing of a bill of review, reverses that judgment and finds the title in B. Certainly, A would not be entitled to retain the rents and profits received by him under the erroneous decision. But, if in the case at bar, respondent is relieved from an accounting for any part of the period of infringement, it is permitted to keep gains and profits which it received by reason of the unlawful use of petitioner's patent. As we view the matter, respondent is no more entitled to retain the gains and profits made by reason of an infringement of a patent than it would be to the rents which it received on account of real estate wrongfully held under color of law.

Further, should any period of the infringement be excepted from the accounting, the effect would be to take from petitioner and turn over to respondent profits which have accrued because of the infringement. Instead of replacing petitioner, as stated in *Sturrock v. Littlejohn, supra*, in the position it would have occupied had the original action gone to its legitimate conclusion in its favor, denial of an accounting for any part of the period in effect mullets petitioner to the advantage of the respondent. It is again urged that the grant of an accounting for the entire period does not take from respondent anything which it fairly gained. It simply requires the surrender of that which respondent would not have had except for an unlawful use of petitioner's property.

Conclusion.

We respectfully submit that the decision of the Court of Appeals of the Third Circuit should be reversed.

Respectfully submitted,

JAMES Q. RICE,
Counsel for Petitioner.

March 17, 1921.

Supreme Court of the United States,

OCTOBER TERM, 1921.

No. 57.

JOHN SIMMONS COMPANY,
Petitioner,

VS.

THE GRIER BROTHERS COMPANY,
Respondent.

SUPPLEMENTAL BRIEF FOR PETITIONER.

In the supplemental brief filed on behalf of respondent October 13, 1921, the point is raised that the bill of review in this case was barred by lapse of time. It is argued that a bill of review cannot be filed after the expiration of the period during which an appeal may be taken.

Whether the authorities cited in this supplemental brief establish this point or not, is not material here, because in this case there was no right of appeal from the decision of the Court of Appeals of the Third Circuit. Under the statute, the decision of a court of appeals is final in patent causes. If, therefore, respondent's argument as to the analogy between appeals and bills of review holds, then a bill of review can never be filed in a

patent cause after decision by a court of appeals, because there is no time within which an appeal can be filed.

The statement in respondent's brief on page 5 that

"at that time (Jan. 22, 1915) the period within which an appeal might be taken was one year"

is, therefore, entirely misleading as applied to this case, because, under the law an appeal to this court from the decision of the Court of Appeals of the Third Circuit, could not be taken within one year or within any period.

In any event, the matter has been settled by the action of this court in *Henry v. Dick*, 244 U. S. 651. There this Court allowed a bill of review to be filed against its decision in *Henry v. Dick*, 224 U. S. p. 1, more than four years after the term had expired during which the first case was disposed of.

The real question at issue is, of course, the question of laches. The decisions referred to in respondent's brief all, in effect, hold that a bill of review should not be received after a period of unreasonable delay. In the present case, there was no delay. The petition for the allowance of the bill of review was filed January 26, 1918, or eight days after the mandate of this Court in the Second Circuit case, *Baldwin v. Abercrombie & Fitch Co.* was sent down and the order entered thereon.

Respectfully submitted,

JAMES Q. RICE,
Of Counsel for Respondent.

October 28, 1921.

U. S. Supreme Court, U. S.

FILED

APR 11 1921

JAMES D. MANER,

CLERK

IN THE
Supreme Court of the United States

OCTOBER TERM, 1920. NO. 342 57

JOHN SIMMONS COMPANY,

Petitioner,

v.s.

THE GRIER BROTHERS COMPANY,

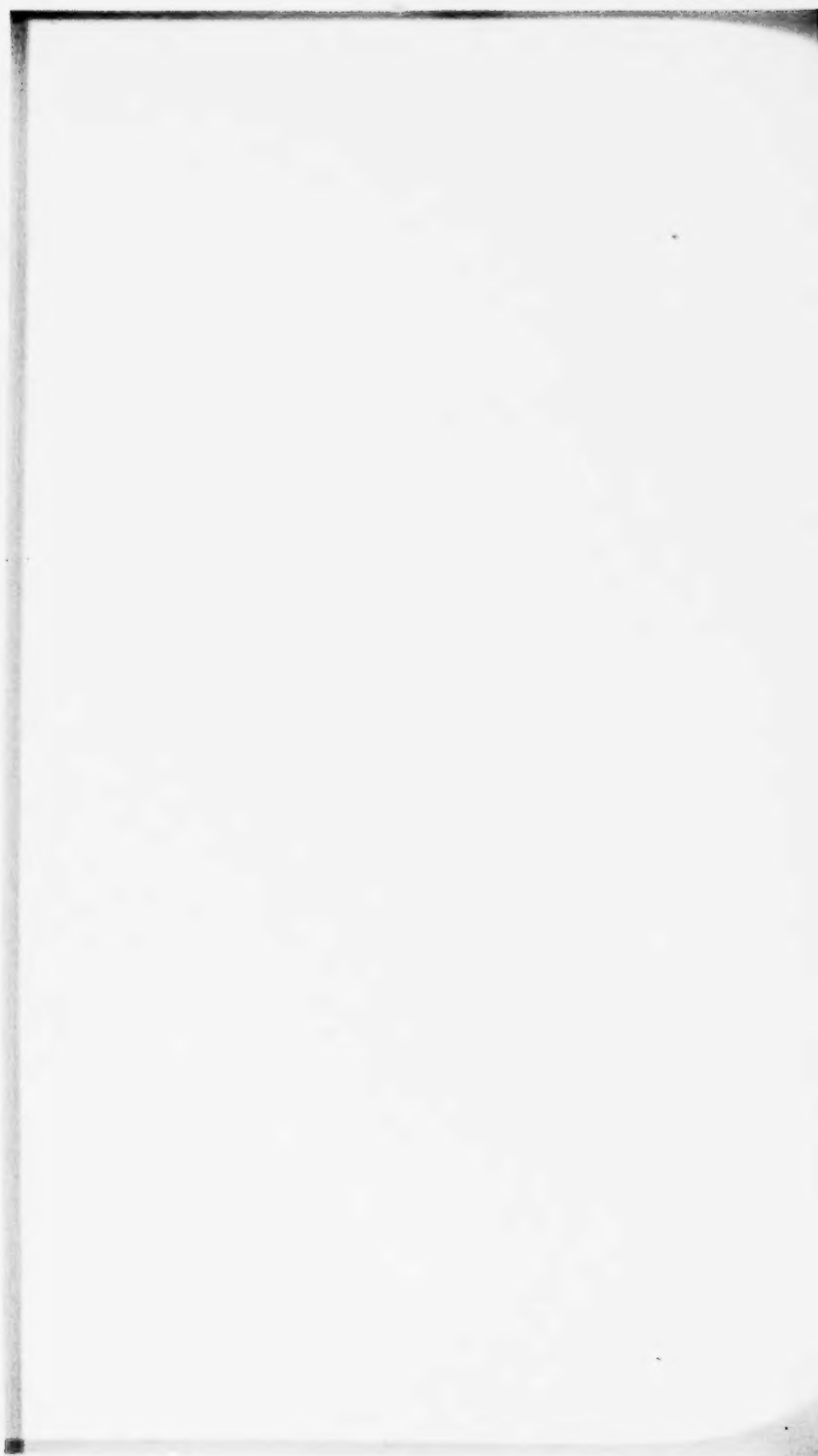
Respondent.

Writ of Certiorari to the
United States Circuit
Court of Appeals for
the Third Circuit.

BRIEF FOR RESPONDENT.

C. P. BYRNES,
GEO. H. PARMELEE,
GEO. E. STEBBINS,

For the Respondent.



INDEX.

	PAGES
Questions Involved	1-1
History of the Case.....	1-7
Argument	8-11
Petitioner's Contentions Destructive of Judicial Stability	8-10
Alleged Facts do not Constitute Proper Ground for Bill of Review.....	10-21
Situation Here Not an Anomalous One.....	22-26
Plaintiffs Debarred by Own Acts from Filing Bill of Review, if Proper Basis Therefor Ever Existed	26-30
In No Event is Defendant Liable for Profits Prior to November 7, 1919.....	30-34
Petitioner's Authorities	35-39
Other Erroneous Positions of Petitioner.....	40-43
Conclusion	43-44

CASES REFERRED TO:

Abercrombie & Fitch Co. et al. vs. Baldwin et al., 245 U. S., 198.....	10
Baldwin vs. Grier Bros. Co., 219 Fed., 560.....	4
Baldwin et al. vs. Grier Bros. Co., 215 Fed., 735....	5
Baldwin (Jno. Simmons Co. Intervener) vs. Aber- crombie & Fitch Co. (Justrite Mfg. Co. Inter- vener), 227 Fed., 455.....	5
Baldwin (Jno. Simmons Co. Intervener) vs. Aber- crombie & Fitch Co. (Justrite Mfg. Co. Inter- vener), 228 Fed., 895.....	6
Bleser vs. Baldwin, 199 Fed., 133.....	4

INDEX—CONTINUED.

	PAGES
In re A. O. Brown & Co., 213 Fed., 705.....	11
Consolidated Rubber Tire Co. vs. Diamond Rubber Co., 157 Fed., 677.....	22
Consolidated Rubber Tire Co. vs. Diamond Rubber Co., 162 Fed., 892.....	23
Dowagiac vs. McSherry Mfg. Co., 155 Fed., 524.....	19
Gorman vs. Littlefield, 229 U. S., 19.....	15
Grier Bros. Co. vs. Baldwin et al., 219 Fed., 735....	5
Harburg vs. Arnold, 87 Mo. App., 328.....	20
Henry vs. Dick Co., 224 U. S., 1.....	36
Henry vs. Dick Co., 244 U. S., 651.....	36
Hill vs. Phelps, 101 Fed., 650.....	19
Hill vs. Chicago & Evanston Ry. Co., 140 U. S., 52	26
Home St. Ry. Co. et al. vs. City of Lincoln, 162 Fed., 133	32
Hoffman et al. vs. Knox et al., 50 Fed., 484.....	17
Kessler vs. Eldred, 206 U. S., 285.....	24
King vs. Dundee Mortgage Co., 28 Fed., 33.....	19
Miller vs. Tyler, 58 N. Y., 477.....	19
Mitchell vs. Tilghman, 19 Wall., 287.....	12
Nat'l Brake & Elec. Co. vs. Neils Christensen et al., U. S. Sup. Ct. Adv. Op., Feb. 1-21, p. 1888.....	35
Omaha Elec. Light Co. vs. City of Omaha, 216 Fed., 848	38
Scotten vs. Littlefield, 235 U. S., 407.....	10, 15, 29
Tilghman vs. Werk et al., 39 Fed., 680.....	12
Tilghman vs. Proctor, 102 U. S., 707.....	13

IN THE
Supreme Court of the United States

OCTOBER TERM, 1920. NO. 312.

JOHN SIMMONS COMPANY,
Petitioner,

VS.

THE GRIER BROTHERS
COMPANY,
Respondent.

On Writ of Certiorari to
the United States Circuit
Court of Appeals for
the Third Circuit.

BRIEF FOR RESPONDENT.

The Questions Involved.

This proceeding raises the following general question of the greatest and most vital importance, viz:

Can a defendant, against whom an action for infringement of a patent has been dismissed pursuant to the decision of the highest court of his jurisdiction, be thereafter brought back into court by a bill-of-review and compelled to account for doing that which the decision of that court authorized him to do?

The District Court of the United States for the Western District of Pennsylvania answered this question in the affirmative, contrary, we believe, to all the authorities. That decision was reversed by the Circuit Court of Appeals for the Third Circuit in the decision from which this petition was taken.

This suit was based on reissue patent No. 13541, granted March 11th, 1913. The structures manufactured by the defendant prior to the date of reissue had been specifically held not to infringe the original patent by the decision of the Circuit Court of Appeals for the Seventh Circuit in a suit brought against another defendant.

As to the infringing acts complained of against this defendant, subsequent to the grant of the said reissue, the bill of complaint was ordered dismissed by the Circuit Court of Appeals for the Third Circuit on the 22nd of June, 1915, and a final decree dismissing said bill as to all questions of patent infringement was entered on January 5, 1916.

This respondent has, therefore, been proceeding throughout in accordance with the decision of a Court of last resort; and, since the date of the reissue patent herein involved, under the decision of the highest court in its jurisdiction.

The petitioner, notwithstanding these facts, seeks to now hold the defendant to an accounting for all infringing structures made by it since the date of the reissue patent.

The question above stated is of the very widest importance because, if the position of the petitioner herein is sustained, no one acquitted in a patent case can ever be safe in proceeding in accordance

with the mandate of the highest court of his jurisdiction so long as there remains in the United States any circuit in which the patent has not been adjudicated. That is to say, so long as there remains anywhere the possibility of a case reaching this court, and of a decision by this court sustaining the patent involved, all other defendants are in jeopardy, notwithstanding any final decrees which they may have obtained in their favor in their own circuits. The judgment of the District Court for the Western District of Pennsylvania was destructive in the highest degree of that stability of judicial decisions which the Courts have always sought to maintain. The Circuit Court of Appeals for the Third Circuit, in the decision from which this petition is taken, correctly appreciated this danger. It found for the respondent as follows:

(1) That the facts alleged in the bill-of-review do not constitute proper ground for a bill-of-review.

(2) That the plaintiffs were debarred by their own acts from filing a bill-of-review, even if the proper basis therefor existed.

These two specific questions are directly raised by this petition.

The respondent also contends that in any event, no recovery can be had against it for any acts committed by it prior to the entry of the decree of November 7th, 1919, of the District Court of the United States for the Western District of Pennsylvania. This was the decree based on the bill-of-review, and up to that date the decree dismissing the bill as to infringement was in full force and effect.

History of the Case.

The petitioner, or its predecessor Baldwin, first brought suit against one Bleser on the original Baldwin patent No. 821,580, in Illinois. In that case, the Court of Appeals for the Seventh Circuit, in April, 1912, held the patent not infringed by the Bleser Lamp (199 Fed. Rep., 133). The respondent commenced the manufacture of a lamp in all substantial respects similar to the Bleser Lamp, and at a time prior to the application for the Baldwin reissue herein involved. It believed that it could safely rely upon the decision of non-infringement in the Bleser case.

In February, 1913, Baldwin applied for a reissue of the said patent and this reissue was granted on March 11th, 1913. On October 10th, 1913, Baldwin brought the present suit under the reissue patent, joining in the bill of complaint allegations of infringement of said patent, and also of unfair competition in trade. At a preliminary hearing, the District Court for the Western District of Pennsylvania granted a preliminary injunction as to unfair competition, but reserved the question of patent infringement until final hearing (210 Fed. Rep., p. 560). At final hearing the District Court held claim 4 (the only claim as to which issue was raised by the petitioner) of the Baldwin reissue patent valid and infringed (215 Fed. Rep., p. 735). This respondent thereupon appealed to the Circuit Court of Appeals for the Third Circuit. That court affirmed the District Court as to unfair competition, but reversed the District Court as to the pat-

ent and held the reissue to be void (219 Fed. Rep., p. 735).

Pursuant to the mandate of the Court of Appeals, the District Court on January 5th, 1916, entered a decree, the sixth paragraph of which was as follows:

"6th. That the bill of complaint herein as to infringement of reissue letters patent No. 13,542 in suit B and the same hereby is dismissed."

That decree also ordered an accounting under the issue of unfair competition.

The mandate of the Court of Appeals was sent down on February 24th, 1915. Petitioner entered no decree on that mandate until January 5th, 1916, when a decree in accordance with the mandate was entered upon motion of petitioner's solicitors.

The petitioner made no effort to take the case to this Court on *certiorari*, but accepted as final the decision of the Court of Appeals dismissing the bill as to patent infringement and proceeded with the accounting on unfair competition, under the said decree of January 5th, 1916. That accounting is still pending.

In the meantime, on May 20th, 1913, the plaintiff brought suit on the same reissue patent in the Southern District of New York against Abercrombie & Fitch Company (Justrite Manufacturing Company, intervenor). In that suit Judge Mayer, of the District Court, held claim 4 of the reissue patent valid and infringed. His decision was dated February 5th, 1915 (227 Fed. Rep., 455). On appeal the lower court was affirmed by the Second

Circuit Court of Appeals on November 9th, 1915 (228 Fed. Rep., 895). Thereupon the *defendants* in the New York suit took a petition for *certiorari* to this Court. This Court in its opinion of December 10th, 1917, affirmed the decree of the Circuit Court of Appeals for the Second Circuit (245 U. S., 198).

On January 26th, 1918, the petitioner presented his petition in this case to the District Court for the Western District of Pennsylvania for leave to file a bill-of-review herein, such petition being based upon the decision of this court in the Justrite case. That petition was refused without prejudice to the right to renew the same after leave to file should have been procured from the Court of Appeals for the Third Circuit. Thereafter the petition was presented to the Court of Appeals for the Third Circuit, and that court, without hearing on the merits, referred the petition back to the District Court with leave to file.

The bill-of-review was filed on April 26th, 1918. The only testimony taken was that offered by the plaintiffs to prove the proceedings in the Abercrombie (Justrite) case and to identify the structure of the lamp involved in that case with the structure of the lamp here involved.

On October 7th, 1919, the District Court filed its opinion in which the bill-of-review was held to be a proper one and the relief prayed for was granted.

In that opinion, however, the District Court held that the accounting "should be limited so that it should not antedate the date of the filing of the bill-of-review, stating that the decision of the Court of

Appeals for the Third Circuit "was the law of the case between the parties, at least until proceedings were instituted to have it set aside."

Upon settlement of the decree, however, the District Court rendered a supplemental opinion (Rec., p. 48), in effect holding that it had been in error in so limiting the accounting; and in the decree of November 7th, 1919, an accounting was ordered without any limitation as to time (Rec., p. 49).

By that decree the defendant was required to account not only for the period prior to the decree on the mandate of January 5th, 1916, which dismissed the bill as to infringement; but it was also required to account for the entire period from January 5th, 1916, to November 7th, 1919. During that whole period it had been proceeding under a decree which dismissed the bill as to infringement.

Respondent commenced manufacture of the alleged infringing lamps long prior to the application for the reissue patent, as found by the Court of Appeals in its first decision (Rec., p. 7).

ARGUMENT.

1. Petitioner's contention is destructive of the stability of judicial decisions.

The decree of the District Court for the Western District of Pennsylvania of January 5th, 1916, dismissing the bill of complaint as to all questions of infringement of the patent in suit, and entered pursuant to the mandate of the Court of Appeals for the Third Circuit was, we submit, a final decree on the question of infringement; and was the settled law of this case as between these particular litigants. We find no reported case, and the petitioner has cited no case in support of this petition, in which a *defendant* after a final decree in its favor by the court of last resort in his jurisdiction, has ever been brought back, either by a bill-of-review or by any other proceeding, and compelled to account for doing that which the decision of that court authorized him to do.

If a defendant can be thus brought back after a final decree in his favor, it is manifest that he gains, in fact, little or nothing by such decree. If, so long (as in this case) there remains any circuit in the United States in which the patent in question has not been adjudicated, under petitioner's contentions, the defendant may at any time be faced with a bill-of-review and brought back into court for an accounting. No argument is, we submit, necessary to show that such a practice would be destructive of that stability of judicial decisions for which the courts of this and all other civilized countries have ever sought to attain. The effect of such a decision

upon the manufacturing business of this country would necessarily be highly unsettling, since no manufacturer acquitted of a charge of infringement could thereafter safely continue his business. The rights of every defendant in a patent case would necessarily remain unsettled until the expiration of the patent.

Infringement of a patent is a tort; and we submit that when a defendant has been charged with a tort and tried and cleared, he cannot again be attacked on the *same* charge. The principle of *autrefois acquit*, applicable to criminal cases, clearly applies in a situation like the present one. As we shall hereafter show, this has always been recognized by the Courts of this country.

The Court of Appeals for the Third Circuit in its decision herein complained of, clearly recognized this fact. In its opinion (Tr., p. 89), before taking up the main legal question involved, the Court of Appeals said:

"Before entering on that legal question, we note the unsettling effect such a holding would have on the whole system of patents, if a final decree holding a patent invalid can be vacated years afterwards because in a case between other litigants, in another jurisdiction, the same patent has been adjudged valid by the Supreme Court of the United States."

And again (Rec., p. 90):

"Such being the courses open to the plaintiffs before they procured the entry of this decree, we turn to the grave unsettling of patents which would follow if the stability and finality of a final patent decree once made is to be undermined by decisions subsequently made. For we are here dealing with the rights

of individual litigants. Whatever effect such subsequent decisions may have on other cases and other litigants, it must not be overlooked that every question, uncertainty of litigation or doubt as to future conduct, are all centered and finally merged in the stability of a final decree, and that such decree being entered it becomes the settled law as between these particular litigants."

2. The facts alleged in the bill-of-review do not constitute proper ground for a bill-of-review.

We respectfully submit that a bill-of-review does not lie under the particular facts of this case.

As stated by this court in *Scotten vs. Littlefield*, 235 U. S., pp. 407, 410:

"Bills of review are on two grounds; first, error of law apparent on the face of the record without further examination of matters of fact; second, new facts discovered since the decree, which should materially affect the decree and probably induce a different result. 2 *Bates' Federal Equity Procedure*, 762; *Street's Federal Equity Practice*, Vol. 2, 2151."

The sole basis for the present bill-of-review is the decision of this Court in the *Justrite case* (245 U. S., 198).

It has, we submit, been expressly held by this court that the contrary decision of another court does not constitute either error in law appearing in the body of the decree, or new matters of fact arising after the decree, for the purpose of a bill-of-review.

The Court of Appeals for the Third Circuit in the decision herein complained of, based its finding

to this effect on the decisions of this court, and held such decisions to be binding upon it (Rec., pp. 90-91), as follows:

"The two and only grounds for a bill-of-review, are, first, error of law apparent on the face of the record without further examination of matters of fact; second, new facts discovered since the decree which should materially affect the decree and probably induce a different result. *Scotton vs. Littlefield*, 235 U. S., 410. Such being the law as to bills-of-review, this case resolves itself into the question whether the subsequent decision of the Supreme Court on this patent at 245 U. S., 198, constituted one or both of such grounds. That it did not is, we think, decided by the Supreme Court itself in the case last cited, where that Court had occasion to pass on the question whether its decision in the *Gorman case*, 229 U. S., 19, made subsequent to a decree of the United States District Court, was a basis for a bill-of-review of the later case. That contention the Supreme Court met by holding '*Such subsequent decision will not lay the ground for a bill-of-review for errors of law apparent, or for new matter in pais discovered since the decree and probably requiring a different result.*' In support of that view, the Court refers to *Tilghman vs. Werk*, 39 Fed. Rep., 389, and *Hoffman vs. Knorr*, 50 Fed. Rep., 481. These cases, which have thus been adopted as expressive of the views of the Supreme Court, are decisive of the case before us." (Italics ours.)

The case of *Tilghman vs. Werk* (39 Fed., p. 680), is, we submit, an exact precedent for the present case. That case was a patent case in which the defendant won in the Court of Appeals; the Court in making its decision following the decision of this

Court in *Mitchell vs. Tilghman*, 19 Wall., 287, holding the plaintiff's patent to be invalid. Subsequently in the case of *Tilghman vs. Proctor*, (102 U. S., 707), this Court changed its views of the same patent, holding it to be valid. On the basis of the decision in *Tilghman vs. Proctor*, it was sought to obtain a bill of review in *Tilghman vs. Werk*. Judge Jackson (afterwards Justice Jackson), denying the application for a bill of review, said (p. 682):

"This last decision of holding of the Supreme Court, it is claimed for petitioner, constitutes new matter *in pais* occurring since the decree, and furnished a good ground for sustaining the petition as a bill of review."

Mr. Justice Jackson then said (p. 682):

"While the suits against respondents and against Proctor and Gamble were founded upon the same patent, it is not alleged in the petition that they had any connection with each other; they were separate and independent suits. Their only connection with each other rested in and upon the alleged agreement or understanding of counsel that *Tilghman vs. Werk* should await the result of *Tilghman vs. Proctor*. While the decision of the Supreme Court in *Mitchell vs. Tilghman* may have been the real ground on which this court bases its decree of April 9, 1878, that fact does not appear upon the face of the decree, and the question is presented whether a change of its ruling or decision by the Supreme Court on a question of law or fact, or upon a mixed question of law and fact, constitutes such new matter as will sustain a bill of review to vacate decrees of the Circuit Court pronounced before such change was made. We think, upon principle and authority, this proposition cannot be maintained. The cases cited and relied

on by counsel for complainant do not, in our opinion, sustain his contention. Such a rule would prolong litigation greatly, and render judicial decisions unstable in the highest degree. The weight of authority, as shown in the cases cited by counsel for respondents, is against this position of complainant's counsel."

The Court then discussed the alleged agreement to suspend action until *Tilghman vs. Proctor* could be decided, and held that the petitioner had not shown proper diligence to secure and preserve his remedy by appeal. The Court then said (pp. 683, 684):

"The application of complainant, made April 11, 1889, for leave to file bill of review herein should be refused. The only new or additional matter presented in the bill of review now asked to be filed is the alleged connection of respondent Werk with the suit against Proctor and Gamble. It is alleged that said Werk, and his counsel Collier, instigated that suit, or rather Proctor and Gamble's infringement of complainant's patent and the denial of his rights, and indemnified them in resisting complainant's claims. The affidavits of Werk and Collier, the parties implicated in said charge, fully met and explained the same, and show that the allegation is not well founded. But, aside from that, this connection of Werk and Collier with the Proctor and Gamble suit, and the defense thereof, was known to complainant as early as 1881. It is now too late for him to rely upon that alleged fact. He is repelled by his *laches* from invoking any relief on that ground, even if it were otherwise a good ground. All other matters set out in the bill of review now sought to be filed are the same as those presented in and by the petition filed in 1881, and already noticed and disposed of.

Leave to file said bill of review is accordingly denied, with costs of the motion."

It will be noted that the precise question here involved arose in that case, since the Court, in the first of the above quotations, said:

"The question is presented whether a change of its ruling or decision by the Supreme Court on a question of law or fact, or upon a mixed question of law and fact, constitutes such new matter as will sustain a bill of review to vacate decrees of the Circuit Court pronounced before such change was made."

Judge Jackson answered this question in the negative. Moreover, his decision was cited with approval by this Court in the recent case of *Scotten vs. Littlefield*, 235 U. S., 407, which also forms a complete precedent for the present case.

In the *Scotten vs. Littlefield* case the decisions of the District Court and the United States Circuit Court of Appeals for the Second Circuit appear in 213 Fed. Rep., pp. 701-5, under the title "*In re Brown et al.*" and "*In re A. O. Brown & Co.*"

In that case, the facts were as follows:

The firm of Brown & Co. was in bankruptcy. Scotten filed a claim for reclamation of certain shares of stock which the bankrupts had held as security. The special master denied the petition, and his decision was affirmed by the District Court. An appeal was then taken to the Court of Appeals for the Second Circuit, alleging error of the District Court in holding that the petitioners had not sufficiently traced and identified their property. The Court of Appeals affirmed the District Court (193 Fed., 34); and this Court affirmed the Court of Appeals (226 U. S., 110).

In a separate proceeding one Gorman raised a similar claim with reference to other shares of stock. This was denied by the lower tribunals, and their decision was affirmed by the Court of Appeals for the Second Circuit on the ground that the claimant had not sufficiently identified his stock (184 Fed., 454). From that decision an appeal was taken to this Court which held that there *was* sufficient proof of identity of the stock and reversed the decisions of the lower tribunals. (*Gorman vs. Littlefield*, 229 U. S., 49.)

The claimants in the *Scotten* case then filed a bill of review, alleging that if the rule enunciated in the *Gorman* case had been applied in their case, their claim would be held proved.

The motion for leave to file was denied.

In the Appellate decision (213 Fed., 705), the Court of Appeals, Second Circuit, by Judge Lacombe, affirming Judge Hand, recited the facts in the *Gorman* case, in which the Court of Appeals was reversed by this Court, and stated that:

"It is the theory of these claimants that if the rule enunciated in *Gorman vs. Littlefield* had been applied to the facts in their cases it would have been held that as to their steel stock identity had been proved. They therefore bring this bill of review which in substance and effect prays for a retrial of their respective claims."

The case was then taken to this Court, and we quote from its decision in *Scotten vs. Littlefield*, 235 U. S., 407, as follows (p. 410):

"Both courts below put their decisions on the ground that the appeal to the Circuit Court of Appeals from the original order of the Dis-

trict Court in the reclamation proceedings really involved the claim for the United States Steel stock in its present aspect, and that if not presented to the Court of Appeals when there on appeal it could not be held back and made the subject of a bill of review, as is now attempted to be done. We think this decision was clearly right. Furthermore, the ground alleged for the bill of review now is, that the principles which determined the disposition of the *German Case*, 229 U. S., 19 (decided May 26, 1913, a little more than two years after the decree in the District Court), reversing the Circuit Court of Appeals in the same case, 175 Fed. Rep., 769, would, had they been applied in this case, have required a different result in the District Court in dealing with the original petition in reclamation, so far as the three hundred shares of the United States Steel stock, pledged with the Hanover National Bank, are concerned.

Bills of review are on two grounds: first, error of law apparent on the face of the record without further examination of matters of fact; second, new facts discovered since the decree, which should materially affect the decree and probably induce a different result. *2 Bates' Federal Equity Procedure*, 762; *Street's Federal Equity Practice*, Vol. 2, 2151.

If the decision in the *German case* would have required a different result if the principles upon which it was decided had been applied in the original proceeding, which we do not find it necessary to decide, *such subsequent decision will not lay the foundation for a bill of review for error of law apparent, or for new matter in pais discovered since the decree, and probably requiring a different result.* *Tilghman vs. Werk*, 39 Fed., 680 (opinion by Judge Jackson, afterwards Mr. Justice Jackson of this court); *Hoffman vs. Knorr*, Circuit Court of Appeals, Fourth Circuit, 50 Fed., 181,

491 (opinion by Chief Justice Fuller). The decree of the Circuit Court of Appeals is affirmed." (Italics ours.)

In this decision, therefore, this Court unequivocally holds that a subsequent contrary decision of this Court will not lay a foundation for a bill of review, either for error of law apparent, or for new matter. This Court also specifically approved *Tilghman vs. Werk, supra*.

In the case of *Hoffman vs. Knorr*, 50 Fed., 484 (cited in *Scotten vs. Littlefield*), the Court held that where a decree fixes the priority claims against an insolvent corporation under the authority of an act of a State Legislature, the question of the validity of the act not being raised at the time, a bill of review will not lie for apparent error, because the act is subsequently adjudged unconstitutional and void by the state Courts on the ground of a defective title and although such a decision is usually as conclusive as a ruling of the Supreme Court itself. This decision was written by Chief Justice Fuller of the Supreme Court when he was sitting in the Court of Appeals for the Fourth Circuit.

Mr. Justice Fuller said (p. 491):

"Undoubtedly the courts of the United States, as a general rule, properly follow the construction placed upon the constitution or laws of a state by the decisions of its highest tribunal, unless they conflict with or impair the efficacy of some provision of the federal constitution or a federal statute or a rule of general commercial law (*Gormley vs. Clark*, 134 U. S., 328, 348, 10 Sup. Ct. Rep., 554); but this rule cannot be applied where the construction contended for has not been announced

at the time of the final adjudication by the United States Court, so as to make the latter erroneous on its face by relation. On the other hand, we cannot find that these bondholders raised any question whatever as to the validity of these laws, but on the contrary, the exceptions they filed were directed to throwing out particular claims as not within the terms of the statutes, or claims in whole or in part as barred thereunder. It is a general rule that a bill of review will not lie to impeach a consent decree. *Thompson vs. Maxwell*, 95 U. S., 391. And if these complainants chose to acquiesce in the allowance of these claims under these statutes, they had a perfect right to do so, but ought not now to be allowed, in view of a decision rendered eighteen months after this decree, to say that error was committed in particulars which they waived by their conduct. They could not approbate and reprobate at the same time, and, in the interest of the stability of judicial decision, their want of diligence ought to be held fatal to their application."

* * * * *

"It does not appear that these complainants had performed the previous decree when their bill of review was permitted to be filed. On the contrary, they objected that the second payment then due might be disbursed under the prior decree, and it would be impossible for them to reconp. Nor did they ask that the sale be set aside, nor in any manner offer to place these creditors in the same situation that they occupied before that decree was entered; but, after having proceeded upon the theory of the validity of these laws, they came forward with their bill of review to obtain a reversal of so much of the decrees as was opposed to their interests, leaving what was made in their favor to stand. We are of the opinion that they were called upon to present their conten-

tion before, if they intended to insist upon it. Cases are not to be tried by piecemeal, and it would open a wide door to persistent litigation if parties should be permitted to lie back, and then renew controversies in this manner.

The decrees of the circuit court appealed from are reversed, and the cause remanded, with a direction to dismiss the petition for rehearing or bill of review, and for further proceedings upon the basis of the finality of the decrees of September 8 and October 14, 1887, in conformity to this opinion."

To the same effect is *King vs. Dunder Mortgage & Trust Investment Co.*, 28 Fed., 33, where the syllabus says:

"A decree of the United States Circuit Court will not be reversed, on a bill of review therein, because in the meantime the state court has put a construction on a clause of the state constitution contrary to that of the circuit court in making said decree."

See also *Hill vs. Phelps*, 101 Fed., 650, and *Dowgiac vs. McSherry Manufacturing Co.*, 155 Fed., 524, citing *Hill vs. Phelps*, etc.

The State Courts also follow the same principles in refusing to re-open a previously tried suit because of a subsequent contrary decision in another case. In the case of *Miller vs. Tyler*, 58 N. Y. 477, 480, the Court said:

"By the consent, or, which is the equivalent of a consent, by the default of the appellants and their voluntary act in omitting to oppose the motion, the judgment was modified so as to entitle the plaintiffs to coin at their option, instead of legal tender notes, in payment of the mortgage debt. This was in conformity to the legal rights of the parties, as then well understood, and as they had been adjudicated by the

highest court of the nation. The reconsideration of the question by the Supreme Court of the United States, with a result adverse to its first judgment, did not affect the existing judgments of State courts, or call for a modification and change of their records to meet the changed views and judgment of that court. A contrary doctrine would lead to the absurd necessity of correcting and modifying all judgments, whether existing and in force or satisfied and fully executed, upon the annunciation by a court of superior authority of a doctrine in conflict with and legally subversive of the principles upon which they were rendered."

In *Harburg vs. Arnold*, 87 Missouri Appeal Reports, 328-329, the Court said:

"But if anything further may be said in order to put the question beyond dispute, it is: that there must be an end to litigation, and that when a litigant has once been heard in the trial court, judgment rendered against him, and appeal had to the highest court under the organic law of the land to which he may go, and that judgment fully, in all essentials, affirmed, he cannot be permitted to renew his contention under the specious plea that the constitutional right which the appellate court was bound to follow committed an error in the first place."

The petitioner tries to distinguish from the above cases by the specious argument that in the case at bar there was error *ab initio* in the original decree of the Third Circuit Court of Appeals, whereas in the cited cases the original decrees were correct and were afterwards made erroneous by subsequent controlling decisions. The fallacy of this argument is apparent. If the reasoning applied by the petitioner to this case is applied to the cited cases, it would seem that the original decrees in the cited

cases would have to be considered erroneous. If the second decision of this Court in the *Tilghman vs. Proctor* case was correct, then the previous decision in the *Mitchell vs. Tilghman* was wrong and was wrong *ab initio*. In the case of *Hoffman vs. Kaur* the statute was unconstitutional from the beginning. The decision of the Court did not make a constitutional statute unconstitutional, but merely declared its unconstitutionality.

These cases are on all fours with the present case in holding that a subsequent contrary decision in another suit is not a ground for a bill of review to bring back and re-try a previously-acquitted defendant upon the same charge.

We submit that the authorities are decisive upon the question here presented, and that the Court of Appeals was correct in stating it was following the decisions made or approved by this Court. We have been unable to find any case, and we believe no case exists, wherein a defendant in a case in tort having first been absolved by a final decree, has been subsequently brought back into court and held under the same charge.

While the petition to this Court alleges that the bill of review is based on an *error of law* appearing on the face of the decree of January 5, 1916, an examination of the bill of review shows that it contains no allegation of error of law. On the contrary, the bill of review recites as its sole basis "that new facts have arisen since said decree was entered" (Paragraph 6, Tr. p. 19). The petitioner's shift to another theory now is virtually an admission that the "new facts" so alleged in the bill of review are not a proper basis therefor.

3. The situation here is not an anomalous one.

The petitioner seems to contend that the situation in this case is an anomalous one and that the decision of the Third Circuit Court of Appeals is destructive of its rights granted it under the Patent Statutes. As a matter of fact, a similar situation has arisen in a number of reported cases and the Courts have been exceedingly careful to protect the rights of a defendant under a final decree although the effect of it was to deprive the plaintiff of a part of his patent monopoly. The Courts have recognized the rights of a defendant under a final decree holding a patent invalid even where by a subsequent decision by this Court the patent was afterward found to be valid. This is exactly the situation here. In fact the present position is one that is inevitable in our patent system, and is one that is well recognized where there have been conflicting decisions in different circuits. We need only refer to a few reported instances:

In the celebrated *Rubber Tire Case*, the decision of the Court of Appeals for the 6th Circuit in the *Goodyear Case* holding the patent in suit invalid had become final. In the subsequent litigation in the New York Circuit, which resulted in the same patent being sustained by the Circuit Court of Appeals and this decision being affirmed by this Court on *certiorari*, it was expressly recognized by the Courts that no decree which these Courts might make could affect the tires manufactured and sold by the Goodyear Tire & Rubber Company, as the decree releasing that Company had become final. Thus, in the suit of *Consolidated Rubber Tire Company vs. Diamond Rubber Company*, which in-

volved that patent, the Court of Appeals for the Second Circuit, in reviewing an order for preliminary injunction, approved the action of the lower court in causing the following paragraph to be inserted in the injunction order:

"Nothing in this injunction order shall prevent, or is intended to prevent or enjoin, the defendant from handling, using, or selling rubber tires and rims covered by the Grant patent, * * * manufactured by the Goodyear Tire & Rubber Company, having a right to manufacture, use and sell such tires under a judicial decree in a litigation in the federal courts in the District of Indiana heretofore pending between this complainant and such parties, wherein it has been judicially determined that said Grant patent is invalid and void." (*Consolidated Rubber & Tire Company vs. Diamond Rubber Company*, 157 Fed., 677, 680.)

When the case again came before the Court of Appeals for the Second Circuit on appeal from final hearing, the same clause was again approved in the decree. On rehearing, the Court of Appeals ordered the decree amended to include the following:

"Nothing in this injunction shall prevent or is intended to prevent, or enjoin this defendant from handling, using and selling rubber tires and rims covered by the Grant patent, manufactured by the Goodyear Tire & Rubber Company, having a right to manufacture, use and sell such tires under a judicial decree in the federal courts of the Sixth Circuit; or manufactured by the Kokomo Rubber Company, having a right to manufacture, sell and use such tires under a judicial decree in the district of Indiana, Seventh Circuit; or manufactured by the Victor Rubber Tire Company,

under a judicial decree in a litigation in the federal courts in the Sixth Circuit, wherein in such litigations it has been judicially determined that the said Grant patent is invalid and void." (*Consolidated Rubber Tire Co. et al. vs. Diamond Rubber Co.*, 162 Fed., 892-895.)

The Court in thus limiting these decrees followed the decision of the Supreme Court of the United States in *Kessler vs. Eldred*, 206 U. S., 285. In that case, Eldred, who owned a patent, sued Kessler, a manufacturer of electric cigar lighters, in the District of Indiana. Non-infringement was found and the bill dismissed. That decision became final. Afterwards Eldred brought suit against another Kirkland, manufacturer of similar devices, in the Western District of New York, and prevailed in the Circuit Court of Appeals for that Circuit. Eldred then sued Breitweiser, a user of Kessler lighters in the same New York District. During the pendency of the last named suit, Kessler filed a bill in the Northern District of Illinois, in which he prayed an injunction against Eldred to enjoin him from prosecuting any suit against any one for alleged infringement of the patent by purchase, use or sale of any cigar lighter manufactured by Kessler and identical with the lighter in evidence before the Court in the first suit. This Court held that the *original judgment conclusively settled the right of Kessler to manufacture and sell his manufactures free from all interference by Eldred by virtue of the patent there adjudicated, and granted the relief prayed for.*

In the *Rubber Tire case*, it will be seen that, notwithstanding the patent had been declared valid by this Court, the Courts refused to disturb the

original judgment in favor of Goodyear and others in the Sixth Circuit.

In the *Kessler case*, notwithstanding the patent had been found valid and infringed by the same device in the Second Circuit, this Court expressly held that Kessler and all his customers were *forever freed* from disturbance under this patent, by reason of the final decree in the first suit against Kessler.

We submit that the only difference, if any, between the present case and these cases just referred to consists only in the fact that the decree against this present defendant was not, *as a whole*, final; although it *was final* insofar as the validity and infringement of the patent in suit was concerned. The only issue as to which it was not final is that of unfair competition, in which an accounting was ordered. The accounting questions, however, were the only questions open in this case.

The case originally involved two branches, one for the infringement of the Baldwin patent and the other for unfair competition in the sale of the defendant's miners' lamps. These two branches of the case were severable and independent of each other.

The decree dismissing the bill as to the patent completely and finally disposed of the patent infringement branch of the suit. No further judicial action as to the patent was required. Neither was there any further question reserved as to the patent.

As stated by Blackstone (3 Black. Comm. 398) :

"Final judgments are such as at once put an end to the actions, by declaring that the plain-

tiff has either entitled himself, or has not, to recover the remedy he sues for."

The finality of a decree as to the matters finally determined by it is not affected by the fact that there may be a further *severable* matter left to be determined. *Hill vs. Chicago and Evanston Railroad Co.*, 110 U. S. 52.

4. The plaintiffs are debarred by their own acts from filing a bill-of-review if a proper basis therefor ever existed.

The Court of Appeals for the Third Circuit based its decision mainly upon the ground, that the subsequent decision of this Court in the *Abercrombie & Fitch case*, sustaining the Baldwin patent, was not a basis for a bill-of-review to upset the decree previously entered in the case against the present defendant, The Grier Brothers Company.

The bill-of-review in this case was carefully considered by the Court of Appeals. It was, of course, addressed to the sound discretion of that court. After full consideration, that Court found that the circumstances of this case were such that it would be most inequitable to grant the petitioner the relief prayed for in said bill. The Court of Appeals further found that the situation of which the petitioner complains was largely of its own making, and that the doctrine of equitable estoppel applied against the petitioner. The bill-of-review being addressed to the equitable discretion of the Court of Appeals, its decision thereon manifestly should not be disturbed unless it has abused its equitable discretion. We submit that there is nothing in

its decision which evidences any such abuse; but, on the contrary, that court very carefully considered the equities between the parties hereto, as well as the legal doctrine to be applied, and that its finding that the equities were with the defendant rather than with the petitioner was not only entirely within its discretion but was correct.

The Court of Appeals said (Rec., pp. 88-89.)

"It will be noticed from the recital of the different steps in this litigation, that the situation is one of the plaintiffs' own creation. After the decision of this Court was made but before its mandate went down, the plaintiffs knew of the decision of the District Court in the case in the Second Circuit, but they made no request to this Court to withhold its mandate. After the mandate went down and before, a decree pursuant thereto had been entered in the Court below, they knew of the affirmance of the latter case by the Circuit Court of Appeals of the Second Circuit, and that the two Circuits were in conflict, but they made no requests to either Court in this Circuit to have the entry of a decree withheld. On the contrary, with knowledge that the Supreme Court had on December 29, 1915, under consideration a petition for *certiorari* in the case in Second Circuit, the plaintiffs became the actors in the quiescent case in this Circuit, and without advising the Court of the pendency of the matter in the Supreme Court, they prepared and on their motion had entered on January 5, 1916, the decree of dismissal, and thereafter, when the Supreme Court had on January 10, 1916, granted the *certiorari*, they allowed the term to end without any move to suspend, open or vacate the said decree of January 5, 1916. Under such circumstances, and in view of the fact that the

entry of the decree at once gave them affirmative relief on their cause of action for unfair competition, it is quite manifest that the plaintiffs themselves and of their own motion, and without compulsion from anyone, chose to change the status of the case by themselves causing the decree, of which they afterwards complained, to be entered. At the time they prepared and had the decree entered, they knew the situation was one where they were making possible the bringing about of just such a situation as they now complain of. Such being the facts, the plaintiffs themselves, by their own course, brought about this situation. We start with the fact that if seeming hardship ensues, the plaintiffs and not the law have brought it on themselves."

And again (Rec., pp. 89-90):

"Nor must we be misled by the at first sight seemingly grave situation of a patentee whose patent has in one Circuit been adjudged valid by the Supreme Court, at the same time adjudged invalid by a Circuit Court of Appeals in another Circuit. For such a situation is not one either created by law but wholly by the plaintiffs not availing themselves of the opportunity the law afforded them of preventing it. For, when the Circuit Court of Appeals of the Second Circuit held this patent valid and infringed, and there was a conflict of decision between two Circuit Courts of Appeals, such situation gave the plaintiffs reasonable ground for applying to the Supreme Court for a *certiorari* to review the adverse decree of this Court. We do not say the plaintiffs were bound to do so; we only say they could have so petitioned, and if an anomalous situation has arisen it is not because the law created it, nor is it a fault of our patent system, but it is one that might have been avoided by acts of commission or omission of the plain-

tiffs, (a) in petitioning the Supreme Court for a *certiorari* of the Third Circuit case, when on November 9th, 1915, the Circuit Court of Appeals of the Second Circuit held the patent valid and infringed; (b) by applying to the Circuit Court of Appeals of the Third Circuit, when on December 20th, 1915, the Supreme Court was petitioned for a writ of *certiorari*, to withhold entry of its decree pending action by the Supreme Court; and (c) by the plaintiffs abstaining from entering the decree of dismissal in the lower Court until the Supreme Court acted."

Plaintiffs made no attempt to petition for a writ of *certiorari* after the former decision of ~~the~~ ^{the} Court in January, 1915. The mandate of ~~the~~ ^{the} Court ^{of Appeals} was filed in the lower Court February 24, 1915. Plaintiffs made no move to even enter a decree on the mandate until January 5, 1916,—nearly eleven months after the mandate was filed.

In the *Abercrombie and Fitch* case, it was the defendant who took the petition which resulted in the case being considered and decided by the Supreme Court. If the defendant in that case had not taken it to the Supreme Court, the ground upon which the bill of review herein is founded would not have existed. In other words, it is through no merit of the plaintiffs that the condition which the plaintiffs now rely upon exists.

In *Scotten vs. Littlefield*, *supra*, the District Court in commenting upon claimant's failure to appeal said (213 Fed., 763):

"It is true they felt bound by the decision of the Circuit Court of Appeals, but an appeal to the Supreme Court was as open to them in this case, as it was in Gorman's."

The bill of review was filed April, 1918, more than two years after the decree on the mandate. That decree was final, in so far as the issue of infringement is concerned; the only question left undetermined in the case being the amount to be paid by defendant under the issue of unfair competition. This was a separate and distinct issue, no appeal as to which could possibly again raise the question of infringement.

Counsel for petition is in error in the statement contained on page 19 of its brief that a writ of *certiorari* could not have been applied for in this case until a decree on the mandate in the Court of Appeals for the Third Circuit had been entered. The present statute requires a petition for a writ of *certiorari* to be presented within ninety days from the decision complained of; and it is the practice in some of the Court of Appeals, at least, to stay its mandate pending the outcome of a *certiorari* petition. In fact, according to the present record, petitioner filed its application for this writ before the mandate of the Court of Appeals was sent down.

5. In no event can defendant be held for profits and damages prior to the decree of November 7, 1919.

The decree of the District Court, which was reversed by the Court of Appeals in the decision upon which petition was taken, contained no limitation as to the accounting period, but required a full accounting by the defendants of all profits and damages (Tr., p. 44).

By this proceeding, the petitioner seeks to give effect to said decree.

The decree of January 5, 1916, which dismissed the bill of complaint on the issue of patent infringement was, we submit, clearly the law of the case between the parties, at least until some proceedings were instituted to have it set aside. If the patent in suit could ever again have any force against this respondent, after the said decree of January 5, 1916, it could only be by reason of a further decree; and any liability of this defendant must necessarily begin with the entry of the new decree, namely the decree of November 7, 1919.

It is, we submit, inequitable beyond belief that this defendant can now be made to account for doing that which under the mandate of the Court of Appeals of the Third Circuit it was expressly authorized and permitted to do during the entire period in question.

The District Court was originally of this opinion, since in its opinion, it stated (Tr., pp. 42-43).

"Plaintiffs are entitled also to an accounting for such infringement, *but such accounting should be limited so that it should not antedate the date of the filing of the bill of review*, for the decision of the Court of Appeals for the Third Circuit was the law of the case between the parties, at least until proceedings were instituted to have it set aside."

In the supplemental opinion (Tr., p. 43) the District Court, however, changed its views and held that upon the vacation of the original decree:

"The parties must be held to be in the same position in which they would have been had

the original decree not been founded upon error, but had been in terms like the decree now to be entered."

The District Court therefore entered its decree of November 7th, 1919, without any limitation as to the accounting period.

It has been repeatedly held by the authorities that a bill of review is not to be considered as a continuance of the former bill, but is in the nature of an original bill.

Thus, in *Home St. Ry. Co. vs. City of Lincoln*, 162 Fed., 133, 138, the Court said (p. 138):

"A bill of review is not considered as a continuance of the former bill, but in the nature of an original bill. It prays for process, and an appearance to it is enforced in the same manner as to an original bill. *Story, Eq. Pl.* (9th Ed.), 383, 403; *2 Dan. Ch. Pr.* (6th Am. Ed.), 1575; *3 Dan. Ch. Pr.* (6th Am. Ed.), 2065; *2 Hoff. Ch. Pr.*, 10; *Lube Eq. Pl.* (Rapalje Ed.), 283; *Fletcher Eq. Pl.*, 919, 934, 941; *Curtis Eq. Proc.* (4th Ed.), 124; *2 Bates Fed. Eq. Pro.*, 711, page 764; *1 Foster Fed. Pr.*, 356; *Cole vs. Miller*, 32 Miss., 89, 101; *Webb vs. Pell*, 1 Paige (N. Y.), 564; *Heermans vs. Montague* (Va.), 20 S. E., 899, 902."

The District Court considered the defendant's situation in this case comparable to that of a party who relies upon the decision of a lower court, which is subsequently reversed by an appellate court. The District Court said (Rec., p. 43):

"Reliance upon a decree of a lower court which is subsequently reversed by the Appellate Court has not been held to save the party so relying from the consequences of a reversal by the Appellate Court. And so with proceedings by bill of review."

We submit that the District Court here was attempting to compare two entirely dissimilar things. In the case supposed by the District Court, the proceedings are all in the same case, and naturally no party to a cause would be justified in relying upon the decision of a lower court from which an appeal had been taken to an appellate tribunal. In the present case, however, the proceedings which gave rise to this bill of review were had in an entirely separate case, to which this defendant was not a party and as to which this defendant had no notice nor was under any obligation to take notice.

The case of a defendant is a hard one, indeed, if after a final decree in his favor by the highest court of his jurisdiction he must take notice of all proceedings which may arise in any of the nine circuits of the United States, and cease operations during their pendency, in order to escape the possibility of a condition such as has arisen in this case. If such is the law, patents, instead of stimulating manufacture, will have precisely the opposite effect.

Counsel for petitioner, in support of his contention that the accounting must cover the entire infringing period, likens the case to an action between A and B as to ownership of a building, in which a court of last resort found the title in A and subsequently, on a bill of review, reverses its former judgment and finds the title in B. He argues that A would be liable to repayment to B of the profits received by A under the first decision. Counsel for petitioner, however, ignores the fact that in the present case, if the original decision had been in favor of the plaintiff, the defendant would thereupon have ceased the acts complained of, and no

profits or damages would thereafter have arisen. In the supposed case, A has simply retained the land and received its income. In the present case, however, respondent has been authorized and permitted by decree of the court to continue to build up its business and thereby, under petitioner's contention, to increase its liabilities. Petitioner's contention is that the defendant must now be penalized for doing that which the Court of Appeals authorized and permitted it to do. Assuredly, when the Court of Appeals ordered the bill against this respondent to be dismissed, and petitioner pursuant thereto itself dismissed the bill as to patent infringement, the respondent had every right to continue its manufacture; and we submit that no court of equity should penalize the respondent for so doing, as the entire question of profits and damages is one which is largely within the discretion of the Court. As found by the Court of Appeals, the present situation is one for which the plaintiff is itself responsible; and as between the parties the greater equities are clearly with the respondent. The plaintiff, by dismissing the bill as to patent infringement, led the respondent to believe that this question was finally settled, and that respondent had every right to proceed with his manufacture. Plaintiff, by its own acts, is therefore estopped to mulct respondent for doing that which in effect it authorized respondent to do. Instead, therefore, of taking from petitioner and turning over to respondent the profits which have accrued because of infringement, as it alleges, the petitioner is seeking recovery from the defendant of alleged profits which would not have accrued if the bill had not been dismissed as to patent infringement.

Petitioner's Authorities.

National Brake & Electric Co. vs. Neils Christensen and Allis-Chalmers Co. (U. S. Sup. Ct. Adv. Op., Feb. 1, 1921, p. 188):

Petitioner relies mainly on this case, which has been decided since the issue of this writ. The situation, however, in the present case and that in the cited case are directly opposed. In the cited case, the *defendant* filed a bill of review seeking to give effect to a final decree in another suit to which it alleged it was privy. This court reversed the decree of the Circuit Court of Appeals for the Seventh Circuit, dismissing the bill, and held that the bill was addressed to the sound discretion of the appellate tribunal, and should be decided from considerations "*addressed to the materiality of the new matter and diligence in its presentation.*" As we understand it, the whole ground of the decision in the cited case was, that the Court of Appeals erred in its holding that the decree in question was a final one, and in refusing to permit the bill of review to be filed. This Court expressly stated that it did not pass upon the merits of the bill of review, but left that to be passed upon by the lower court.

In the present case, the Court of Appeals for the Third Circuit followed exactly the practice which this Court held the proper one in the cited case. It directed the District Court to receive the bill of review and pass upon its merits. This was done, and upon appeal the Court of Appeals considered the bill on its merits and ordered its dismissal. The decision of the Court of Appeals for the Third Circuit herein complained of is therefore not contrary

to the decision of this Court in the cited case, as alleged by the petitioner, but is directly in accord therewith in all respects.

Furthermore, in the cited case, one of the issues of the bill of review was the privity of the defendant therein with the defendant in a case in another circuit. In the instant case, there is and can be no question of privity, as the defendant herein has absolutely no connection with the defendant in the *Abercrombie and Fitch* case.

Another important distinction between the cited case and the instant case is that in the former the bill of review was filed by the *defendant*, which had previously been adjudged to infringe, in an attempt to avail itself of the adjudged invalidity of the patent. As we have elsewhere shown, no case has been found, and no case is cited by the petitioner, in which a defendant has ever by a bill of review been brought back into court after a final decree in his favor and compelled to submit himself to an accounting for his actions under such decree. We believe that there is a vital distinction in law between the position of the present defendant and that presented by the usual bill of review.

Henry vs. Dick Co., 244 U. S., 651:

Counsel for petitioner argues that the decision herein complained of is contrary to the practice authorized by this court in the above case.

In the original *Henry vs. Dick* case (224 U. S., 1), the defendant, Henry, was held to be guilty of contributory infringement and a decree and injunction were entered by the plaintiff against him. The defendant, who later brought the bill of review

against this decree, did not enter the decree of his own volition, but as a defeated party was compelled to accept it. In the case at bar, the present petitioners had entered the decree which they now attempt to upset by a bill of review, and as we above pointed out, they had this decree entered at the very time when the defendant in another suit had a petition for *certiorari* pending before this Court on the same patent.

Moreover, in the case of *Henry vs. Dick* (244 U. S., 651), cited in the petition, the facts were precisely the reverse from those which exist here. In that case the defendant was under perpetual injunction not to do a thing which all other persons could lawfully do after the decision in the original case of *Henry vs. Dick* (224 U. S., 1) had been overruled by this Court in the case of *Motion Picture Patents Co. vs. Universal Film Co.* (242 U. S., 502). This Court in granting the motion for leave to file the bill of review took an opportunity to correct that peculiar and anomalous situation. In the present case, however, the defendant has been cleared of the charge against him by the plaintiffs entering the decree dismissing the bill as to the patent infringement. Defendant is, therefore, forever, immune. The case of *Henry vs. Dick* is in line with other cases in which a *defendant* in view of newly discovered evidence has been permitted to file a bill of review for his relief. As above stated, however, we find no case in which plaintiff has been permitted to file a bill of review, the effect of which would be to bring the defendant back into Court and hold it for the very offense of which it has been acquitted.

The situation of the present defendant is not an

anomalous situation as was that of the defendant Henry in the *Henry vs. Dick* litigation. When a defendant has been charged with a *tort* and tried and cleared, he cannot again be attacked on the *same* charge. The principle of *autrefois acquit*, applicable to criminal cases, applies in a situation like the present one.

Omaha Electric Light Co. vs. City of Omaha, 216 Fed., 848:

In the Omaha case (216 Fed., 848), a suit was brought by the Omaha Electric Light Company to enjoin the City of Omaha from interference with its power transmitting wires. The Court of Appeals for the Eighth Circuit held that the plaintiff's franchise had expired and refused to interfere with the action of the City. An appeal to this Court was dismissed because this Court held that no federal question had been raised. The Old Colony Trust Company, trustee under a mortgage of the Electric Light Company's property, brought suit against the City for the same purpose. The Court of Appeals again held that the franchise had expired and dismissed the bill. The case then went to this Court which reversed the Court of Appeals.

The Court of Appeals stayed its mandate in the first case, awaiting the decision of this Court in the second case. After the decision of this Court, the Court of Appeals vacated its decree in the first case.

This case is not in conflict with the present case because in the Omaha case the second bill was against the *same defendant under the identical question of its franchise and the Court of Appeals had stayed its mandate in the first case awaiting*

this Court's decision in the second case. The Court of Appeals specifically held that it could not and would not have considered the bill of review (treated as a petition for rehearing) except for said stay. After reviewing the authorities, the Court said (p. 855) :

"To be sure, the object we had in mind at the time of staying the mandate was to await the action of the Supreme Court. Our jurisdiction, however, was not confined to such intention. So long as we retained the case, it was subject to our full appellate power, including the correction of our decree.

The case is, therefore, still pending in this Court. * * * We entered our stay for the purpose of determining what mandate should be issued."

The Court of Appeals then proceeded to say that inasmuch as *during the stay of its mandate*, this Court had rendered its decision, it was therefore clearly its duty to then issue its stayed mandate in harmony with the decree and mandate of this Court (p. 856).

In the present litigation, the decision of this Court sustaining the patent was in another case involving an entirely different defendant and to which the present respondent was not a party. Furthermore, the mandate of the Court of Appeals for the Third Circuit had issued and the present petitioner had had entered in the lower Court pursuant thereto its decree which was final so far as the patent is concerned.

It is clear, therefore, that the decision of the Third Circuit Court of Appeals herein complained of is in no way in conflict with the decision of the Eighth Circuit Court of Appeals in the Omaha case.

Other Erroneous Positions of Petitioner.

On page 15 of its brief therein, the petitioner contends that the Court of Appeals erred in holding the decree in *Baldwin vs. Grier* herein involved, to be a consent decree. We do not understand that the Court of Appeals based its decision on any such finding. The Court of Appeals called attention to the fact that the decree was entered on the motion of petitioner's counsel and that "it would seem that there is substantial ground for contending that when the plaintiffs themselves took the matter into their own hands and themselves prepared, moved, and had entered the decree which dismissed their patent bill, such voluntary action on their part in entering the decree in favor of their adversary was not only in form but in substance, and by a positive act on their part a consent, and, so far as they were concerned, a consent decree."

This we do not understand to be a positive finding, and in the following paragraph the Court of Appeals immediately passes this question by. The Court of Appeals undoubtedly did consider this act of the petitioner as having a bearing on the equities of the case, but its decision is certainly not based on any such particular finding.

The plaintiffs caused the decree of January 5, 1916, to be entered at the very time the writ of *certiorari* in the *Abercrombie and Fitch* case was pending in this court, that petition having been filed December 20, 1915, and granted January 10, 1916. Manifestly, it had the decree entered at that time, in order to avail itself of the benefit of that

part of the decree in its favor, to wit, the provision for an accounting on the issue of unfair competition. Before entering this decree, the petitioner had waited nearly a year after the mandate of the Court of Appeals. There was no obligation upon the petitioner to enter the January 5, 1916, decree at that particular time, when it knew that the defendant's petition for writ of *certiorari* to this Court had been submitted and would shortly be acted upon. It is clear, therefore, that the petitioner at that time deliberately chose to terminate the proceedings with respect to patent infringement and to proceed with its accounting on the issue of unfair competition. The petitioner is therefore precisely in the situation condemned by Justice Fuller in the case of *Hoffman vs. Knox, supra*, in which he said (p. 191):

"And if these complainants chose to acquiesce in the allowance of these claims under these statutes, they had a perfect right to do so, but ought not now to be allowed, in view of a decision rendered eighteen months after this decree, to say that error was committed in particulars which they waived by their conduct. *They could not approbate and reprobate at the same time*, and in the interest of the stability of judicial decision, their want of diligence ought to be held fatal to their application." (Italics ours.)

On page 17 of its brief, the petitioner states that the Court of Appeals "recognizes the inequities created by its decision." We do not find this in the Court's opinion. On the contrary, the Court clearly finds that the complainants have no cause for complaint since the situation is one of their own creation. The petitioner also attempts to excuse its

failure to take any of the steps which the Court of Appeals suggested it might have taken, by speculations as to what the Court of Appeals might or might not have done. That failure, however, is not explained and cannot be explained, as the petitioner made no attempt whatever to prevent the situation which has arisen, but, on the contrary, as above pointed out, expressly created the possibility of the situation by entering the decree of January 5, 1916, without awaiting the decision of this Court on the petition for writ of *certiorari* in the Abercrombie and Fitch case.

On page 19 of the brief, the petitioner argues that "defendant has suffered no injury and the plaintiff has gained no advantage by the course which has been pursued."

This is not a correct statement since, as above pointed out, the defendant, if it must now account, has certainly suffered injury by being led to believe that it could safely follow the decree of January 5, 1916. The defendant cannot now, without additional injury, be placed back to the position it would have occupied on January 5, 1916, had that decree adjudged it to infringe the patent.

On page 35 of its brief, petitioner argues that no change has occurred in the status of the parties since the entry of the original decree, and that there are no facts present which make this bill of review inequitable.

Manifestly, the entry of the decree itself was a change in the status of the parties, since by that decree the bill of complaint was dismissed so far as all questions of patent infringement were con-

cerned. By that decree, the defendant was judicially informed that it might proceed with impunity in the conduct of its business with respect to the patented lamp structures which had been complained of. This status, produced by the entry of the said decree of January 5, 1916, by which the defendant was assured of its position, manifestly continued to exist, to the great peril of this defendant if petitioner's present contentions are correct. Certainly, the defendant could rest upon this fact alone so far as any showing of a change in status was necessary. To now attempt to put defendant back to January 5, 1916, and compel it to account for any profits it may have been induced to make by the decree of that date, is inequitable.

On page 37 of its brief, the petitioner argues that the defendant must have been fully advised of the proceedings in the *Justrite* case, stating that the president and superintendent of the *Justrite* Company testified for defendant. This statement is made off the record. The record which the petitioner has brought to this Court contains no such showing.

Conclusion.

As hereinbefore stated, the effect of allowing the bill of review would be to destroy the stability of judicial decisions for which the Courts have always striven. The Court of Appeals for the Third Circuit in holding that a bill of review did not lie, did not ignore the decision of this Court in the New York litigation and hold that the Baldwin reissue patent is invalid in the Third Circuit with respect to the public at large. The Court of Appeals con-

fined their decision to the rights of the individual litigants under the particular circumstances of this case.

We submit that the Court of Appeals for the Third Circuit was correct in its findings in this case. It followed precisely the principles laid down by this Court in *Scotten vs. Littlefield* and cases therein cited, and applied them to the facts in this case.

The decree dismissing the bill as to the Baldwin patent is final and conclusive, and renders this defendant forever immune.

This defendant stands in the very same position with respect to the Baldwin patent as the Goodyear Tire and Rubber Company stood with respect to the Grant patent in the rubber-tire litigation, and in the same position as Kessler and his customers stood by reason of the final decision in Indiana in his favor in the cigar-lighter litigation.

Respectfully submitted,

C. P. BYRNES,
GEO. H. PARMELEE,
GEO. E. STEBBINS,
for the Respondent.

April 9, 1921.

57
342
No. 932

Office Supreme Court, U.
S. D.

MAY 29 1920

JAMES O. WALKER,
Clerk.

Supreme Court of the United States

OCTOBER TERM, A. D. 1919.

JOHN SIMMONS COMPANY,

Petitioner,

vs.

THE GRIER BROTHERS COMPANY,

Respondent.

On Petition for Writ of Certiorari, directed to the United States Circuit Court of Appeals for the Third Circuit.

BRIEF FOR THE RESPONDENT, THE GRIER BROTHERS COMPANY.

C. P. BYRNES,
GEO. H. PARMELEE,
GEO. E. STEBBINS,

Counsel for Respondent.

INDEX.

	Pages
Statement of the Case	1-5
The Cases cited by Court of Appeals holding a bill of review does not lie, are the law of the case	5-13
A bill of review in present Circumstances would be destructive of the stability of judicial decisions..	13-14
No conflict between decision of Third Circuit Court of Appeals and decision of Eighth Circuit Court of Appeals in Omaha case.....	14-16
Decision of Third Circuit Court of Appeals on bill of review herein not contrary to decision of this Court in Henry vs. Dick.....	16-21
Court of Appeals did not hold decree against which bill was filed was a consent decree.....	21-22
Court of Appeals for Third Circuit correct in holding that decree entered on its mandate was final as to the patent.....	22
Conclusion	22

CASES CITED.

Consolidated Rubber Tire Co. vs. Diamond Rubber Tire Co.—162 Fed. 892	19
Diamond Rubber Tire Co. vs. Consolidated Rubber Tire Co.—212 U. S. 574.....	20
Dowagiac vs. McSherry Manufacturing Co.—155 Fed. 521.....	16
Harburg vs. Arnold—87 Missouri Appeal Rep. 328.....	11
Henry vs. Dick—224 U. S. 1 and 244 U. S. 631.....	16
Hill vs. Phelps—52 Fed. 650.....	10
Hill vs. Chicago & Evanstown Ry. Co.—140 U. S. 52.....	22
Hoffman vs. Knox—50 Fed. 481.....	8
Kessler vs. Eldred—206 U. S. 285.....	17
King vs. Dundee Mortgage & Trust Investment Co.—28 Fed. 33	10
Miller vs. Tyler—58 N. Y. 477, 480.....	10
Omaha Electric Light Co. vs. City of Omaha—216 Fed. 848	14
Rubber Tire Wheel Co. vs. Goodyear Tire & Rubber Co.—187 U. S. 641	20
Rubber Tire Wheel Co. vs. Goodyear Tire & Rubber Co.—214 U. S. 512	20
Scotten vs. Littlefield—235 U. S. 407.....	7
Tilghman vs. Werk—39 Fed. 680.....	6

Supreme Court of the United States

OCTOBER TERM, A. D. 1919.

JOHN SIMMONS COMPANY,
Petitioner,

vs.

THE GRIDER BROTHERS
COMPANY,
Respondent.

On Petition for Writ of Certiorari, directed to the United States Circuit Court of Appeals for the Third Circuit.

Statement of the Case.

There is no conflict between the decision of the Third Circuit Court of Appeals holding that a bill of review did not lie in this case, and any decisions of the other Circuits or of this Court. Neither is there any new or general question of law presented.

The Court of Appeals held that the *specific facts* of the present case did not entitle the petitioner herein to a bill of review. As stated by the Court of Appeals in their opinion (Tr., p. 100), "The question before us is whether, under the facts and circumstances of this case, the bill of review would lie."

The facts in the present case are briefly as follows:

The plaintiff Baldwin had brought suit against one Bleser in Illinois on the original Baldwin patent No. 821,580. In that case the Court of Appeals for the Seventh Circuit, in April 1912, held the patent not infringed by the Bleser Lamp (119 Fed. 133.) Following the authority of the decision of the Seventh Circuit Court of Appeals in the Bleser case, and not until after that decision, the present defendant, The Grier Brothers Company, began the manufacture of its miners' lamps containing the structure complained of.

In February 1913, Baldwin applied for a reissue of his original patent, which reissue, No. 13,541 here involved, was granted on March 11, 1913. Baldwin and John Simmons Company brought the present suit on the reissue on October 4, 1913, joining in the bill of complaint the allegations of infringement of the patent and also of unfair competition. The District Court held the patent infringed and the defendant guilty of unfair competition (215 Fed. 735). Upon appeal, the Court of Appeals for the Third Circuit affirmed the District Court as to unfair competition, but reversed it as to the patent, holding the reissue claim in suit to be invalid (219 Fed. 735).

The opinion of the Third Circuit Court of Appeals was handed down on January 22, 1915, and the mandate was sent down on February 24, 1915. The plaintiffs did nothing in this case for about a year, when on January 5, 1916, the plaintiffs caused to be entered in the lower Court a decree, the sixth paragraph of which was as follows:

"6th. That the bill of complaint herein as

to infringement of reissue letters patent No. 13,542 in suit be and the same hereby is dismissed."

This decree also ordered an accounting for unfair competition.

The plaintiffs by the entry of this decree abandoned their claim of infringement against the defendant and proceeded with an accounting for unfair competition. Except for the accounting on unfair competition the plaintiffs did nothing further in this case until two years later, when on January 26, 1918, they applied to the District Court for leave to file the bill of review against the decree which they had entered dismissing the suit as to the patent.

The circumstances and time of the entry of the decree in the suit against the respondent have a peculiar relationship to the litigation in the Second Circuit involving the same patent;—a relationship which, as found by the Third Circuit Court of Appeals, disentitles the plaintiffs to any equities in their attempted bill of review.

The plaintiffs, Baldwin and John Simmons Company, on May 20th, 1913, filed a bill in the Southern District of New York against third parties, namely, Abercrombie & Fitch Co. and Justrite Mfg. Co. The District Court held the reissue patent valid and infringed (227 Fed. 455), which decision was affirmed by the Second Circuit Court of Appeals on November 9, 1915 (228 Fed. 895). Thereupon the *defendants* in the New York litigation petitioned this Court for a writ of *certiorari* on December 20, 1915. This petition was granted by this Court on January 10, 1916.

It was in this interval between December 20, 1915, and January 10, 1916, that the plaintiffs, the present petitioners, had entered in the present suit against The Grier Brothers Company, the decree dismissing the bill as to infringement of the Baldwin reissue patent. The plaintiffs were fully cognizant that the defendants in the New York suit had the petition for *certiorari* pending before this Court alleging conflicting decisions between the Second and Third Circuits. Nevertheless the plaintiffs of their own volition entered the decree dismissing the bill as to the Baldwin patent against the respondent, The Grier Brothers Company.

Plaintiffs did not file any petition for certiorari in the instant case either at this time or at any time. When they caused the decree to be entered herein, the petition in the New York case was actually pending here. Yet they deliberately chose to and did abandon all rights against the respondent, under the patent, by this deliberate entry of the decree.

Even after this Court granted the petition for *certiorari* in the suit in the Second Circuit, the plaintiffs made no attempt to bring the suit in the Third Circuit before this Court on *certiorari* but accepted the decree which they had entered dismissing the bill as to the Baldwin patent and proceeded with the accounting on the unfair competition branch of the case.

This Court acting upon the writ of *certiorari* in the Second Circuit case, affirmed the Court of Appeals for the Second Circuit (245 U. S. 198). Thereafter, on January 26, 1918, the petitioners made application for leave to file a bill of review to vacate the decree which they had had entered dis-

missing the bill as to the Baldwin patent in the suit against the respondent, The Grier Brothers Company. The District Court granted the prayer of the bill and vacated the decree of January 5, 1916, as to the dismissal of the bill on the question of patent infringement, ordering not only an injunction against the respondent, but also an accounting covering the entire period including the time when the decree dismissing the bill as to the patent was in force.

On appeal, the Court of Appeals for the Third Circuit reversed the District Court and held that a bill of review did not lie in view of the particular facts of this case.

The cases cited by the Court of Appeals in holding that a bill of review does not lie, are the law of the case.

The Court of Appeals in its decision holding that a bill of review did not lie in the present situation referred to the decision of this Court in *Scotten vs. Littlefield*, 235 U. S. 410, and the cases of *Tilghman vs. Werk*, 39 Fed. 680, and *Hoffman vs. Knox*, 50 Fed. 481, therein cited by this Court.

It is well settled that "no bill of review shall be admitted except it contains either error in law appearing in the body of the decree, without further examination of matters of fact, or some new matter which hath arisen on time after the decree" (Lord Bacon's Fourth Ordinance on the law of equity).

These decisions expressly hold that the contrary decision of another Court does not constitute either

error in law appearing in the body of the decree, or some new matter of fact arising after the decree, for the purpose of a bill of review.

The case of *Tilghman vs. Werk*, 39 Fed. 680, quoted with approval by this Court in *Scotton vs. Littlefield*, clearly declares the law controlling this case. That case was a patent case which the defendant won in the Circuit Court, the Court in making its decision following the decision of this Court in *Mitchell vs. Tilghman*, 19 Wallace 287. Subsequently in the case of *Tilghman vs. Proctor*, 102 U. S. 707, this Court changed its views of the same patent. On the basis of the decision in *Tilghman vs. Proctor* it was sought to obtain a bill of review to modify the decree in the *Tilghman vs. Werk* case in conformity thereto. Judge Jackson (afterwards Justice Jackson), denying the application for a bill of review, said (p. 682) :

"The question is presented whether a change of its ruling or decision by the Supreme Court on a question of law or fact, or upon a mixed question of law and fact, constitutes such new matter as will sustain a bill of review to vacate decrees of the Circuit Court pronounced before such change was made. We think, upon principle and authority, this proposition cannot be maintained. The cases cited and relied on by counsel for complainant do not, in our opinion, sustain his contention. Such a rule would prolong litigation greatly, and render judicial decisions unstable in the highest degree. The weight of authority, as shown in the cases cited by counsel for respondents, is against this position of complainant's counsel."

The above decision was quoted with approval in this Court in the recent case of *Scotton vs. Lit-*

Littlefield, 235 U. S. 107. It also forms a complete precedent in the present case.

In the *Scotten vs. Littlefield* case the decisions of the District Court and the United States Circuit Court of Appeals for the Second Circuit appear in 213 Fed. Rep., pp. 701-5, under the title "*In re Brown et al.*," and "*In re A. E. Brown & Co.*"

In that case, the facts were as follows:

The firm of Brown & Co. was in bankruptcy. Scotten filed a claim for reclamation of certain shares of stock which the bankrupts had held as security. The special master denied the petition, and his decision was affirmed by the District Court. An appeal was then taken to the Court of Appeals for the Second Circuit, alleging error of the District Court in holding that the petitioners had not sufficiently traced and identified their property. The Court of Appeals affirmed the District Court (193 Fed. 34); and this Court affirmed the Court of Appeals (226 U. S. 110).

In a separate proceeding one Gorman raised a similar claim with reference to other shares of stock. This was denied by the lower tribunals, and their decision was affirmed by the Court of Appeals for the Second Circuit on the ground that the claimant had not sufficiently identified his stock (184 Fed. 154). From that decision an appeal was taken to this Court which held that there *was* sufficient proof of identity of the stock and reversed the decisions of the lower tribunals. (*Gorman vs. Littlefield*, 229 U. S. 19).

The claimants in the Scotten case then filed a bill of review, alleging that if the rule enunciated

in the Gorman case had been applied in their case, their claim would be held proved.

The motion for leave to file the bill of review was denied by the District Court and by the Court of Appeals for the Second Circuit. The case was then taken to this Court and we quote as follows from its decision (235 U. S. 407-410) :

"Bills of review are on two grounds; first error of law apparent on the face of the record without further examination of matters of fact; second, new facts discovered since the decree, which should materially affect the decree and probably induce a different result. 2 *Bates' Federal Equity Procedure*, 762; *Street's Federal Equity Practice*, Vol. 2, 2151.

If the decision in the Gorman case would have required a different result if the principles upon which it was decided had been applied in the original proceeding, which we do not find it necessary to decide, *such subsequent decision will not lay the foundation for a bill of review for error of law apparent, or for new matter in pais discovered since the decree, and probably requiring a different result.* *Tilghman vs. Werk*, 39 Fed. 680 (opinion by Judge Jackson, afterwards Mr. Justice Jackson of this court); *Hoffman vs. Knorr*, Circuit Court of Appeals, Fourth Circuit, 50 Fed. 484, 491 (opinion by Chief Justice Fuller.)

The decree of the Circuit Court of Appeals is affirmed." (Italics ours.)

In the case of *Hoffman vs. Knorr* (cited in *Scotten vs. Littlefield*, and reported in 50 Fed. Rep. 484), the Court held that where a decree fixed the priority claims against an insolvent corporation under the authority of an act of a State Legislature, the question of the validity of the act not being raised at the time, a bill of review did not lie

for apparent error, because the act was subsequently adjudged unconstitutional and void by the state Courts on the ground of a defective title and although such a decision is usually as conclusive as a ruling of the Supreme Court itself. This decision was written by Chief Justice Fuller of the Supreme Court when he was sitting in the Court of Appeals for the Fourth Circuit.

Mr. Justice Fuller said (p. 491) :

"And if these complainants chose to acquiesce in the allowance of these claims under these statutes, they had a perfect right to do so, but ought not now to be allowed, in view of a decision rendered eighteen months after this decree, to say that error was committed in particulars which they waived by their conduct. They could not approbate and reprobate at the same time, and, in the interest of the stability of judicial decision, their want of diligence ought to be held fatal to their application."

* * * * *

"After having proceeded upon the theory of the validity of these laws, they came forward with their bill of review to obtain a reversal of so much of the decrees as was opposed to their interests, leaving what was made in their favor to stand. We are of the opinion that they were called upon to present their contention before, if they intended to insist upon it. Cases are not to be tried by piecemeal, and it would open a wide door to persistent litigation if parties should be permitted to lie back, and then renew controversies in this manner.

The decrees of the circuit court appealed from are reversed, and the cause remanded, with a direction to dismiss the petition for rehearing or bill of review, and for further proceedings upon the basis of the finality of the decrees of

September 8 and October 14, 1887, in conformity to this opinion."

To the same effect is *King vs. Dundee Mortgage & Trust Investment Co.*, 28 Fed. 33, where the syllabus says :

"A decree of the United States Circuit Court will not be reversed, on a bill of review therein, because in the meantime the state court has put a construction on a clause of the state constitution contrary to that of the circuit court in making said decree."

See also *Hill vs. Phelps*, 101 Fed. 650, and *Duwagiac vs. McSherry Manufacturing Co.*, 155 Fed. 524, citing *Hill vs. Phelps*, etc.

The State Courts also follow the same principles in refusing to re-open a previously tried suit because of a subsequent contrary decision in another case. In the case of *Miller vs. Tyler*, 58 N. Y. 477, 480, the Court said :

"By the consent, or, which is the equivalent of a consent, by the default of the appellants and their voluntary act in omitting to oppose the motion, the judgment was modified so as to entitle the plaintiffs to coin at their option, instead of legal tender notes, in payment of the mortgage debt. This was in conformity to the legal rights of the parties, as then well understood, and as they had been adjudicated by the highest court of the nation. The reconsideration of the question by the Supreme Court of the United States, with a result adverse to its first judgment, did not affect the existing judgments of State courts, or call for a modification and change of their records to meet the changed views and judgment of that court. A contrary doctrine would lead to the absurd necessity of correcting and modifying all judg-

ments, whether existing and in force or satisfied and fully executed, upon the enunciation by a court of superior authority of a doctrine in conflict with and legally subversive of the principles upon which they were rendered."

In *Harburg vs. Arnold*, 87 Missouri Appeal Reports, 328-329, the Court said:

"But if anything further may be said in order to put the question beyond dispute, it is: that there must be an end to litigation, and that when a litigant has once been heard in the trial court, judgment rendered against him, and appeal had to the highest court under the organic law of the land to which he may go, and that judgment fully, in all essentials, affirmed, he cannot be permitted to renew his contention under the specious plea that the constitutional light which the appellate court was bound to follow committed an error in the first place."

The petitioner tries to distinguish from these cases by the specious argument that in the case at bar there was error *ab initio* in the original decree of the Third Circuit Court of Appeals, whereas in the cited cases the original decrees were correct and were afterwards made erroneous by subsequent controlling decisions. The fallacy of this argument is apparent. If the reasoning applied by the petitioner to this case is applied to the cited cases, it would seem that the original decrees in the cited cases would have to be considered erroneous. If the second decision of this Court in the *Tilghman vs. Proctor* case was correct, then the previous decision in the *Mitchell vs. Tilghman* was wrong and was wrong *ab initio*. In the case of *Hoffman vs. Knor* the statute was unconstitutional from the be-

ginning. The decision of the Court did not make a constitutional statute unconstitutional, but merely declared its unconstitutionality.

These cases are on all fours with the present case in holding that a subsequent contrary decision in another suit is not a ground for a bill of review to bring back and re-try a previously-acquitted defendant upon the same charge.

We submit that the authorities are decisive upon the question here presented, and that the Court of Appeals was correct in stating it was following the decisions made or approved by this Court. We have been unable to find any case, and we believe no case exists, wherein a defendant in a case in tort having first been absolved by a final decree, has been subsequently brought back into court and held under the same charge.

While the petition *to this Court* alleges that the bill of review is based on an *error of law* appearing on the face of the decree of January 5, 1916, *an examination of the bill of review shows that it contains no allegation of error of law.* On the contrary, the bill of review recites *as its sole basis* "that *new facts* have arisen since said decree was entered" (Paragraph 6, Tr. p. 19). The petitioner's shift to another theory before this court is virtually an admission that the "new facts" as alleged in the bill of review are not a proper basis therefor.

A bill of review in the present circumstances would be destructive of the stability of judicial decisions.

If a bill of review should properly lie in the present case, then not only would the effect of such a practice be to destroy the stability of judicial decisions, but no acquitted defendant in a patent case would ever be safe in proceeding in accordance with the mandate of the highest Court of his jurisdiction, so long as there remained any circuit in which the patent had been unadjudicated.

Under such a theory, so long as there remained anywhere the possibility of a case reaching this Court, and of a decision of this Court sustaining the patent involved, all other defendants would be in jeopardy notwithstanding any final decrees which they had obtained in their favor.

The petitioner's allegation that the defendant should have been apprised of the proceedings in the Second Circuit is wholly irrelevant and immaterial. We know of no rule of law or equity which would compel any defendant in whose favor a final decree has been entered by the Court of last resort in his jurisdiction to watch all other possible proceedings against other defendants in other Circuits. Certainly, a defendant in the position of the present defendant, on entering the decree dismissing the bill on the issue of infringement, was fully justified in acting pursuant to that decree. If such a defendant is compelled to take notice of all litigation which may be pending against other defendants in other jurisdictions and await its final outcome, his established business must irreparably suffer.

There is no conflict between the decision of the Third Circuit Court of Appeals that a bill of review will not lie in this case and the decision of the Eighth Circuit Court of Appeals in the case of Omaha Electric Light Company vs. City of Omaha, as alleged by the petitioner.

In the Omaha case (216 Fed. 848), a suit was brought by the Omaha Electric Light Company to enjoin the City of Omaha from interference with its power transmitting wires. The Court of Appeals for the Eighth Circuit held that the plaintiff's franchise had expired and refused to interfere with the action of the City. An appeal to this Court was dismissed because this Court held that no federal question had been raised. The Old Colony Trust Company, trustee under a mortgage of the Electric Light Company's property, brought suit against the City for the same purpose. The Court of Appeals again held that the franchise had expired and dismissed the bill. The case then went to this Court which reversed the Court of Appeals. The Court of Appeals thereupon vacated its decree in the first case.

This case is not in conflict with the present case because in the Omaha case the second bill was against the *same defendant under the identical question of its franchise and the Court of Appeals had stayed its mandate in the first case awaiting this Court's decision in the second case.* The Court of Appeals specifically held that it could not and

would not have considered the bill of review (treated as a petition for rehearing) except for said stay. After reviewing the authorities, the Court said (p. 855) :

"To be sure, the object we had in mind at the time of staying the mandate was to await the action of the Supreme Court. Our jurisdiction, however, was not confined to such intention. So long as we retained the case, it was subject to our full appellate power, including the correction of our decree.

The case is, therefore, still pending in this Court. * * * We entered our stay for the purpose of determining what mandate should be issued."

The Court of Appeals then proceeded to say that inasmuch as *during the stay of its mandate*, this Court had rendered its decision, it was therefore clearly its duty to then issue its stayed mandate in harmony with the decree and mandate of this Court (p. 856).

In the present litigation, the decision of this Court sustaining the patent was in another case involving an entirely different defendant and to which the present respondent was not a party. Furthermore, the mandate of the Court of Appeals for the Third Circuit had issued and the present petitioner had had entered in the lower Court pursuant thereto its decree which was final so far as the patent is concerned. The petitioner, therefore, is wholly in error in its statement on page 14 of its brief accompanying its petition that there were "the same circumstances" in the case at bar as in the Omaha case.

The decision of the Third Circuit Court of Appeals on the bill of review herein is not contrary to the decision of this Court in *Henry vs. Dick Co.*, as alleged by the petitioner.

In the original *Henry vs. Dick case* (224 U. S. 1), the defendant, Henry, was held to be guilty of contributory infringement and a decree and injunction were entered by the plaintiff against him. The defendant, who later brought the bill of review against this decree, did not enter the decree of his own volition but as a defeated party was compelled to accept it. In the case at bar, the present petitioners had entered the decree which they now attempt to upset by a bill of review, and as we above pointed out, they had this decree entered at the very time when the defendant in another suit had a petition for *certiorari* pending before this Court on the same patent.

Moreover, in the case of *Henry vs. Dick* (244 U. S. 651), cited in the petition, the facts were precisely the reverse from those which exist here. In that case the defendant was under perpetual injunction not to do a thing which all other persons could lawfully do after the decision in the original case of *Henry vs. Dick* (224 U. S. 1) had been overruled by this Court in the case of *Motion Picture Patents Co. vs. Universal Film Co.* (242 U. S. 502). This Court in granting the motion for leave to file the bill of review took an opportunity to correct that peculiar and anomalous situation. In the present case, however, the defendant has been cleared of the charge against him by the plaintiffs entering the decree dismissing the bill as to the patent infringement. Defendant is, therefore, forever,

immune. The case of *Henry vs. Dick* is in line with other cases in which a defendant in view of newly discovered evidence has been permitted to file a bill of review for his relief. As above stated, however, we find no case in which plaintiff has been permitted to file a bill of review, the effect of which would be to bring the defendant back into Court and hold it for the very offense of which it has been acquitted.

The situation of the present defendant is not an anomalous situation as was that of the defendant Henry, in the *Henry vs. Dick* litigation. When a defendant has been charged with a *tort* and tried and cleared, he cannot again be attacked on the *same* charge. The principle of *autrefois acquit*, applicable to criminal cases, applies in a situation like the present one.

The present position is one which is inevitable in our patent system and is one which has arisen many times before where there have been conflicting decisions between different circuits. We need only refer to a few well-recognized instances, namely, the litigation on the Eldred cigar lighter patent and to the litigation involving the Grant tire patent which also came before this Court.

In the case of *Kessler vs. Eldred*, Eldred, who owned a patent, sued Kessler, a manufacturer of electric cigar lighters, in the District of Indiana. Non-infringement was found and the bill dismissed. That decision became final. Afterward Eldred brought suit against Kirkland, another manufacturer of similar devices, in the Western District of New York, and prevailed in the Circuit Court of Appeals for that circuit. Eldred then sued Breitweiser, a user of Kessler's lighters, in the same

New York District. During the pendency of the last-named suit, Kessler filed a bill in the Northern District of Illinois praying for an injunction against Eldred to enjoin him from prosecuting any suit against any user or purchaser of Kessler's cigar lighters, of the type which were involved in the suit against Kessler in Indiana. This Court, in its decision (206 U. S. 285), held that the original judgment conclusively settled the right of Kessler to manufacture and sell his goods free from all interference by Eldred.

The present defendant is in the same position that Kessler was in this case. The decree entered by plaintiff dismissing its bill against the defendant as to patent infringement conclusively settled the right of the present defendant to manufacture and sell its miners' lamp free from any further interference by the plaintiff.

The right of a defendant, in whose favor a decree has been entered absolving him of patent infringement, to continue the manufacture of the alleged infringed articles even after the patent had been held valid and infringed in a suit against a third party, is clearly again recognized in the celebrated Rubber Tire cases, in which the Grant patent was involved. The owners of the Grant patent brought suit in the Sixth Circuit against the Goodyear Tire & Rubber Company. The Court of Appeals for the Sixth Circuit held the patent in suit to be invalid and ordered the bill against the Goodyear Tire & Rubber Co. to be dismissed (116 Fed. 363). In suits brought against the Victor Rubber Company in the Sixth Circuit (123 Fed. 85), and against the Kokomo Rubber Company in the Seventh Circuit (not reported), the defendants

were also acquitted of the charge of patent infringement.

The owners of the patent subsequently went into the Second Circuit and brought suit against the Firestone Tire & Rubber Company and against the Diamond Rubber Co. In this Second Circuit litigation the Grant patent was held valid (147 Fed. 739; 151 Fed. 237; 157 Fed. 677; 162 Fed. 892). The defendant, Diamond Rubber Co., petitioned this Court for *certiorari*. Upon *certiorari* this Court held the Grant patent to be valid (220 U. S. 428).

In the litigation in the Second Circuit it was expressly recognized that no decree might be made which could affect the tires manufactured by the previously acquitted defendants in the Sixth Circuit.

Thus in the suit of the *Consolidated Rubber Tire Co. vs. Diamond Rubber Co.*, the Court of Appeals for the Second Circuit ordered that the injunction against the Diamond Rubber Company include the following provision:

"Nothing in this injunction shall prevent or is intended to prevent, or enjoin this defendant from handling, using and selling rubber tires and rims covered by the Grant patent, manufactured by the Goodyear Tire & Rubber Company, having a right to manufacture, use and sell such tires under a judicial decree in the federal courts of the Sixth Circuit; or manufactured by the Kokomo Rubber Company having a right to manufacture, use and sell such tires under a judicial decree in the district of Indiana, Seventh Circuit; or manufactured by the Victor Rubber Tire Company, under a judicial decree in a litigation in the federal courts in the Sixth Circuit, wherein in such litigations it has been judicially determined that the said Grant patent is invalid

and void." (*Consolidated Rubber Tire Co., et al. vs. Diamond Rubber Co.*, 162 Fed. 892-895.)

This Court recognized this situation and refused to reopen by certiorari the previously tried Goodyear case. After the case against the Goodyear Company had been decided against the validity of the Grant patent in the Circuit Court of Appeals for the Sixth Circuit, the plaintiff petitioned this Court for *certiorari*, which was denied (187 U. S. 641). This Court thereafter accepted the petition for *certiorari* brought by the defendant in the Diamond Rubber Tire case (212 U. S. 574). After the acceptance of *certiorari* in the Diamond case, the plaintiff sought by petition for *certiorari* to have this Court *reopen the decision in the Goodyear case*. This Court, however, denied the renewed petition for *certiorari* in the Goodyear case (214 U. S. 512), and thereby refused the attempt by the plaintiff to again drag a previously acquitted defendant into Court upon the same charge of infringement.

The situation of the present defendant is exactly analogous to that of Kessler in the *Kessler vs. Eldred* litigation and to that of the Goodyear Tire & Rubber Company in the Rubber Tire litigation. The present defendant has a right to rely, as did the defendants in these cases, upon the decree absolving it of the patent infringement. If the law were otherwise it would upset and destroy the stability of judicial decisions and would make it unsafe for any defendant manufacturer to accept and act upon a decree in his favor by his Court of Appeals. If a plaintiff could, as the plaintiff herein is endeavoring to do, come in years afterward and upset a final decree in favor of an acquitted defendant, then any defendant sued for the infringement of a patent must, in order to be safe, immediately

cease his manufacture of the article or device complained of. If he contested the suit and it was decided in his favor, just so long as there was any circuit remaining in which the plaintiff could find another alleged infringer, just so long would there be the same possibility of a decree in favor of the defendant being set aside and of his being adjudged an infringer as in this case. *At no time during the life of the patent in question could any defendant safely rely upon the final decision of the Court of Appeals for his Circuit.*

The Court of Appeals did not hold that the decree against which the bill of review was filed, was a consent decree, as alleged in the petition.

The Court of Appeals did not hold that the decree which the plaintiffs entered dismissing the bill as to the patent branch of the suit and ordering an accounting as to the unfair competition branch of the suit, was a consent decree. The Court held that it was in the nature of a consent decree in that its entry was a voluntary act upon the part of the plaintiffs. The plaintiffs had several courses open to them at the time they had the decree entered. They might have petitioned this Court for *certiorari*, they might have applied to the Court of Appeals to withhold the entry of its decree pending the action of this Court in the New York litigation, or they might have abstained from entering the decree in question. Having these several courses open before them, the plaintiffs, however, chose to enter the decree dismissing the bill as to the patent and get the benefit of the accounting as to unfair competition.

The Court of Appeals for the Third Circuit was correct in holding that the decree entered on its mandate was final as to the patent infringement branch of the case.

The case originally involved two branches, one for the infringement of the Baldwin patent and the other for unfair competition in the sale of the defendant's miners' lamps. These two branches of the case were severable and independent of each other.

The decree dismissing the bill as to the patent completely and finally disposed of the patent infringement branch of the suit. No further judicial action as to the patent was required. Neither was there any further question reserved as to the patent.

As stated by Blackstone (3 Black. Comm. 398) :

"Final judgments are such as at once put an end to the actions, by declaring that the plaintiff has either entitled himself, or has not, to recover the remedy he sues for."

The finality of a decree as to the matters finally determined by it is not affected by the fact that there may be a further *severable* matter left to be determined. *Hill vs. Chicago and Evanston Railroad Co.*, 140 U. S. 52.

Conclusion.

As hereinbefore stated, the effect of allowing the bill of review would be to destroy the stability of judicial decisions for which the Courts have always striven. The Court of Appeals for the Third Cir-

cuit in holding that a bill of review did not lie, did not ignore the decision of this Court in the New York litigation and hold that the Baldwin reissue patent is invalid in the Third Circuit with respect to the public at large. The Court of Appeals confined their decision to the rights of the individual litigants under the particular circumstances of this case.

We submit that the Court of Appeals for the Third Circuit was correct in its findings in this case. It followed precisely the principles laid down by this Court in *Scotten vs. Littlefield* and cases therein cited, and applied them to the facts in this case.

The decree dismissing the bill as to the Baldwin patent is final and conclusive, and renders this defendant forever immune.

This defendant stands in the very same position with respect to the Baldwin patent as the Goodyear Tire and Rubber Company stood with respect to the Grant Patent in the rubber-tire litigation, and in the same position as Kessler and his customers stood by reason of the final decision in Indiana in his favor in the cigar-lighter litigation.

Respectfully submitted,

C. P. BYRNES,
GEO. H. PARMELEE,
GEO. E. STEBBINS,

For the Respondent.

May 25, 1920.

Office Supreme Court, U. S.

FILED

OCT 15 1921

WM. R. STANSBURY

CLERK

IN THE
SUPREME COURT OF THE UNITED STATES

57 —————

No. ~~342~~ October Term, 1920.

—————
JOHN SIMMONS COMPANY, Petitioner,

VS.

THE GRIER BROTHERS COMPANY, Respondent.

—————
On Writ of Certiorari to the United States Circuit Court of
Appeals for the Third Circuit.

—————
Supplemental Brief for Respondent.

—————
DAVID A. REED,

Of Counsel for Respondent



IN THE

SUPREME COURT OF THE UNITED STATES

No. 342 October Term, 1920.

JOHN SIMMONS COMPANY, Petitioner,

VS.

THE GRIER BROTHERS COMPANY, Respondent.

On Writ of Certiorari to the United States Circuit Court of
Appeals for the Third Circuit.

Supplemental Brief for Respondent.

This brief propounds two thoughts:

1. A subsequent decision of this Court in another action between other parties is no ground for modification of the final decree in this case by means of a bill of review.

2. The bill of review in this case is barred by lapse of the period of limitation.

I.

The Bill of Review is Grounded on no Sufficient Reason.

"No decree shall be reversed, altered, or explained, being once under the great-seal, but upon bill of review; and no bill of review shall be admitted, except it contain, either error in law appearing in the body of the decree, without further examination of matters in fact, or, some new matter which hath risen in time after the decree."

Lord Bacon's First Ordinance in Chancery, January 29, 1618, quoted in Beames' Chancery Orders, Page 1.

A bill of review may be based on either of two grounds: first—error of law apparent on the face of the record without further examination of matters of fact; second—new facts discovered since the decree which should materially affect the decree and probably induce a different result.

Scotten vs. Littlefield, 235 U. S., 407, 411.

A subsequent decision of this Court is not a new "fact." Its force, if it has *any* force, upon a prior decision in another case, is to demonstrate that there was in that prior case an erroneous deduction or conclusion of law.

It seems to be Petitioner's contention that each decision of this court furnishes ground for bills of review

in all prior cases, no matter how ancient, if they were founded on conclusions inconsistent with the recent decision of this court. Petitioner's argument can lead to no other conclusion but that every judicial decision of an inferior court must hang in perpetual suspense against a possible contrary doctrine laid down by this court at any time in the future. That no such paradoxical system obtains in our jurisprudence was distinctly stated by this court in *Scotten vs. Littlefield*, 235 U. S., 407, where this court said (in an opinion by Mr. Justice Day) in answer to a precisely similar contention:

"Such subsequent decision will not lay the foundation for a bill of review for errors of law apparent, or for new matter *in pais* discovered since the decree, and probably requiring a different result. *Tilghman v. Werk*, 39 Fed., 680 (opinion by Judge Jackson, afterwards Mr. Justice Jackson of this Court); *Hoffman v. Kuar*, circuit court of appeals, fourth circuit, 1 C. C. A. 535, 8 U. S. App. 19, 50 Fed., 484, 491 (opinion by Chief Justice Fuller)."

As was very well said by Justice Allen in *Miller vs. Tyler*, 58 N. Y., 477:

"A contrary doctrine would lead to the absurd necessity of correcting and modifying all judgments, whether existing and in force or satisfied and fully executed, upon the enunciation by a court of superior authority of a doctrine in conflict with and legally subversive of the principles upon which they were rendered."

II.

The Bill of Review was Conclusively Barred by Lapse of Time.

A new decision is not a new "fact." The law remains as before; our understanding of it is bettered. So then, if a new decision furnishes grounds for correcting an earlier decree or judgment in another litigation, it must be because the new decision shows that there was "error of law" in the former decision. Assuming that upon such an excuse we can exhume the remains of buried controversies and re-write their histories, is there no limitation upon the process, or is every judgment and every decree, no matter how ancient, susceptible to such treatment?

We find the limitation clearly defined in a long line of decisions of this Court. It is settled law that a judgment or decree is subject to revision on bill of review only where that bill of review is filed within the period fixed by statute for an appeal from the decree. In other words, by analogy to the period of limitation which applies to appeals, the right to file a bill of review based upon an error of law is restricted to the same period after rendition of the decree complained of:

- Thomas vs. Harvie's Heirs*, 10 Wheaton, 146;
- Kennedy vs. Bank*, 8 Howard, 586, 609;
- Whiting vs. Bank*, 13 Peters, 6, 15;
- Ricker vs. Powell*, 100 U. S., 104;
- Clark vs. Killian*, 103 U. S., 766;
- Ensminger vs. Powers*, 108 U. S., 292;
- Central Trust Company vs. Grant Locomotive Works*, 135 U. S., 297;
- Fraenkl vs. Cerecedo*, 216 U. S., 295.

This being the rule, what results from applying it to the case at bar? This litigation was finally settled by a decision of the Court of Appeals of the Third Circuit on January 22nd, 1915, holding the reissue patent invalid (219 Fed., 735). At that time the period within which an appeal might be taken was one year, as fixed by the Act of March 3, 1891, Section 6, 26 Stat. L., 828. This decision of the Circuit Court of Appeals on January 22, 1915, was a final order, which with the permission of this Court could have been brought up on *certiorari* within one year. In pursuance of the decision and mandate of the Circuit Court of Appeals, the lower court entered a final decree January 5, 1916, (Transcript page 11). This decree adopted the judgment of the Circuit Court of Appeals that the re-issue patent was invalid, and thereupon dismissed the bill of complaint in so far as it charged infringement thereof. This also was not interlocutory, but was a final decree:

Smith vs. Vulcan Iron Works, 165 U. S., 518;

In re Sanford Fork & Tool Company, 160 U. S., 247.

Taking the most favorable possible view for the petitioner, the bill of review could be filed only within one year after the decree of January 5, 1916.

Before that decree, there had come, (November 9, 1915), a decision of the Court of Appeals of the Second Circuit, sustaining the reissue patent and showing a conflict between the Circuits, (228 Fed., 895.) Five days after the decree (January 10, 1916), this court granted a petition for a writ of *certiorari* from the decision in the Second Circuit. Yet the petitioner allowed his year to elapse without petitioning this court for a *certiorari*, without filing a bill of review and without taking any other action either during or after the term to preserve

his rights against the time when this court should have passed upon his patent. He made no move until January 26, 1918, when he first applied to the District Court for permission to file a bill of review. This was more than three years after the decision of the Circuit Court of Appeals and more than two years after the final decree in the District Court dismissing his bill.

We submit that the Bill of Review in substance showed no reason for disturbing the decree, and we further submit that if it had showed such reason it would have been too late and would have been barred by lapse of time.

Respectfully submitted,

DAVID A. REED,

Of Counsel for Respondent.

October 10, 1921.

JOHN SIMMONS COMPANY v. GRIER BROTHERS
COMPANY.

CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE
THIRD CIRCUIT.

No. 57. Argued November 8, 1921.—Decided February 27, 1922.

1. A bill of review is called for only after a final decree adjudicating upon the entire merits and leaving nothing further to be done except the execution of it. P. 88.
2. An interlocutory decree may be modified or rescinded by the court at any time before final decree. P. 88.
3. Whether a decree is final or interlocutory depends upon its essential purport and effect and not upon its characterization in pleadings. P. 89.
4. A decree in a suit for patent infringement and unfair competition, dismissing the bill as to the former ground and granting a permanent injunction as to the latter, but leaving the case pending for an accounting before a master, is interlocutory as an entirety, permitting the plaintiff, if diligent, to seek a rehearing of the dismissal. P. 89. *Smith v. Vulcan Iron Works*, 165 U. S. 518, and *Hill v. Chicago & Evanston R. R. Co.*, 140 U. S. 52, distinguished.
5. A proceeding to reopen by rehearing or bill of review a decree entered on a mandate of an appellate court should first be referred to that tribunal. P. 91.
6. The fact that a party, to carry on his suit, moved execution of a mandate directing a decree partly adverse to himself, after his right of appeal was exhausted, did not make the resulting decree a decree by consent. P. 91.

82.

Opinion of the Court.

7. A decision of this court upholding a patent claim is ample ground for rehearing in a pending suit between other parties in which the same claim has been adjudged void. P. 91.
 8. Omission to apply to this court for certiorari to an interlocutory decree, *held* not laches. P. 91.
 9. *Abercrombe & Fitch Co. v. Baldwin*, 245 U. S. 198, upholding claim 4 of Baldwin lamp patent, *followed*. P. 91.
- 265 Fed. 481, reversed.

CERTIORARI to review a decree of the Circuit Court of Appeals, reversing a decree entered by the District Court after a rehearing, in a suit for patent infringement and unfair competition, and directing reinstatement of another previously entered under its mandate.

Mr. James Q. Rice for petitioner.

Mr. C. P. Byrnes and *Mr. David A. Reed*, with whom *Mr. Geo. H. Parmelee* and *Mr. Geo. E. Stebbins* were on the briefs, for respondent.

MR. JUSTICE PITNEY delivered the opinion of the court.

In October, 1913, Frederic E. Baldwin, a citizen of New York, together with the present petitioner John Simmons Company, a corporation and citizen of that State, brought suit in the United States District Court for the Western District of Pennsylvania against The Grier Brothers Company, a corporation and citizen of the latter State, charging infringement of reissued letters patent No. 13,542, issued to and owned by Baldwin and under which the Simmons Company was sole licensee, for certain improvements in acetylene gas lamps intended for various uses, especially that of miners' lanterns. The bill charged also unfair competition with plaintiffs by the sale of lamps made to resemble the Baldwin lamp manufactured under the patent. The District Court granted a preliminary injunction as to unfair competition but reserved the question of patent infringement for final hear-

ing. 210 Fed. 560. Upon that hearing the court held claim 4 of the Baldwin reissue patent valid and infringed and awarded a permanent injunction upon both grounds, July 24, 1914, with an interlocutory decree for an accounting. 215 Fed. 735. Upon appeal by defendant (the present respondent), the Circuit Court of Appeals for the Third Circuit affirmed the decree as to unfair competition but reversed it as to patent infringement, holding the reissue to be void as to claim 4 upon the ground that this broadened the original patent. 219 Fed. 735, 739. This decision was rendered January 22, 1915, and the mandate went down about a month later setting forth the decree of the appellate court that the decree of the District Court be "affirmed as to so much thereof as refers to the subject of unfair competition, but the rest of the decree must be modified in accordance with the opinion of this court," and that the appellant recover costs and have execution therefor; and thereupon commanding that execution and further proceedings be had according to right and justice. No decree was entered upon this in the District Court until January 5, 1916, when on motion of plaintiffs an order was entered that the decree of the Circuit Court of Appeals be made the decree of the District Court, that plaintiffs recover from defendant their damages sustained by reason of unfair trade to be ascertained and reported by a master to whom reference was made for the purpose, that a perpetual injunction be issued restraining defendant from further unfair competition in trade; and that the bill of complaint as to infringement of the reissue patent be dismissed. The accounting before the master is still pending.

In May, 1913, Baldwin had brought suit (John Simons Company intervening) upon the same reissue patent in the United States District Court for the Southern District of New York against Abercrombie & Fitch Company (Justrite Company, intervening), and that court

adjudged the patent valid and infringed. 227 Fed. 455. On appeal this decree was affirmed by the Circuit Court of Appeals for the Second Circuit, November 9, 1915. 228 Fed. 895. On December 20, 1915, defendants in that suit presented to this court a petition for a writ of certiorari; January 10, 1916, this writ was granted (239 U. S. 649); and under it, on December 10, 1917, the decision of the Circuit Court of Appeals for the Second Circuit was affirmed, this court holding, in direct opposition to the decision of the Circuit Court of Appeals for the Third Circuit, that claim 4 of the reissue was valid. 245 U. S. 198. A mandate was sent down January 15, 1918, to the District Court for the Southern District of New York, and the proper decree was promptly entered thereon.

Soon after this, plaintiffs herein petitioned the District Court for the Western District of Pennsylvania for leave to file what was called a "bill of review" against its decree of January 5, 1916. The court in the first instance refused, but without prejudice to an application to the Circuit Court of Appeals for the Third Circuit for leave to file such bill. Upon application that court granted plaintiffs leave to make the application to the District Court, and authorized the latter court to take action thereon. Under this leave, application was renewed to the District Court, the proposed "bill of review" being at the same time presented, and with leave of the court filed. This bill sets out the original bill and the proceedings had thereunder, as above recited; also the proceedings in the suit in the Second Circuit and the final decision of this court therein; alleging these as "new facts" that had arisen since the decree entered in the District Court for the Western District of Pennsylvania on the 5th of January, 1916, and as showing that that decree was erroneous and contrary to law, in so far as (pursuant to the opinion of the Circuit Court of Appeals for the Third Circuit) it dismissed the bill as to infringement of the re-

issue patent and failed to decree a perpetual injunction and ascertainment of damages as to infringement; prayed that the cause might be reopened and the decree rescinded and set aside, in so far as it dismissed the patent cause of action, and a new decree entered granting the relief prayed for in the original bill. Defendant answered admitting in the main, or at least not denying, the allegations of the so-called bill of review as to the former proceedings and decrees in the courts of the two circuits, but denying that the lamp involved in the Abercrombie & Fitch Company suit (the "Justrite lamp") corresponded in essential features of construction with the "Grier lamp" involved in the present suit; averring that the decisions of the Circuit Courts of Appeals of the two circuits were not rendered on the same state of facts; that the bill was "in fact only a petition for rehearing because of the decision of the Supreme Court referred to therein;" and that the decision of this court in the Abercrombie & Fitch Company suit formed no basis for a bill of review.

Afterwards, John Simmons Company by leave filed a supplemental bill setting up that it had acquired from Baldwin all his rights in the reissue patent including all claims for damages and profits on account of the infringement. Defendant having answered this, testimony was taken to show the structural identity of the "Justrite" and the "Grier" lamps, and the cause came to hearing, with the result that the District Court found substantial identity between the two lamps in all essential features of construction, sustained the right of plaintiffs to maintain the bill of review, and held that its former decree, entered pursuant to the mandate of the Circuit Court of Appeals, so far as it held the reissue patent invalid, should be vacated and set aside and a decree entered sustaining the validity of claim 4 of the reissue, finding defendant guilty of infringement thereof, and plaintiffs entitled to an accounting of profits and a perpetual injunction.

82.

Opinion of the Court.

From the decree thus entered an appeal was taken to the Circuit Court of Appeals, which reversed it and remanded the cause with directions to reinstate the decree of January 5, 1916. 265 Fed. 481. To review this decision, the present writ of certiorari was allowed. 253 U. S. 482.

The District Court, as will appear from an excerpt from its opinion reported in a note to the opinion of the Circuit Court of Appeals, 265 Fed. 483, treated the case as one based upon a true bill of review, and this as resting not upon new matter that had arisen since the decree but upon error of law apparent on the face of the record without further examination of matters of fact.

The Circuit Court of Appeals, upon a recital of the different steps in the litigation, regarded the situation as one of plaintiffs' own creation, for the reason that after that court's decision on the original bill but before the mandate went down, although apprised of the contrary decision of the District Court for the Southern District of New York in a cause to which they were parties, plaintiffs made no request to the Circuit Court of Appeals for the Third Circuit to withhold its mandate; that, after the mandate went down and before a decree pursuant to it was entered in the court below, they knew of the affirmance of the decision of the District Court of New York by the Circuit Court of Appeals for the Second Circuit, yet made no request to either court in the Third Circuit to have the entry of a decree withheld; that on the contrary, with knowledge that this court had under consideration a petition for certiorari in the Second Circuit case, they prepared and of their own motion caused to be entered on January 5, 1916, the decree dismissing their suit as to the patent infringement; and after this court on January 10, 1916, granted the certiorari, they allowed the term to end without moving to suspend, open, or vacate the decree of January 5. The court held that in effect, so far as plaintiffs were concerned, that decree was a consent de-

cree, and while not going to the extent of holding that this was sufficient to bar them from maintaining the bill of review, did declare that the anomalous situation and consequent hardship, arising from the fact that a patent adjudged valid in one circuit by this court at the same time had been adjudged invalid by the Circuit Court of Appeals in another circuit, was due not to any fault of the law or of the patent system but to the failure of plaintiffs to take steps that might have avoided it. Proceeding to consider the legal question whether the decision of this court in 245 U. S. 198, either showed an error of law apparent on the face of the record without further examination of matters of fact, or constituted a new fact discovered since the decree and materially affecting it, the court held on the authority of *Scotten v. Littlefield*, 235 U. S. 407, 411; *Tilghman v. Werk*, 39 Fed. 680; and *Hoffman v. Knox*, 50 Fed. 484, that the bill of review could not be maintained.

The cases cited are to the effect that, in the application of the ancient rule of practice in equity, based upon Lord Bacon's first ordinance (Story Eq. Pl., 6th ed., § 404), a change in the authoritative rule of law, resulting from a decision by this court announced subsequent to the former decree, neither demonstrates an "error of law apparent" upon the face of that decree nor constitutes new matter *in pais* justifying a review.

But a bill of review is called for only after a final decree—one that finally adjudicates upon the entire merits, leaving nothing further to be done except the execution of it. If it be only interlocutory, the court at any time before final decree may modify or rescind it. Story Eq. Pl., §§ 408, a, 421, 425. In the so-called bill of review herein, it is in terms alleged that the decree of the District Court for the Western District of Pennsylvania, entered July 24, 1914, was an interlocutory decree. The same is alleged as to the decree of January 5, 1916. Both allega-

82.

Opinion of the Court.

tions are admitted by the answer, which at the same time asserts that the "bill of review" is in fact only a petition for rehearing. Obviously, the nature of the decree is to be determined by its own essential purport and effect not by the statements of the pleaders about it. But an examination of the record demonstrates that they correctly described the decree as interlocutory.

The decree of July 24, 1914, although following a "final hearing", was not a final decree. It granted to plaintiffs a permanent injunction upon both grounds, but an accounting was necessary to bring the suit to a conclusion upon the merits. An appeal taken to the Circuit Court of Appeals, whose jurisdiction, under § 129 Judicial Code, extended to the revision of interlocutory decrees granting injunctions, followed by the decision of that court reversing in part and affirming in part, did not result in a decree more final than the one reviewed. The prayer for relief based upon infringement of patent and that based upon unfair competition in trade were but parts of a single suit in equity. The decree entered pursuant to the decision of the appellate court, did not bring the suit to a conclusion for either purpose. As to unfair competition, it evidenced a *quasi*-definitive decision in plaintiffs' favor, but an inquiry before a master still was necessary before final decree could pass; an inquiry not formal or ministerial but judicial, in order to ascertain the amount of the damages to be awarded. As to the claim of patent infringement, the decree evidenced a *quasi*-definitive decision adverse to plaintiffs, which, if nothing occurred to prevent, would in due course be carried into the final decree. But it did not constitute a separation of the cause, nor dismiss defendant from the jurisdiction for any purpose; necessarily this decision remained in abeyance until the cause should be ripe for final decree; there was nothing to take the case out of the ordinary rule that there can be but one final decree in a suit in equity.

Smith v. Vulcan Iron Works, 165 U. S. 518, 525, where it was held by this court, after some diversity of opinion among the Circuit Courts of Appeals of the different circuits, that an appeal to one of those courts under § 7 of the Act of 1891, from which § 129 Judicial Code was derived, taken from an interlocutory decree granting an injunction and awarding an accounting in a patent case, conferred jurisdiction upon the appellate court to consider and decide the case upon its merits, and thereupon direct a final decree dismissing the bill, if in its judgment it had no equity to support it, differed vitally from the case before us, since there an adverse decision upon the patent disposed of the entire merits, the suit having no other object. Nor was the situation presented in the present case analogous to that passed upon by this court in *Hill v. Chicago & Evanston R. R. Co.*, 140 U. S. 52, which arose out of its decision in 129 U. S. 170. There a decree was held final for the purposes of an appeal, which dismissed the bill as to certain parties and denied relief "upon all matters and things in controversy," although it left undetermined a severable matter in which those parties had no interest. The test of finality here to be applied is rather that exemplified by *Keystone Manganese & Iron Co. v. Martin*, 132 U. S. 91, and cases cited. In *Ex parte National Enameling & Stamping Co.*, 201 U. S. 156, 165, it was pointed out that the rule of the *Hill Case* cannot apply to a case in which there is but a single defendant.

Regarding, therefore, the decree of January 5, 1916, as an interlocutory not a final one, there is neither technical nor substantial ground for applying to it the rules pertaining to a bill of review, and the bill herein called such is to be treated as essentially a petition for rehearing. By the 69th Equity Rule (226 U. S. 669) such a petition is in order at the term of the entry of the final decree; and, of course, if an interlocutory decree be involved, a

82.

Opinion of the Court.

rehearing may be sought at any time before final decree, provided due diligence be employed and a revision be otherwise consonant with equity.

As the decree in question was entered pursuant to the mandate of an appellate court, proper deference to its authority required that a proceeding to reopen it, whether by rehearing or review, should be first referred to that tribunal. *Southard v. Russell*, 16 How. 547, 570-571; *In re Potts*, 166 U. S. 263, 267; *National Brake & Electric Co. v. Christensen*, 254 U. S. 425, 430-431.

That having been done in this case, and leave for the purpose obtained (leave to grant a "review" fairly included any step short of that), what obstacle stood in the way of correcting the decree? The suit was still pending; plaintiffs applied promptly after the decision of this court in the *Abercrombie & Fitch Co.* suit, 245 U. S. 198. It was eminently proper that the decree in the present suit should be made to conform to that decision, in the absence of some special obstacle. We cannot assent to the view of the court below that plaintiffs may be regarded as consenting to the decree of January 5, 1916; they simply accepted an adverse decision as to a part of their suit, not open to further appeal at their instance, and proceeded in the orderly mode to pursue their suit as to the rest. They were not guilty of laches for omitting at that stage to make application to this court for allowance of a writ of certiorari. That mode of review is not a right of the party, but lies in this court's discretion; peradventure the very fact that a final decree had not yet been entered might have been deemed a sufficient ground for refusing the writ. *Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.*, 240 U. S. 251, 254, 257-258.

Our decision in *Abercrombie & Fitch Co. v. Baldwin*, 245 U. S. 198, must be taken as not only demonstrating that the Circuit Court of Appeals erred in its disposition of this case upon the first appeal (219 Fed. 735), but that

the error, even though not amounting to "error apparent," within the meaning of Lord Bacon's first ordinance, afforded ample ground for setting matters right upon a rehearing before final decree, as was in effect done by the District Court. No sufficient ground is shown for the reversal of its latest decree.

Decree of the Circuit Court of Appeals reversed, and that of the District Court affirmed; and the cause remanded to that court for further proceedings in conformity to this opinion.

DEED ADMINISTRATION OF ESTATE